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D E C I S I O N
of 10 October 2000

Case Number: T 0055/00 - 3.5.1

Application Number: 92915411.0

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IPC: G06F 12/02

Language of the proceedings: EN

Title of invention:

Memory Management Method

Applicant:

QUARTERDECK OFFICE SYSTEMS, INC.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 97

EPC R. 51

Keyword:

"Obligation to check documents intended for grant of a patent"

Decisions cited:

J 0005/81, J 0007/90

Catchword:

-



Case Number: T 0055/00 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 10 October 2000

Appellant: QUARTERDECK OFFICE SYSTEMS, INC.
150 Pico Boulevard
Santa Monica
CA 90405 (US)

Representative: Zenz, Joachim Klaus, Dipl.-Ing.
Zenz, Helber, Hosbach & Partner
Patentanwälte
Huysseallee 58-64
D-45128 Essen (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 11 October 1999
refusing a request for correction of errors under
Rule 89 EPC in the European patent No. 0 595 880.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: R. Randes
P. H. Mühlens

Summary of Facts and Submissions

I. This appeal is against the decision of the Examining Division dated 11 October 1999 to refuse the request of the appellant for correction of errors under Rule 89 EPC in the decision of 22 October 1998.

II. The appellant filed on 15 July 1992 an International application for a "Memory Management Method". The Examining Division decided to grant a patent on the basis of the following:

"description, pages 1 to 40, as originally filed; claims no. 5 to 9 as received on 25. 04. 94 with letter of 19. 04. 94; drawings, sheets 1/17 to 17/17 as originally filed", the decision being written down and signed in the respective internal EPO forms, namely in Form 2053.3. This means that the Examining Division decided to grant the patent without pages 41 to 44 of the description as filed; the pages were omitted due to lack of unity of invention.

According to the granting procedure, the EPO sent a "Communication under Rule 51(4) EPC" dated 4 February 1998 (EPO Form 2004 01.96) to the representative of the appellant in order to inform him that it was intended to grant the patent on the basis of "the above application with the text and the drawings as indicated below: Description, page(s) 1 to 44 as published". Thus, the text of the communication did not take into account the intention of the Examining Division to omit pages 41 to 44 of the description. Contrary to that, the enclosed documents contained only pages 1 to 40 of the description.

With letter dated 28 May 1998, the appellant referred to the communication under Rule 51(4) and stated his approval to "the text notified".

EPO Form 2006 01.95 entitled "Decision to grant a European Patent pursuant to Article 97(2) EPO" was issued on 22 October 1998. According to the decision of the Examining Division, the patent specification did not contain pages 41 to 44.

When translating the patent specification into German, the representative of the appellant noticed that pages 41 to 44 were missing in the description. Being convinced that this was due to an error committed by the EPO, he requested the issuance of a corrected patent specification which was refused by the contested decision.

III. The Examining Division held that there was no obvious error that can be corrected under Rule 89 EPC as the text given for grant corresponds to the real intention of the Examining Division. The request to the applicant to give his approval for the documents listed in the said communication under Rule 51(4) did not free the applicant from the obligation to check the correspondence between the list of documents and the enclosed copies. Whereas the list of copies in the communication was not correct, the copies were correct. Thus, the request for a reprint of the patent specification including the subject - matter of pages 41 to 44 could not be allowed.

IV. The arguments of the appellant can be summarized as follows:

The Examining Division was wrong in deciding to refuse a correction of the patent specification under Rule 89 EPC as it was not the appellants intention to apply for correction of obvious mistakes. All he requested was a re - print of the patent specification to bring the specification in line with that what was granted, ie the patent including pages 41 to 44.

According to the appellant, the patent was granted including these pages. Although it had been the internal intention of the Examining Division to omit the pages, the decision to grant, documented by EPO Form 2006, did not exclude it. The decision to grant cannot be seen from the internal form 2053.3, because this form and its contents are not made public. The actual decision can only be seen from documents which are intended for the use of the applicant or for the public. Thus, the relevant documents were the documents issued by the Office, ie the communication under Rule 51(4) EPC and the "Decision to grant a Patent" dated 22 October 1998, whereas the internal intention of the Examining Division was without any relevance. As none of the relevant documents announced the omission of the pages, they were not excluded by the decision to grant.

As far as the communication under Rule 51(4) EPC is concerned, the relevant content of this communication is only the text written on form 2004, but not the enclosed documents.

These documents are only for information without forming a part of the communication itself. The appellant could therefore rely on the text of the communication even though there was a discrepancy

between this text and the documents enclosed.

Acts and decisions of the EPO in a granting procedure can only affect the applicant if he knows of them which he cannot if they are only recorded in internal documents of the office. Thus, the objective contents of a communication can only be determined by what is made known to the applicant.

That point, as well as the question of the relevant contents of a communication being important points of law, they should be referred to the Enlarged Board of Appeal.

The case as a whole should be referred to the Legal Board, because the contested decision does not concern the refusal of a European patent Application or the grant of a European patent.

As the Examining Division made the contested decision on the basis of the contents of an internal form, they committed a substantial procedural violation. Thus, the appeal fee should be reimbursed.

The appeal procedure should be continued in German as the appeal is not about the drafting of a patent but about a legal question.

- V. The representative of the appellant requested in writing that the decision under appeal be set aside and to establish that the European Patent Office has to reprint the patent specification including the subject-matter of pages 41 to 44 and, as a further request, reimbursement of the appeal fee, and, as an auxiliary request, reference of this case to the Enlarged Board.

