

Decision of Technical Board of Appeal 3.5.01 dated 13 June 2007

T 1093/05 – 3.5.01

(Translation)

Composition of the board:

Chairman: S. Steinbrener
Members: P. Schmitz
S. Wibergh
K. Bumès
G. Weiss

Patent proprietor/Appellant: Infineon Technologies AG

Headword: Multiplier circuit/INFINEON TECHNOLOGIES

Article: 96(2), 97(2), 113(2) EPC

Rule: 51(4), (6), (11), 89 EPC

Keyword: "Interpreting a decision to grant a patent" – "Correction of a decision to grant a patent (no)" – "Amendments after the communication under Rule 51(4)" EPC

Headnote:

If a grant decision is defective, the patent proprietor must consider carefully the nature of the defect and how it is best rectified. If it involves a substantial procedural violation, rectification is possible only on appeal. A request for correction under Rule 89 EPC can succeed only if it is clear that the examining division did not intend to grant the patent in that form – and also in what form it did intend to grant it (Reasons 12).

Summary of facts and submissions

- I. European patent application No. 97 111 341.0 was filed on 4 July 1997. On 30 June 2003, the examining division issued a communication under Rule 51(4) EPC. This included amendments it had made to claims 1, 5 and 6 and page 4 of the description.
- II. In a letter received on 4 November 2003 the applicant said the examining division's proposed amendments were totally unacceptable, filed a revised page 4 of the description and asked that the patent be based on that and the original claims. At the same time, English and French translations of the original claims were filed and the fees for grant and printing were paid.
- III. On 22 April 2004, the decision to grant was issued using EPO Form 2006A 07.02. It stated that a patent was being granted with the documents indicated in the communication pursuant to Rule 51(4) EPC dated 30 June 2003. It also said that "the modifications subsequently requested by the applicant and received at the EPO on 00.00.00 have been taken into account". On 2 June 2004, the patent specification was published without the amendments requested.
- IV. In a letter of 23 June 2004, the patent proprietor asked that the patent be republished in the form it had approved (claims as originally filed, and description with amended page 4), which had not been taken into account in the specification as published. In a letter of 9 July 2004, the patent proprietor asked for the decision to grant to be corrected under Rule 89 EPC so as to enable the patent to be granted with the amendments received on 4 November 2003, and for publication of a duly corrected specification. In a decision of 8 June 2005, the examining division, enlarged by a legally qualified examiner, refused these requests for correction.
- V. The justification it gave for doing so was that the decision to grant the European patent contained no obvious error; having not seen the amendments filed on 4 November 2003, the division had not known that modifications had been requested after it issued the communication under Rule 51(4) EPC. On the day it took the decision,

therefore, its actual intention had been to grant the patent as per the documents indicated in the communication under Rule 51(4) EPC. True, that decision should not have been taken, the applicant not having agreed to the text as granted. But a procedural error was not correctable under Rule 89 EPC; a decision containing such an error was binding on both the examining division and the applicant – who however was adversely affected by it and could therefore have taken it to appeal.

VI. In a letter received on 1 August 2005, the patent proprietor (appellant) appealed against this decision, and requested that the examining division's decision of 8 June 2005 be set aside and its decision to grant dated 22 April 2004 corrected by replacing the sentence

"The modifications subsequently requested by the applicant and received at the EPO on 00.00.00 have been taken into account."

with

"The modifications subsequently requested by the applicant and received at the EPO on 04.11.03 have been taken into account".

The appellant also asked for the specification to be corrected accordingly.

VII. In the grounds of appeal, also received on 1 August 2005, the appellant argued that the examining division had granted a patent with the amendments requested. The decision to grant stated that

"the modifications subsequently requested by the applicant ... have been taken into account."

All that was missing was the right date. The use of a non-existent one did not mean that no amendments had been taken into account. The date 00.00.00 given in the decision to grant was indubitably an obvious error; clearly, the EPO could receive nothing on 00.00.00, and the error was also correctable under Rule 89 EPC because only once throughout the examination proceedings had amendments been requested, namely in the letter received by the EPO on 4 November 2003. Therefore, and because the decision to grant expressly said that modifications requested had been taken into account, there could be no doubt that the amendments referred to in the decision to grant were those received at the EPO on 4 November 2003.

The file, too, left no doubt that the examining division's actual intention had been to grant a patent with the amendments requested. Under Article 97(2)(a) EPC a decision to grant could be issued only if it was established, in accordance with the provisions of the Implementing Regulations, that the applicant had approved the text in which the examining division intended to grant the European patent. That approval had existed only for the amendments received on 4 November 2003. Had the examining division wanted in its grant decision to grant a patent with the documents indicated in the communication pursuant to Rule 51(4) EPC, it was required under Rule 51(6) EPC before issuing the decision to obtain approval of the amendments it felt to be necessary. Clearly, therefore, the division had intended to grant the patent with the amendments received on 4 November 2003.

