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**Datasheet for the decision
of 27 January 2017**

Case Number: T 0084/16 - 3.3.04

Application Number: 10762578.2

Publication Number: 2416799

IPC: A61K38/16, A61K9/00, A61P7/00

Language of the proceedings: EN

Title of invention:
PAR-1 activation by metalloproteinase-1 (MMP-1)

Applicant:
Tufts Medical Center, Inc.

Headword:
PAR-1 activation/TUFTS

Relevant legal provisions:
EPC Art. 64(1), 65, 97(1), 97(3), 98, 107, 106(1), 112(1),
113(2), 128(4)
EPC R. 71(3), 71(5), 71(6), 71a(1), 73, 74, 101(1), 111, 139,
140, 144(d)
RPBA Art. 13(1), 13(3), 21
Decision of the President of the EPO dated 12 July 2007
concerning documents excluded from file inspection

Keyword:

Admissibility of the appeal - (no)
Error in the patent specification - (yes)
Adversely affected by the grant decision - (no)
Referral to the Enlarged Board of Appeal - (no)
Exclusions from file inspection - (yes)

Decisions cited:

G 0001/10, T 0150/89, T 0850/95, T 1145/09, T 1644/10

Catchword:



Beschwerdekammern
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Chambres de recours

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Case Number: T 0084/16 - 3.3.04

D E C I S I O N
of Technical Board of Appeal 3.3.04
of 27 January 2017

Appellant: Tufts Medical Center, Inc.
(Patent Proprietor) 800 Washington Street
Boston, MA 02111 (US)

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Decision under appeal: Decision of the examining division dated
2 July 2015 to grant, pursuant to Article 97(1)
EPC, European patent No. 2 416 799 based on
European patent application No. 10762578.2.

Composition of the Board:

Chairwoman G. Alt
Members: B. Claes
M. Blasi

Summary of Facts and Submissions

- I. The patent proprietor (hereinafter "appellant") filed an appeal against the examining division's decision dated 2 July 2015 to grant, pursuant to Article 97(1) EPC, European patent No. 2 416 799 based on European patent application No. 10 762 578.2. The application had originally been filed as an international patent application and was published as WO 2010/118435 having the title "*PAR-1 activation by Metalloproteinase-1 (MMP-1)*". The appeal was based on the submission that the decision to grant the patent contained errors.
- II. The facts in the proceedings before the examining division relevant for the present decision are as follows:

The examining division issued a communication pursuant to Rule 71(3) EPC dated 16 March 2015 stating its intention to grant a patent. With respect to the version of the claims on which the grant would be based, the communication referred to claims 1 to 14 as "*filed with telefax on 12-09-2014*". The complete text intended for grant (the "Druckexemplar") which was enclosed with the communication included, as claims, a clean version of the copy of the set of claims submitted by the appellant by fax on 12 September 2014. Claim 3 of these claims refers to "*a tetracycline compound **or doxycycline***" and claim 14 to "*... the group consisting of ... **Pli3pal-12S** ...*" (emphasis added by the board).

In response to the communication pursuant to Rule 71(3) EPC, the appellant filed on 16 June 2015 translations of the claims and paid the fee for grant

and publishing, hence approving the text including the claims as communicated to him pursuant to Rule 71(5) EPC.

The decision to grant the patent pursuant to Article 97(1) and Rule 71a(1) EPC dated 2 July 2015 (hereinafter "the grant decision") referred, for the text of the application forming the basis for the grant decision, to the documents indicated in the communication pursuant to Rule 71(3) EPC (see above) and announced the publication of the mention of the grant in European Patent Bulletin 15/31 of 29 July 2015.

In the European patent specification published in accordance with Article 98 and Rule 73 EPC on the European publication server on 29 July 2015 as EP 2 416 799 B1, claim 3 refers to "*a tetracycline compound **ordoxycyline***" and claim 14 to "*... the group consisting of ... **Pli3pai-2S** ...*" (emphasis added by the board).

On 30 July 2015, the certificate for the patent was issued to the appellant in accordance with Rule 74 EPC.

III. The board issued a communication pursuant to Article 17(1) RPBA dated 24 May 2016 setting out its preliminary, non-binding opinion that the appellant seemed not to have been negatively affected by the decision under appeal. The board was furthermore of the preliminary opinion that the present case differed from the procedural situation that the Enlarged Board of Appeal had been concerned with in its decision G 1/10. The board invited the appellant to file its submission within two months from notification of the communication.

- IV. In a letter dated 18 July 2016 the appellant requested a four-month extension of the time limit to reply to the board's communication.

- V. In a communication dated 20 July 2016, sent in advance by fax, the board informed the appellant that it refused the request for an extension of the time limit. It noted however that the time limit set in its previous communication had not yet passed.

- VI. In a further letter dated 22 July 2016 the appellant requested anew a four-month extension of the time limit to respond to the board's communication of 24 May 2016, and appended as an enclosure evidence of email correspondence dated 21 July 2016 between the appellant's European patent attorney and the responsible contact person at the appellant. The appellant further requested that the appellant's letter as well as the enclosure be excluded from file inspection.

- VII. In a communication dated 26 July 2016 the board refused the requested extension of the time limit and announced that the reasoning for the refusal of the extension request and observations concerning the appellant's request for exclusion from file inspection would be contained in a separate communication of the board.

- VIII. This separate communication of the board was issued on 28 July 2016. Redacted versions of the appellant's letter dated 22 July 2016 and of the appended email correspondence were enclosed showing the extent to which the board considered legitimate personal interests of natural persons as being affected by the statements in the letter and the email. A two-month time limit for reply was set. This communication of the

board with its enclosure as well as the original versions of the appellant's letter dated 22 July 2016 with its enclosure were provisionally excluded from file inspection in accordance with Rule 144(d) EPC and Article 1(3) of the Decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection (OJ EPO 2016, Supplementary publication No. 1, X.3).

- IX. With a letter dated 3 August 2016 the appellant replied to the board's communication pursuant to Article 17(1) RPBA dated 24 May 2016 (see section III) submitting further arguments in support of the admissibility of the appeal as well as a further document.
- X. The board summoned the appellant to oral proceedings.
- XI. With a letter dated 29 September 2016 the appellant submitted comments concerning its request for exclusion from file inspection.
- XII. Oral proceedings were held on 27 January 2017 during which the appellant submitted redacted versions of its letter of 22 July 2016 and its enclosure, the board's communication dated 28 July 2016 without enclosure and the appellant's letter dated 29 September 2016 (see annex to the minutes of the oral proceedings). The appellant requested that only these redacted versions be open to file inspection. It further submitted questions in writing and requested that they be referred to the Enlarged Board of Appeal. It also requested that the decision dated 2 July 2015 to grant a patent be set aside and that a patent be granted based on the text approved by the appellant in accordance with Rule 71(5) EPC. At the end of the oral

proceedings the Chairwoman announced the decision of the board.

XIII. The appellant's arguments can be summarised as follows:

Admissibility of the appeal

In the specification of the European patent EP 2 416 799 B1, claim 3 incorrectly referred to "ordoxycycline" rather than to "or doxycycline" and claim 14 incorrectly referred to "Pli3pai-12S" rather than to "Pli3pal-12S". The patent was therefore not granted with the text approved by the appellant, the change in the claim language being introduced after the text intended for grant was approved under Rule 71(5) EPC. The examining division had therefore failed to observe Article 113(2) EPC.

The errors to the text for grant had been introduced during an administrative procedure inside the EPO which the appellant could not control or verify. In fact, the first opportunity for the appellant to check the granted text was the publication of the patent specification. It was generally accepted that the patent specification was documentary evidence for the text of the granted patent.

This was stated in decision T 150/89, point 2 of the Reasons: *"The decision to grant is legally binding as regards existence and **scope of the patent** (Art. 97 EPC). The **patent publication** is a **reproduction thereof** (Art. 98 EPC). Given it is an official document published by a public authority for the information of the public, it **constitutes documentary evidence**"* (translation and emphasis by the appellant).