Reasons for the Decision

1. The appeal is admissible.
2. The Board is competent to decide the present case. According to Article 21(3)(a) EPC, the Board of Appeal shall consist for appeals from a decision of the Examining Division of technically and legally qualified members, when the decision concerns the refusal of a European patent application or the grant of a European patent (Technical Board of Appeal).

In all other cases, the Board of Appeal shall consist of three legally qualified members (Article 21(3)(c), Legal Board of Appeal). The matter in dispute in this case is whether the specification has to contain pages 41 to 44 or not. If the pages have to be omitted because of lack of unity of invention as it was held by the Examining Division, it cannot be allowable to publish them. The main issue of this case is the scope of the granted patent. This question has to be decided by the Examining Division which is also competent for the correction of obvious errors in the patent specification. (See G 8/95, OJ 1996, 481, reasons 3.4 and 4). As a consequence, an appeal against these decisions of the Examining Division has to be dealt with by a Technical Board of Appeal which is in this case, according to the business distribution scheme, the Technical Board 3.5.1.

3. The Examining Division shall grant a European patent, if the application and the invention meet the requirements of the EPC (Article 97(2)). This was, according to the view of the Examining Division, for

this application only the case if pages 41 to 44 were omitted. This decision is clearly documented in the file as it is recorded on the (internal) form 2035.3 and duly signed by the members of the division. The decision of the Examining Division to grant the patent without these pages remained unchanged until the formal act of granting and was therefore the basis of the grant. The fact that this decision was - in part - erroneously communicated to the applicant did not change the initial decision, nor was it changed before or by the issue of form 2006 entitled "Decision to grant". If a decision or an act is wrongly communicated or communicated in a wrong context, the decision or act itself is not affected by the error which caused the wrong communication. Otherwise, to mention an extreme case, the refusal of an application could be overturned into a grant of a patent because of the mere reason that a wrong communication was sent out.

4. Although a wrong communication or publication cannot change or amend a decision, the fact that a decision appears in a communication to be different from the decision as it actually stands could be relevant at least in certain cases. Applicants as well as the public can normally rely on the correctness of what is issued or published by the office, unless the contents or the circumstances indicate that a communication is not correct.
5. The applicant received with the communication dated 4 February 1998 a written text on EPO Form 2004 and a complete set of the relevant documents. He was thus given the opportunity to check the documents as a complete set. Because the EPC does not provide for any possibility to amend or revoke a patent once granted -

except as a result of an opposition procedure - and because the patent proprietor is not allowed to file a notice of opposition against his own patent, this check is very important.

This is why the EPO complies with the requirements of Rule 51(4) EPC not only in communicating the text on form 2004 but also in enclosing a complete set of the relevant documents. The text on form 2004 indicates explicitly that "a copy of the relevant documents is enclosed". Having regard to the importance of the check of the documents, it cannot be said that the only relevant part of the communication under Rule 51(4) EPC is the text written on form 2004. The enclosed documents also form a relevant part of the communication. Only when checking these documents the applicant is able to discover mistakes within the text of the documents. It is therefore not sufficient to check only whether the documents enclosed are the documents following references in the communication, but to check also the contents of the relevant documents. If the applicant had checked the enclosed relevant documents intended for grant thoroughly, he would have remarked that the four pages of the description were missing. In his response to the communication, he could then have proposed to amend the description accordingly (Rule 51(5) EPC).

6. As the applicant indicated his approval of the text notified, the grant procedure continued and the patent was granted. As the fact that the decision was wrongly communicated did not change the decision and as the applicant could not rely on the correctness of the part of the communication indicating that the description would contain "pages 1 to 44 as filed", there is no

legal basis for the requested re - printing of the patent.

A correction under Rule 89 EPC is not possible either, because the omission of the pages was due to the discretion of the Examining Division and not to any error.

7. Under Article 112(1) EPC, the Boards of Appeal shall refer a case to the Enlarged Board of Appeal if it appears necessary for ensuring uniform application of the law or if an important point of law arises. It is not necessary to refer questions to the Enlarged Board if they can be resolved by the Board of Appeal itself without any doubt (see J 5/81 (OJ 1982, 155) or if they are not relevant for the decision in the specific case (see eg J 7/90 (OJ 1993, 133)). The question, whether the contents of a communication of the EPO can also be seen from internal documents of the office, is not relevant for the solution of this case because the decision was communicated, even if the communication was partly wrong. The same applies to the question whether a decision under Article 97(2) EPC can be based on internal documents which are unknown to the applicant. Thus, the case can be solved without answering these questions. The question whether in the case of a communication under Article 51(4) EPC the documents enclosed form a part of the communication (yes) is a simple question of law which can be answered by the Board itself. Apart from these points mentioned by the applicant, the Board does not see any other point which might have required referral to the Enlarged Board.

8. With a view to the request of the applicant to continue

with the proceedings in German, it has to be noticed that the language of the proceedings is the language of the application or that of the translation if the application was not filed in an official language of the EPO. The language of the proceedings remains unchanged regardless whether the case is about the drafting of an application or a legal point (Article 14(1) and (3) EPC). The applicant and/or his representative are, within the limits set by the Convention or the Regulations, free to use a language different from the language of the proceedings, as the representative of the applicant did in the present case.

9. In view of Rule 67 EPC, the reimbursement of the appeal fee as requested by the applicant is not justified. Reimbursement under Rule 67 EPC is only possible if, as the first requirement of this rule states, the appeal is successful.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg