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**Datasheet for the decision
of 11 November 2020**

Case Number: T 0646/20 - 3.2.04

Application Number: 07747361.9

Publication Number: 2007981

IPC: F03D7/02, F03D1/06

Language of the proceedings: EN

Title of invention:

WIND TURBINE WITH SLENDER BLADE

Applicant:

Wobben Properties GmbH

Headword:

Relevant legal provisions:

EPC Art. 107, 121

Keyword:

Further processing - time limit for requesting further
processing - request admissible (no)
Admissibility of appeal - party adversely affected by decision
(no)

Decisions cited:

G 0001/10, T 0001/92, J 0012/83, G 0001/09, T 0493/08

Catchword:

Addition of further Designation States after grant (no)



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Case Number: T 0646/20 - 3.2.04

D E C I S I O N
of Technical Board of Appeal 3.2.04
of 11 November 2020

Appellant: Wobben Properties GmbH
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 4 July 2019 to grant a European Patent, following examination of application No. 07747361.9, pursuant to Article 97(1) EPC**

Composition of the Board:

Chairman C. Heath
Members: G. Martin Gonzalez
J. Wright

Summary of Facts and Submissions

I. Subject matter of this appeal

This is a case where the patentee appeals against the grant of its own patent. Most of the arguments revolve around the question of whether the patentee was adversely affected by such grant, but also around questions on the interpretation of the remedy of "further processing" under Art. 121 EPC.

II. Examination phase of the patent

European patent application 07747361 (corresponding to EP 2007981 after grant) was filed on 2 April 2007, that is, before the EPC 2000 came into force on 13 December 2007. Under the EPC 1973, EPC Member States had to be designated individually, and a designation fee for each Member State had to be paid. In the present case, designation fees for five Member States (DE, DK, ES, GB and PT) were paid, but not for the others. The intention to designate and pay for these five Member States had been so stated in the request for entry into the European phase published on 31 October 2008. In regard of the other Member States and Extension States, a "noting of loss of rights pursuant to Rule 112(1) EPC" (in the following "Notification") was sent to the applicant's representative on 5 December 2008. As the application was pending when the EPC 2000 came into force, the EPC 2000 applied to the Notification and its consequences (Decision of the AC of 28 June 2001, OJ 2007 SA 1 p. 197, Art. 1 (5)). The Notification mentioned the possibility of further processing (Art. 121 EPC) within a non-extendable period of two months after notification. The appellant states that the

Notification was never received, which the Board under Rule 125 (4) EPC has to accept in the absence of any proof to the contrary. With letter dated 4 March 2013, the applicant sent a general enquiry to the EPO in regard of "which European Countries the patent has been applied and if European Countries can still be added to this list". It appears that the applicant subsequently tried to pay further designation fees, yet the public file does not indicate any details in this regard. The subsequent examination phase led to the exchange of various communications between the applicant and the examining division that on 23 April 2019 issued a communication under Rule 71(3) EPC with an intention to grant (in the following "Communication"). The Communication listed as bibliographic data the Contracting States "DE, DK, ES, GB and PT" and invited the applicant to either approve the text and bibliographic data by filing a translation of the claims and paying the prescribed fees or request reasoned amendments within four months. On 19 June 2019, the applicant filed a translation of the claims, requested "to now issue the decision to grant" and paid the fees due.

III. Appealed decision and Appeal

On 4 July 2019, the Office issued the decision to grant (now subject to appeal) that indicated 31 July as the date when the decision to grant would be published in the European Patent Bulletin. On the very day of 31 July 2019, the applicant filed a request for further processing in regard of the loss of rights for the remaining EPC Member States and Extension States communicated in the Notification of 2008, but not received by the applicant. With this request, the applicant filed the corresponding fee for further

processing and the designation fees for the remainder of the EPC Member States and Extension States. Against the decision to grant, the appellant on 12 September 2019 filed a notice of appeal, paid the appeal fee on the same day and supplied the reasons on 13 November 2019. The Board in its communication dated 26 May 2020 raised questions in relation to the admissibility of the appeal, to which the appellant replied with a letter dated 6 November 2020. Oral proceedings were held on 11 November 2020 by way of videoconference at the end of which the appellant **requested** that the decision under appeal be set aside and that the patent be granted in respect of the EPC Member States AT BE BG CH/LI CY CZ DE DK EE ES FI FR GB GR HU IE IS IT LT LU LV MC MT NL PL PT RO SE SI SK TR

and the Extension States

AL BA HR MK RS

and to correspondingly correct the designated Contracting States and Extension States in respect of divisional patent application 19188863.5 filed on 29 July 2019.