This also followed from decision G 1/10 of the Enlarged Board of Appeal in point 6 of the Reasons, stating that a European patent as from its date of grant fell within the jurisdiction of the designated contracting states, which were then entitled and required to take the text of the granted patent as the basis for any national proceedings. In these proceedings the patent specification was the only document that would be accepted as proof for the text of the granted patent.

The patent specification itself had legal effects as was suggested by the certificate for the patent.

In the present case, the following disadvantageous legal effects arose from the erroneous patent specification. Due to the change in the wording of the claims the scope of the patent was changed, in particular in claim 3 where the compound "ordoxycycline" was an unknown compound whereas the original intention was to specify a compound from the group of tetracycline compounds or doxycycline. Moreover, the wording of the claims at issue had become unclear and was open to interpretation in national court proceedings.

In view of decision G 1/10, in the present circumstances the only legal remedy available was the filing of an appeal. In point 12 of the Reasons of the decision the Enlarged Board held: *"If however the examining division proceeds to make a decision to grant which contains an error subsequently made by it, **so that the granted text is not that approved by the proprietor, then the proprietor is adversely affected by that decision and is entitled to appeal.** If, for example, the text of the patent which is the subject of the decision to grant includes an amended claim **which***

has after approval been erroneously changed by the examining division, then the patent proprietor can demonstrate that the examining division did not grant his patent with the text approved by him. It must then follow that the examining division failed to observe Article 113(2) EPC and the appeal should succeed by allowing interlocutory revision and reimbursement of the appeal fee as being equitable in view of the examining division's mistake (see respectively Article 109(1) and Rule 103(1) (a) EPC)" (emphasis added by the appellant).

The procedure laid down in the Guidelines for Examination in the EPO for the correction of errors in a patent specification (Guidelines, H-VI, 4) had no legal basis in the EPC and the EPO did not have a competence for performing corrections of patents after grant.

Questions to be referred to the Enlarged Board of Appeal

At the oral proceedings, the appellant asked the board to refer the following questions to the Enlarged Board of Appeal [sic]:

"a) Does the patent specification (B1 publication) constitute the 'text of the patent' as granted and is the 'text of the patent' thus an integral part of the decision to grant?

b) If yes, are corrections of 'printing errors' in the patent specification possible under GL H-VI 4 in view of the decision G 1/10, order 1, Rule 140 EPC is not available for corrections of the patent after grant?

c) If no, what constitutes the 'text of the patent' if the patent specification deviates from the text approved by the Applicant under Rule 71(5) to allow the Proprietor to demonstrate that the Examining Division 'did not grant his patent with the text approved by him' (G 1/10, Rn. 12, p. 20, 1.7)?"

The appellant presented arguments concerning the late submission of the request for referral and submitted that the referral served both alternatives mentioned in Article 112(1) EPC, *i.e.* to ensure uniform application of the law and because a point of law of fundamental importance arose.

Documents excluded from file inspection

The original versions of the appellant's letter dated 22 July 2016 with enclosure, the board's communication dated 28 July 2016 without enclosure and the appellant's letter dated 29 September 2016 should remain excluded from file inspection. Allowing the public to inspect the original versions of these documents would be prejudicial to the legitimate personal interests of natural persons. The documents only in the versions as submitted during the oral proceedings before the board should be open to file inspection. These versions were sufficient and appropriate for assessing the request for the extension of the relevant time limit.

Reasons for the Decision

Admissibility of the appeal

1. Under Article 107, first sentence, EPC any party to proceedings adversely affected by a decision may appeal. A party is adversely affected within the meaning of Article 107 EPC if the decision fails to meet that party's requests or diverges therefrom without the party's prior approval (see e.g. decisions T 114/82, T 115/82, OJ EPO 1983, 323, point 1 of the Reasons; T 244/85, OJ EPO 1988, 216, point 4 of the Reasons).
2. The present appeal was lodged in view of errors that appeared in the patent specification published in accordance with Article 98 EPC, *i.e.* in the "B1 publication". Claim 3 incorrectly refers to "ordoxycycline" (instead of "or doxycycline") and claim 14 to "Pli3pai-12S" (instead of "Pli3pal-12S").

The decision under appeal

3. Subject of the appeal is the examining division's decision dated 2 July 2015 to grant a European patent (hereinafter the "grant decision"). In the course of the proceedings, the appellant confirmed that the appeal was solely directed to that decision. This decision took effect on 29 July 2015, *i.e.* on the date on which the mention of the grant was published in the European Patent Bulletin.
4. The appellant considered the decision to be contrary to the requirements of Article 113(2) EPC because the text of the patent specification was not the text approved

by the appellant. The appellant therefore was adversely affected by the decision to grant a European patent because it diverged from its request without its approval being given.

Appellant adversely affected by the decision under appeal

5. First, the board notes that the grant decision itself does not contain the errors which subsequently appeared in the patent specification. Indeed, with respect to the text of the patent application forming the basis for the grant decision, the decision refers to the documents indicated in the communication pursuant to Rule 71(3) EPC dated 16 March 2015. Neither the set of claims referred to in that communication nor the copy of the text intended for grant enclosed with it ("Druckexemplar", see pages 69 and 71) contained the errors at issue (see above section II).

Accordingly, the documents upon which the examining division's intention to grant the patent was based, the text of which was subsequently approved by the appellant pursuant to Rule 71(5) EPC by payment of the relevant fee and by filing the translations of the claims, did not contain the errors at issue, but, instead, corresponded to the text in which the appellant wished to have the patent granted.

6. Second, on the question of which document establishes the definitive content of a patent the board notes the following.

- 6.1 Article 97(1) EPC provides that, if the examining division is of the opinion that the European patent application and the invention to which it relates meet the requirements of the EPC, *"it shall decide to grant*

a European patent, provided that the conditions laid down in the Implementing Regulations are fulfilled."

In accordance with Rule 71a(1) EPC, the decision to grant the European patent shall be issued if all fees have been paid, a translation of the claims in the two official languages of the European Patent Office ("EPO") other than the language of the proceedings has been filed and there is agreement as to the text to be granted. The invitation for paying the relevant fees, notably the fee for grant and publishing and for filing the translations of the claims, is contained in the communication under Rule 71(3) EPC in which the examining division informs the applicant of the text in which it intends to grant the patent and of the related bibliographic data. By duly paying the fees and filing the translations the appellant is deemed to have approved the text communicated to him and to have verified the bibliographic data contained in this communication in accordance with Rule 71(5) EPC.

Rule 71a(1), second sentence, EPC provides further that the grant decision *"shall state which text of the European patent application forms the basis for the decision"*. Under the current practice of the first instance, this is done by referring, in the grant decision (see Form 2006A), to the documents indicated in the communication pursuant to Rule 71(3) EPC and having been approved by the applicant. These documents are thus an integral part of the grant decision (see e.g. decisions G 1/10, OJ EPO 2013, 194, point 3 of the Reasons and T 850/95, OJ EPO 1996, 455, point 3.2 of the Reasons).

Hence, it follows from Article 97(1) and Rule 71a(1) EPC that the authentic content of a

European patent is determined only by the text on which the grant decision is based.

- 6.2 As soon as possible after the mention of the grant of the patent has been published in the European Patent Bulletin pursuant to Article 97(3) EPC, the EPO publishes the specification of the European patent (see Article 98 EPC). The contents and the form of the patent specification are governed by Rule 73 EPC and by the relevant Decision of the President of the EPO dated 12 July 2007 (here Special edition No. 3, OJ EPO 2007, D.3), respectively.

