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**D E C I S I O N**  
of 28 February 1997

**Case Number:** J 0042/92 - 3.1.1

**Application Number:** 85901816.0

**Publication Number:** 0179807

**IPC:** A61K 31/27

**Language of the proceedings:** EN

**Title of invention:**

Stable pharmaceutical compositions of short-acting  
beta-adrenergic receptor blocking agents

**Applicant:**

THE DU PONT MERCK PHARMACEUTICAL COMPANY

**Opponent:**

-

**Headword:**

Post grant amendment/DU PONT MERCK PHARMACEUTICAL

**Relevant legal provisions:**

EPC Art. 21(3), 64(1), 97(4)  
EPC R. 88

**Keyword:**

"A request under Rule 88 EPC for amendments to the description  
or claims can only be filed during the pendency of application  
or opposition proceedings"

**Decisions cited:**

G 0008/95, G 0011/95, J 0017/91

**Catchword:**

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Case Number: J 0042/92 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 28 February 1997

**Appellant:** THE DU PONT MERCK PHARMACEUTICAL COMPANY  
Barley Mill Plaza, Building 25  
Wilmington, Delaware 19898 (US)

**Representative:** Seaborn, George Stephen  
c/o Edward Evans & Co.  
Chancery House  
53-64 Chancery Lane  
London WC2A 1SD (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office dated 13 August 1992,  
refusing a request for correction of errors.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** S. C. Perryman  
J.-P. B. Seitz

## Summary of Facts and Submissions

- I. European Patent 179 807 was granted to the Appellant, the mention of grant being published in the Official Bulletin on 8 January 1992.
- II. On 14 February 1992 the Appellant filed a request to amend the text of the patent pursuant to Rule 88 EPC.
- III. On 12 June 1992 the Examining Division issued a communication refusing the amendments. On 17 July the Appellant wrote insisting on consideration of the amendments and asking for a decision.
- IV. On 13 August 1992, the Examining Division issued both a communication saying that their communication of 12 June 1992 should be disregarded, that Rule 88 EPC applied only while the application was pending and reinterpreting the request for amendment as being a request for a decision on amendments pursuant to Rule 89 EPC, and a decision refusing the request stating that:

"The Applicant filed a request for amendments already on 04.07.91. He was informed with official letter dated 09.10.91 that his request could not be followed. This information was confirmed with telephone conversation dated 31.10.91. The Applicant's agreement to the refusal of his amendments requested was submitted on 10.10.91 with letter dated 07.10.91. He requested the same amendments in an identical manner with letter dated 14.02.92. They cannot be allowed for the same reason as already formerly stated."

- V. The Appellant appealed on 8 October, paying the appeal fee and submitting Grounds of Appeal on 19 November 1992. Essentially it was argued that:

- There had been no rejection of the request to make corrections on the merits of the corrections, that the first rejection referred to in the decision was due to the fact that approval of the text to be granted had already been given, and that as this request had been refused only because it had been made at an inappropriate time, there was no basis for refusing it now.
  
- Rule 88 EPC did not explicitly preclude the correction of errors in claims and descriptions of granted patents. Any such corrections would inevitably be corrections of text approved for granting of a patent since the applicant had to give his approval of the text before the patent was granted. Although the applicant gave such approval, it would be totally unjust to expect that the applicant were thereby warranting that the text was free of errors. Inevitably from time to time errors might be present in texts approved for grant and it would only be just that the applicants/proprietors should be able to correct such errors when they came to their attention, and Rule 88 EPC provided a means for making such corrections. Such corrections had been allowed in the past under Rule 88 EPC after grant in one case where there was no opposition, and in one case during an opposition.

VI. The Appellant requested that the decision under appeal be cancelled in its entirety or alternatively amendment of the decision to allow certain of the requested amendments.

VII. By a communication dated 12 July 1994 the Board informed the Appellant of its provisional opinion that the appeal would have to be dismissed because an application under Rule 88 EPC could only be entertained while application or oppositions proceedings were pending before the European Patent Office.

VIII. The Appellant requested a decision in writing.

### Reasons for the Decision

1. The appeal is admissible.

#### *Competence to hear appeal*

2. The present appeal is from a decision of the Examination Division. The first question to be decided in this appeal, is whether the present board, consisting of three legally qualified members is the appropriate Board of Appeal to hear the appeal. The competence of the Technical Boards of Appeal and the Legal Board of Appeal in grant proceedings is laid down in Article 21(3) EPC as follows:

"For appeals from a decision of an Examining Division, a Board of Appeal shall consist of:

- (a) two technically qualified members and one legally qualified member, when the decision concerns the refusal of a European patent application or the grant of a European patent and was taken by an Examining Division consisting of less than four members;

- (b) three technically qualified members and two legally qualified members, when the decision was taken by an Examining Division consisting of four members or when the Board of Appeal considers that the nature of the appeal so requires;
- (c) three legally qualified members in all other cases."