Publishing the specification without those amendments was likewise an obvious error correctable under Rule 89 EPC. The specification quite obviously failed to reflect the text as per the decision to grant.

VIII. On 18 October 2006 the board issued a communication expressing the provisional opinion that the decision to grant was to be understood as granting a patent as per the text indicated in the communication under Rule 51(4) EPC and that this was not correctable under Rule 89 EPC.

IX. In a letter dated 28 December 2006, the appellant submitted comments in response. On 13 June 2007, oral proceedings were held at the appellant's request and the board announced its decision.

Reasons for the decision

1. The appeal meets the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

2. The appeal challenges the refusal of the request for correction of the decision to grant a patent (hereinafter "grant decision"). Before a decision can be taken about the correction, the interpretation to be given to the grant

decision – i.e. the text of the patent as granted – must be clarified. That text is definitively and expressly set out in the grant decision (Rule 51(11) EPC). In European Patent Office practice, the grant decision is an electronically generated form which refers to the documents indicated in the communication pursuant to Rule 51(4) EPC and says that a patent is granted with those documents. These documents thus become an integral part of the grant decision, as if they were repeated in the decision itself (T 850/95, OJ EPO 1997, 152, Reasons 2). If amendments are requested after the communication under Rule 51(4) EPC has been issued and the examining division agrees to them, the division will decide to grant the patent under Article 97(2) EPC (Guidelines for Examination in the European Patent Office, C-VI, 15.4) instead of issuing a second such communication. To permit this, the grant decision contains a further sentence reading: "The modifications subsequently requested by the applicant and received at the EPO on [date] have been taken into account", into which the actual date of receipt of the amendments is duly inserted. EPO practice is to include this sentence even if no amendments have been requested or agreed to. In such cases, the grant decision gives the figures "00.00.00" rather than a specific date. It is then referring only to the text as per the communication under Rule 51(4) EPC and granting a patent in that text.

3. The appellant says that although the grant decision gave the date of receipt of the amendments as 00.00.00, the decision could only be understood to mean that the patent had been granted with the amendments filed on 4 November 2003. In the oral proceedings the appellant's representative conceded that he was aware from experience that in EPO practice the sentence in question, with the figures 00.00.00, appeared in every grant decision when no amendments had been requested. But the question here was the yardstick to be applied in the decision's interpretation. That could not vary depending on whether the addressee was a professional representative or an individual applicant. Rather, the yardstick had to be the general public, which was also affected by a grant decision.

4. The board's view is that the basis for deciding how a decision is to be understood must be how it would be construed in good faith by a reasonable addressee taking part in legal dealings with the EPO. The appellant argues that the decision can only be interpreted as meaning that the amendments had been allowed, because otherwise the division could not have granted the patent. The board cannot agree. The first question one has to ask when interpreting a standard statement in an official decision is: what does it mean under normal circumstances? As shown above, this sentence means that no amendments were taken into account following the communication under Rule 51(4) EPC. Someone engaged in legal dealings with the EPO can be expected to be – or make himself – familiar with its usual practice, and therefore to ascribe to this standard sentence its normal meaning. This practice is also apparent to the general public, since the sentence appears in every grant decision. Its information content cannot depend on individual addressees' purely subjective understanding of it, because otherwise its meaning would vary accordingly.

5. Even if a reasonable addressee were unfamiliar with EPO practice, he could not assume that his request for amendments had actually been allowed. The grant decision is clearly a computer-generated form, not an individually written decision. It is not unusual for such forms to cover multiple standard situations and to be adjusted as required. Nor is it unusual to use the figures 00.00.00 as a placeholder for a date which may need to be inserted. If no date has been entered in circumstances when it should have been, that suggests that a mistake has been made: either the amendments have been taken into account without changing the date, or the date has not been changed because the amendment request has not been noted. But then the decision is not saying what, by rights, should have been said. And in such a case it cannot be assumed that the procedure has taken the proper course; rather, it is possible that the request was not noted – a possibility the addressee would need to look into. An error which may have a number of causes cannot be corrected by making the decision say just what the addressee would have liked it to say. So the patent proprietor could not assume from the decision as communicated that the examining division had granted the patent with the amendments it had requested. After all, the specification notified to it during the period for appeal against the grant decision (see its letter of 23 June 2004) also took no account of these amendments in the binding language of the proceedings.