No legal effects are provided by the EPC with respect to the patent specification (see e.g. decision T 1644/10 dated 26 October 2011, points 7 *et seq.* of the Reasons). The board can therefore in this respect endorse the finding in Legal Advice No. 17/90 (OJ EPO 1990, 260, point 4) that *"the text of the patent specification has no binding character. Its function is confined to facilitating public access to the content of the granted patent, particularly the nature and scope of the industrial property right."*

- 6.3 Further support for the finding that the definitive text of the patent is established by the grant decision, and not by the text of the patent specification, can moreover be derived from the fact that effects are solely attached to the former. As from the date on which the grant decision takes effect, *i.e.* when the mention of the grant is published in the European Patent Bulletin (Article 97(3) EPC), for example, the periods for meeting the national validation requirements under Article 65 EPC start running for the patent proprietor, or, for third parties, for filing a notice of opposition. Moreover,

as of this date, the European patent confers the rights under Article 64(1) EPC, irrespective of whether the patent specification is published on that same date.

6.4 In addition, there is nothing in the EPC or legal texts relating to it from which it could be derived that errors in a patent specification have an "retroactive" effect on the grant decision or on the content of the granted patent.

7. Accordingly, from the above the board considers that the decision under appeal was correct and the appellant was not adversely affected by it.

Arguments of the appellant

8. In a first line of argument the appellant submitted that (see section XIII, first to fourth paragraph) the errors in the text intended for grant had been introduced by the examining division in an administrative procedure inside the EPO that could neither be controlled nor verified by the appellant. It followed from decision T 150/89 dated 29 April 1991 that the patent specification constituted documentary evidence of the text of the granted patent. This was demonstrated by the fact that the patent specification was the only document accepted as proof for the text of the granted patent in proceedings before national courts. Thus, only after the publication of the patent specification could an applicant learn that the examining division had granted the patent based on a text different from the text actually approved.

9. However, firstly, it has been found in point 5 above that the text referred to in the grant decision corresponds to the text in which the appellant wished

to have the patent granted, *i.e.* that no changes had been introduced by the examining division. In fact, during the oral proceedings before the board the appellant admitted that nothing in the file hinted to any further action by the examining division or that a different grant decision had been taken by it. Secondly, the appellant's suggested approach would seem to be contrary to the legal concept laid down in Article 97(1) and (3) and Rule 71a(1) EPC (see above point 6.1). Likewise, it is not derivable from decision T 150/89 (*supra*) relied upon by the appellant that a patent specification had a probative force such as to result in a correct grant decision being deemed incorrect.

10. In a second line of argument the appellant submitted (see section XIII, fifth and sixth paragraph), by referring to the certificate for the patent transmitted to the appellant by the EPO on 30 July 2015 that the patent specification itself had legal effects. This line of argument seems to be based on the premise that it is in fact the patent specification which establishes the definitive text of the granted patent.
11. With regard to this line of argument, the board refers to point 6.1 above where the board has concluded that it follows from Article 97(1) and Rule 71a(1) EPC that the authentic content of the European patent is determined only by the text on which the grant decision is based. In this respect, see for example also decision G 1/10 (*supra*), point 6 of the Reasons stating that "*Legal certainty is served by the grant decision establishing a definitive text of a patent for the purposes of any subsequent proceedings, whether at national or EPO level*", and as a corollary thereto, the

quotation from the Legal Advice cited already in point 6.2 above.

12. No other conclusion can be drawn in the light of the certificate for the European patent. The certificate under Rule 74 EPC issued by the EPO (Form 2031) certifies "*that a European patent has been granted in respect of the invention described in the patent specification for the Contracting States designated in the specification.*" Thus, the certificate serves the purpose of enabling the patent proprietor to prove entitlement to the patent right. It certainly does not establish that the patent specification constitutes the authentic text of the granted patent.
13. Consequently, the appellant's related argument concerning legal consequences from the incorrect patent specification, *i.e.* that compared to the text version approved by the appellant the scope of the patent had changed or the claim wording had become unclear, does not convince the board either.
14. In a third line of argument, the appellant submitted that the sole legal remedy available to the patent proprietor in the present circumstances was filing an appeal against the grant decision. This view was based on decision G 1/10 of the Enlarged Board of Appeal (*supra*) which the appellant considered to relate to the same circumstances as the present ones (see section XIII, seventh paragraph).
15. The board considers that the ruling in decision G 1/10 (*supra*) is not applicable to the present case because the circumstances are different. It is clear that, in this case, the error affecting the claims had occurred during the pre-grant procedure (see decision G 1/10,

supra, section II and referral decision T 1145/09 of 17 June 2010, section III) and that, accordingly, the documents on which the grant decision was based likewise contained the error. In addition, the Enlarged Board explicitly stated that its "*decision is therefore limited to corrections within grant decisions of the description, claims and drawings*" (see decision G 1/10, *supra*, point 3 of the Reasons).