IV. The appellant's arguments

In regard of admissibility, the appellant argued as follows: The Communication of 23 April 2020 allowed the applicant a four-months period to reply. Despite the applicant's approval of 19 June 2020, the examining division should have deferred any decision to grant until the expiry of this four-months period (i.e. until 23 August), as the applicant was entitled to file its approval or notify its disapproval up until this point in time. As the applicant had filed an approval on 19

June and a disapproval on 31 July, that is, both within the time limit of four months, the examining division prematurely and mistakenly granted a patent, thereby adversely affecting the appellant. The appellant in this regard relies on decision **T 1/92**, OJ 1993, 685. Further, the approval communicated on 6 July did not imply any waiver of rights in regard of pending procedural issues such as the request for further processing. Finally, an adverse effect was also manifest in that due to the decision to grant, the divisional application 19188863.5 was likewise limited to a designation of five Member States.

As to the substantive issues, the appellant argued that the request for further processing had to be granted: As the 2008 Notification of loss of rights had not been received and its contents only recently been discovered, the request for further processing of 31 July 2019 was filed within two months from obtaining knowledge of the contents of the Notification of 2008. Such request could be filed at any point in time even after the grant of the patent, provided that the conditions of Art. 121 and Rule 135 EPC were complied with. There was nothing to indicate that further processing for an application could no longer be obtained once the patent had been granted.

Reasons for the Decision

1. Admissibility of the Appeal

1.1 It is good law that in order to correct the designation of Member States in a decision to grant, the only available remedy is to file an appeal against such decision (decision **T 493/08** of 29 September 2009, point 6.2.1 of the reasons). Yet in order to file an appeal under Art. 107 EPC, the

appellant must be adversely affected. This is questionable in a case where the applicant has approved the text intended for grant and the corresponding bibliographical data as set out in the Communication. The Enlarged Board of Appeal has so held in a case where the applicant after having approved the text intended for grant appealed against the decision to grant in order to obtain a correction of the granted patent (decision **G 1/10** published in OJ 2013, 194).

1.2 The relevant passages of this decision read as follows:

"10. Further, a patent applicant is obliged to approve the text in which his patent is to be granted (see Article 97(1) and Rule 71(3)(4) and (5) EPC). He must be informed of the text in which the examining division intends to grant a patent and is deemed to approve that text if he proceeds to pay the requisite fees and file translated claims within a period of four months (see Rule 71(3) EPC). Otherwise he must within that four months period request amendments or corrections (see Rule 71(4) EPC, which specifically mentions "correction of errors under Rule 139"); and there is also a procedure for further amendment and approval in the event those first amendments or corrections are not consented to by the examining division (see Rule 71(5) EPC).

11. If, given the opportunity to check the patent text before approving it, an applicant does not draw any errors to the attention of the examining division and thus ensure his approval is limited to the correct text, then the responsibility for any errors remaining in that text after grant should be his alone, whether the error was made (or introduced) by him or by the examining division...

12. 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)."

- 1.3 The Board is mindful of the fact that the above decision has explicitly refrained from deciding the question whether the above should apply not only to the approved text, but also to bibliographic data, as "bibliographic data do not form part of the text of the patent" (**G 1/10**, part 4 of the reasons) and the issue thus did not need to be decided. However, the Enlarged Board in the above passage highlighted that the distinction between text and bibliographical data stemmed from the fact that the previous version of Rule 71(3) EPC did not require the Office to communicate the bibliographical data in the communication notifying the intention to grant, which in the current version it does.
- 1.4 The Board thus takes the view that the ruling of decision **G 1/10** in regard of the approved text equally applies to those bibliographical data that relate to the scope of the

patent and submitted to the applicant in the communication under Rule 71(3) EPC. Just as the text of a patent, the designated States determine the scope (in this case the geographical scope) of the patent and are thus of vital interest to third parties and the public at large. This was not further questioned by the appellant.

1.5 The appellant however argued that the decision to grant issued on 4 July 2019 was premature and failed to take into account that the applicant had four months from the 23 April 2019 to communicate its approval - or disapproval - with the bibliographical data. As the applicant's disapproval was voiced with the request for further processing on 31 July 2019, in other words within the four months period given to the applicant, it was clear that the applicant did not approve, or at least given that there was approval and disapproval, the issue was ambiguous and no decision of grant could be issued in line with decision **T 1/92** of 24 April 1992.