6. To grant a patent in a text not approved by the applicant is in breach of Articles 97(2)(a) and 113(2) EPC and thus a substantial procedural violation. It is established board of appeal and Enlarged Board of Appeal case law that an examining division is bound by its final decision on an application, which can be set aside only following an admissible, allowable appeal (see G 12/91, OJ EPO 1994, 285, Reasons 2; G 4/91, OJ EPO 1993, 707, Reasons 7; T 371/92, OJ EPO 1995, 324, Reasons 1.4 and 1.5; T 1081/02 of 13 January 2004, not published in OJ EPO, Reasons 1.1.3; T 830/03 of 21 September 2004, not published in OJ EPO, Reasons 1.1 and 1.2). In view of this established case law, the board cannot subscribe to the view expressed in T 971/06 dated 21 March 2007 (not published in OJ EPO) that an erroneous decision is a nullity and therefore no appeal needs to be filed against it.

In the present case, however, no appeal against the grant decision was filed.

7. Instead, the appellant chose to request correction under Rule 89 EPC. But this case does not fulfil the conditions of that rule, which permits the correction only of linguistic errors, errors of transcription and obvious mistakes in EPO decisions. A grant decision contains an obvious mistake if the text given for grant is not and obviously cannot be what the examining division actually intended, and the erroneously indicated text can be replaced by that on which the examining division actually wanted to base its decision (see T 850/95, loc. cit., Reasons 3). For reasons of legal certainty and to prevent adverse effects for third parties, only obvious errors can be corrected (see G 1/97, OJ EPO 2000, 322, Reasons 3(c)). That means it must be clear not only that the examining division did not intend to grant the patent in the form actually granted, but also in what form it did intend to grant it.

8. Even if the grant decision, taken in isolation, might be considered ambiguous in the circumstances, its purport is abundantly clear from the application dossier and the procedure documented therein, namely that the examining division's intention was to grant the patent with the documents indicated in the communication pursuant to Rule 51(4) EPC. There is nothing on file to suggest that it intended to grant the patent with the documents received on 4 November 2003. As the division explains in the contested decision, these amendments did not reach it. That should not have happened, but in these circumstances the division cannot be assumed to have wanted to grant something which it had never seen, let alone examined – especially when the appellant was using the amendments to request a patent on the basis of original claims which were precisely what the division did not want to grant. *Pace* the appellant, it could not simply assume that the division had been convinced by its arguments and therefore wanted to grant the patent with the original claims. That is purely hypothetical and not at all obvious.

9. Nor can the appellant successfully argue that the examining division could be supposed to have agreed to the amendments because it would not have wanted to grant a patent marred by a procedural error. It can indeed be assumed that the division did not wish to commit a procedural error. But that alone does not mean it wanted to agree to the amendments. Since it was unaware of them, that is certainly not obvious and cannot therefore be taken into account for the purposes of a request under Rule 89 EPC.

10. In G 8/95 (OJ EPO 1996, 481) the Enlarged Board of Appeal distinguished between two situations in which the grant decision was not what the applicant had asked for, and explained which errors were correctable under Rule 89 EPC and which were appealable (Reasons 3.1 to 3.3). Both an appeal and a correction request under Rule 89 EPC sought to "change" the grant decision. However, a request under Rule 89 EPC could not be based on a party's not having been granted what it had asked for, but only on a linguistic error, error of transcription or similar obvious mistake. Thus the difference between an appeal and a request for correction of a decision could be seen in the fact that in the first case the remedy was directed against the substance of the decision and in the latter case against the form in which the decision was expressed. In G 1/97 (loc. cit., Reasons 2(c)) the Enlarged Board ruled that a substantial procedural violation was not correctable under Rule 89 EPC.

11. In the present case the appellant is challenging the substance of the grant decision, which should not have been issued the way it was. But the right way to do that would have been to appeal against it. The correction request cannot succeed because it challenges the form of the grant decision, and (as explained above) the examining division wanted to issue it in that form.

12. If a grant decision is defective, the patent proprietor must consider carefully the nature of the defect and how it is best rectified. If it involves a substantial procedural violation, rectification is possible only on appeal. A request for correction under Rule 89 EPC can succeed only if it is clear that the examining division did not intend to grant the patent in that form – and also in what form it did intend to grant it.

13. The board would also point out that errors made during the procedure under Rule 51(4) EPC can go straight into the grant decision – as in the present case. The communication under Rule 51(4) EPC is supposed to bring the substantive procedure to an end and should as a rule be based on a text approved by the applicant. If in this communication the examining division suggests amendments, it must ensure that an approved text exists before it issues the grant decision – especially since no second communication under Rule 51(4) EPC is issued if the applicant responds with amendments which the division considers grantable. To avoid this kind of problem, the division should make only such amendments in the communication under Rule 51(4) EPC as it can reasonably expect the applicant to accept, as stipulated in the Guidelines for Examination in the EPO, Part C-VI, 15.1. Otherwise it must issue a communication under Article 96(2) EPC (see also T 121/06 dated 25 January 2007, not published in OJ EPO, Reasons 14).

14. The patent specification reflects the substance of the grant decision and therefore cannot be corrected either.

Order

For these reasons it is decided that:

The appeal is dismissed.