16. In the present case the error was not present in the grant decision (see point 5 above), but occurred in post-grant proceedings. The board considers that the appropriate remedy in the present case, *i.e.* where the patent specification diverges from the text on which the grant decision is based, is outlined or in the Guidelines for Examination (see the edition of November 2014, H-VI, 3 and C-V, 10, applicable at the time of the grant decision was taken, or the currently valid edition of November 2015, H-VI, 4 and C-V, 10), namely that the text of the patent specification be brought into conformity with the content of the grant decision. The Guidelines indicate that such mistakes in the patent specification may be corrected at any time. This is done by means of a note in the European Patent Bulletin and publication of a corrigendum or a complete republication of the patent specification, the sole purpose being to bring the patent specification into line with the content of the grant decision.
17. The appellant submitted in this respect that the procedure laid down in the Guidelines had no legal basis in the EPC and the EPO did not have a competence for performing corrections of patents after grant.
18. The board is aware that the EPC does not explicitly deal with the situation where the patent specification

does not correctly reproduce the content of the European patent. Neither Rule 139 EPC, concerned with errors in documents filed with the EPO and available only as long as proceedings are pending before the EPO, nor Rule 140 EPC, concerned with errors in decisions, deal with this situation. Moreover, the act of publishing the patent specification does not qualify as a decision within the meaning of Article 106(1) and Rule 111 EPC and, as such, is not open to appeal.

19. However, it is established practice at the EPO that if the patent specification diverges from the text on which the grant decision is based, then the patent specification is corrected by the EPO (see point 17 above and also Legal Advice No. 17/90, *supra*, point 5 and decision T 150/89, *supra*, point 2 of the Reasons). In the board's opinion, this follows from Article 98 EPC because the obligation incumbent upon the EPO to publish the specification of the European patent encompasses the obligation that the text of the patent specification correctly reproduces the content of the European patent (see also decision T 1644/10, point 21 of the Reasons). It is in conformity with the principle of proper administration that errors in the patent specification may be corrected by the EPO at any time.

20. In the same context, the board is not aware of any decision of the boards of appeal, nor has one been cited by the appellant, in which a board denied the possibility of bringing the patent specification into conformity with the content of the granted patent in view of the absence of an explicit provision in the EPC.

21. In view of the above considerations and since the text on which the grant decision was based did not comprise the above-mentioned errors in claims 3 and 14, the board judges that the appellant was not adversely affected by the decision under appeal. Therefore, the appeal is to be rejected as inadmissible pursuant to Article 107 and Rule 101(1) EPC.

*Request for referral to the Enlarged Board of Appeal
(Article 112(1) EPC)*

22. According to Article 112(1)(a) EPC, a board shall, either of its own motion or upon request from a party, refer any question of law to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises. Pursuant to Article 21 RPBA a board shall refer the question to the Enlarged Board of Appeal, should it consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board.
23. The appellant requested, for the first time at the oral proceedings, that the board refer three questions to the Enlarged Board of Appeal (see section XIII above) should it be of the opinion that the appeal was not admissible. The board decided to admit the request into the proceedings (Article 13(1), (3) RPBA).
24. In support of its request, the appellant referred to both considerations mentioned in Article 112(1) EPC.
- 24.1 In respect of uniform application of the law, the appellant argued that deciding against admissibility of the appeal in the present case would deviate from