3. The decision under appeal refused a request under Rule 88 EPC to make amendments made after grant of the patent. For the Board, the appeal thus raises the preliminary question of whether a request under Rule 88 EPC can be made after grant. This is purely a question of law, and does not concern the refusal of a European patent application or the grant of a European patent. Thus under the provisions of Article 21(1)(c) the present composition of the Board is the appropriate one to consider the question. If this question can be answered in the affirmative, the appropriate course would then be for this Board to refer the matter back for consideration of the amendments on their merits by the Examining Division. This course of action ensures that the amendments, if they can be considered at all after grant, would be considered by two instances with any appeal on the merits of the amendments being to a Technical Board of Appeal. The present decision is thus consistent with the reasoning in decision G 0008/95 (OJ EPO 1996, 481) of the Enlarged Board of Appeal, as answering the preliminary question does involve any consideration of the text with which the patent should be granted.

4. Rule 88 EPC appears in the Implementing Regulations to the Convention and not in the European Patent Convention itself. This raises the presumption that it is a merely ancillary provision which can only be applied while proceedings are pending for some other

purpose before the European Patent Office, and that Rule 88 does not confer original jurisdiction on the European Patent Office to make corrections at any time. Relevant proceedings would be application or opposition proceedings.

5. On the grant of a European patent the purpose for which the European Patent Office has been given jurisdiction over the application in the application proceedings has been fulfilled, and by virtue of Article 64(1) EPC, jurisdiction passes to the national patent authorities of the designated contracting states, unless some specific provision of the convention confers jurisdiction on the European Patent Office anew, such as if an opposition is filed. This passing of jurisdiction makes it impossible to interpret the absence of an explicit statement in Rule 88 EPC that it is limited to the pendency of other proceedings before the European Patent Office, as speaking for the possibility of an application of Rule 88 EPC at all times. This line of reasoning has already been adopted in decision J 17/91 (OJ EPO 1994, 225) in an analogous situation concerning the impossibility of registering an exclusive licence at the European Patent Office once all proceedings before the European Patent Office had terminated.

6. Thus for a request for correction concerning the description or claims under Rule 88 EPC to be entertained by the European Patent Office, there must be application or opposition proceedings pending before it. The decision to grant a European patent takes effect pursuant to Article 97(4) EPC on the date on which the European Patent Bulletin mentions the grant. After this date, Rule 88 EPC could only be applied during the pendency of opposition proceedings.

7. The decision to grant the present patent took effect on 8 January 1992, and there were no oppositions filed. So *prima facie* there have never been any proceedings during the pendency of which the European Patent Office had the power to consider the request made by the Appellant's letter of 14 February 1992.
  
8. The Board does not agree with the Appellant that this interpretation leads to an unjust result. A proprietor has the opportunity to file documents he regards as correct during the prosecution of the application, and an opportunity to review their correctness when replying to the communication under Rule 51(4) EPC indicating the basis on which the Examination Division intends to grant the patent. As stated in decision G 0011/91 (OJ EPO 1993, 125) the parts of a European patent application or of a European patent relating to the disclosure (the description, claims and drawings) may ... be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed... A correction under Rule 88, second sentence, EPC is of a strictly declaratory nature. The corrected information merely expresses what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure. As any allowable corrections under Rule 88 EPC are ones that must thus be obvious to the skilled person anyway and so should not be a matter of dispute, there is no reason why, once no application or



opposition proceedings are pending before the European Patent Office, this question of the obvious correct meaning should not fall to be determined solely by the national patent courts or other authorities having jurisdiction over proceedings in which this question may arise.

9. Finally the Board can see no case for exceptionally allowing the amendments here on the basis of the fulfilment of reasonable expectations raised by a general, but incorrect, practice of allowing corrections applied for under Rule 88 EPC after grant. In the Guidelines for Examination, in Part VI Examination Procedure 5.9 there appears the statement with reference to Rule 88 "Linguistic errors, errors of transcription and other mistakes in any document filed with the Office may be corrected at any time". However in its context this can only be read as meaning any time during the pendency of examination proceedings, without any fixed time period from the filing of the incorrect document or the time the error was noticed. The Guidelines for Examination thus cannot have given rise to any reasonable expectation that correction of errors was possible after grant, nor could a general practice giving rise to such a reasonable expectation be inferred from the one case mentioned by the Appellant where such an amendment was allowed after grant when no opposition proceedings were pending, or even from several such cases.
10. The Board thus concludes that the appeal must be dismissed, as the European Patent Office had ceased to have jurisdiction to consider a request under Rule 88 EPC at the time the request was filed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Beer

J. -C. Saisset