decisions G 1/10 (*supra*) and T 150/89 (*supra*). As can be taken from points 6.1, 9, 11, 15 and 19 above, the board cannot concur with the conclusions which the appellant has drawn from these decisions. Decision G 1/10 (*supra*) was not concerned with a scenario such as in the present case. The sentence in point 12 of the Reasons of this decision referred to by the appellant in question c) proposed for a referral (*"if, for example, the text of the patent which is the subject of the decision to grant includes an amended claim which has after approval been erroneously changed by the examining division, then the patent proprietor can demonstrate that the examining division did not grant his patent with the text approved by him"*) has to be read in the context of this decision. In the board's view, a scenario addressed by this sentence could be one, for example, in which, in reply to an initial communication under Rule 71(3) EPC containing an amended claim, further amendments have been requested by the applicant to which the examining division consented by issuing a second communication under Rule 71(3) EPC (*cf.* Rule 71(6) EPC), but the grant decision issued subsequently (after the applicant had paid the fee and filed the translations), erroneously refers to the documents of the initial communication under Rule 71(3) EPC. In such a situation, the proprietor can demonstrate that the granted text is not that approved by it. The board is therefore satisfied that the present decision does not deviate from those cited by the appellant.

24.2 As to the second consideration for a referral referred to in Article 112(1) EPC, namely, that of a point of law of fundamental importance arising, the appellant argued that in proceedings before national courts the B1 publication was taken as the basis for the

determining the extent of protection of the patent. That a point of law of fundamental importance, *i.e.* relevant to a substantial number of similar cases and therefore of interest not only to the parties in the present appeal but also to the public at large, arises, may be accepted by the board. However, a board of appeal only refers questions to the Enlarged Board of Appeal if it considers that a decision of the Enlarged Board is required (see Article 112(1)(a) EPC). Given that there are clear provisions in the EPC as to what constitutes the content of the European patent, and that there is established practice concerning the possibility of correcting the patent specification in case of divergence from the content of the granted patent, the board has no difficulties in reaching a decision in the case at hand. It therefore considers a decision by the Enlarged Board as not required.

25. Thus, the board rejects the appellant's request to refer questions to the Enlarged Board of Appeal.

Documents excluded from file inspection

26. Article 128(4) EPC provides that, after publication of the application, the files relating to the application and the resulting patent are open to file inspection, subject to the restrictions laid down in the Implementing Regulations, in particular Rule 144 EPC. The board derives from these provisions that excluding documents from file inspection is a narrow exception.

Rule 144(d) EPC provides for exclusion of a document from file inspection on the ground that an inspection would not serve the purpose of informing the public about the patent application or the patent. Pursuant to Article 1(2)(a) of the relevant Decision of the

President of the EPO (see section VII above), which is based on this provision, documents or parts thereof shall be excluded from file inspection *inter alia* if their inspection would be prejudicial to the legitimate personal interests of natural persons.

27. The appellant's letter dated 22 July 2016 contained a request for extension of the time limit for replying to a board's communication. The document also contained information on which the board had to base procedural decisions potentially relevant for the final outcome of the case. It therefore served the purpose of informing the public about the patent and could therefore not be excluded as a whole.
28. However, the board concurs with the appellant that inspection of the letter dated 22 July 2016 and its enclosure would be prejudicial to the legitimate personal interests of natural persons, to a large extent, especially as far as the reasoning provided by the appellant in support of the requested time extension was concerned. The redacted versions of the appellant's letter dated 22 July 2016 with enclosure, of the board's communication dated 28 July 2016 without enclosure and the appellant's letter dated 29 September 2016 submitted by the appellant during the oral proceedings (see annex to the minutes of the oral proceedings) take this into account.
29. Accordingly, the board decided that only these redacted versions would be open to file inspection and the original versions of the documents and their enclosures would remain excluded from file inspection.

Order

For these reasons it is decided that:

1. The appellant's letter dated 22 July 2016 with enclosure, the board's communication dated 28 July 2016 without enclosure and the appellant's letter dated 29 September 2016, all of them only in the versions as submitted during the oral proceedings before the board, are open to file inspection.

The original versions of these documents remain excluded from file inspection.

2. The request for referral of questions to the Enlarged Board is rejected.
3. The appeal is rejected as inadmissible.

The Registrar:

The Chairwoman:



P. Cremona

G. Alt

Decision electronically authenticated