1.6 The headnote of this decision reads as follows:

„1. If, according to Rule 51(6) EPC it cannot be established beyond doubt at the end of the time limit under Rule 51(4) EPC, that the applicant approves the text in which the Examining Division intends to grant the European patent, the Examining Division cannot proceed to the grant of the patent and Rule 51(5) EPC applies. (cf. points 2 and 4.1 of the Reasons for the Decision).

2. The applicant is adversely affected in the sense of Article 107, first sentence, EPC if the patent is nevertheless granted (cf. point 1 of the Reasons for the Decision).“

1.7 Although the above headnote might prima facie support the appellant's case, the decision was rendered in factual and legal circumstances that are not comparable to the present case. For one, the applicant in decision **T 1/92** sent a notice of disapproval before the Office had taken any

decision to grant. And further, under the law then in force, approval by the applicant was followed by the Office's request to pay the applicable fees and file the translation of the claims. In other words, when the applicant registered its disapproval in case **T 1/92**, the application was by no means ready for grant, as the applicant still had to perform various acts that would allow the application to be granted. This is no longer the case under the Rule 71(3) EPC, as submitting the translation of the claims and paying the applicable fees is deemed to be the applicant's approval to a grant in the version as communicated, Rule 71(5) EPC. In the present case, the examining division issued a decision to grant based on the applicant's explicit approval and request. No further positive approval is required in these circumstances (decision **J 12/83**, OJ 1985, 6, point 5 of the reasons).

- 1.8 The principle as established in decision **T 1/92** could thus only assist the appellant's case if there was indeed a duty by the examining division to defer the grant of a patent until the period of four months stipulated in the communication under Rule 71(3) EPC had lapsed. In other words, regardless of whether the applicant had submitted the translation of the claims, paid the fees due and even "requested to now issue the decision to grant".
- 1.9 The Board finds no support for any obligation of the examining division to take such course of action and defer a decision of grant until the expiry of the four months period in a case where the applicant at any given time within this period of time gives approval to grant and thereby allows the examining division to issue a corresponding decision. The four months period stipulated in Rule 71(3) EPC should give the applicant sufficient time to examine the version of the patent intended for grant, to

furnish the translation of the claims and to pay the necessary fees. Once the case is ready for grant, it would be rather strange if the examining division had to defer a decision for the eventuality that the applicant had second thoughts. In other words, the period of four months is addressed to the applicant, not the examining division. Once the applicant has given its approval, there is nothing that would prevent the examining division from taking a decision.

1.10 The Board therefore concludes that neither can the appellant avail itself of the reasoning expressed in decision **T 1/92**, as this decision related to contradictory statements of the applicant prior to the decision of grant being taken by the examining division, nor can the applicant require the examining division to defer a decision of grant until the expiry of the four months period, as the latter is meant as a period of time wherein the applicant should express its approval or disapproval. Once the applicant has done so, the case is ready for a decision and the examining division is not at fault - nor therefore the appellant adversely affected - if such decision to grant is indeed rendered without further delay.

1.11 The Board thus holds that the applicant's approval to the notification under Rule 71(3) EPC also related to the designated Member States, and the decision of grant subsequently rendered by the examining division matched the contents of the notification and the applicant's approval.

1.12 In a further line of argument, the appellant stated that even though it agreed to the designation of the five Member States, the applicant did so in ignorance of the fact that extension to the other Member States and

Extension States could still be requested by way of further processing. In other words, that the applicant when sending its approval was unaware of a procedural option that could still be taken, namely the request for further processing related to the loss of rights for the other Member States and Extension States.

- 1.13 The Board is not convinced by this argument. From decision **G 1/10** (as above), the Board concludes that in the interest of legal certainty, the patent in the version as granted should no longer be open to amendments that the applicant had "adequate means at his disposal" to remedy beforehand. In the Board's view, it is incumbent on the applicant to verify the complete file (which is the applicant's own one, after all) including the publicly available register in order to spot any inconsistencies it may wish to draw attention to. Inconsistencies related to text and the designated Member States in the communication under Rule 71(3) EPC and not raised in response thereto must be considered as approved by applicant.

By the same token, it is the applicant's responsibility to know and make use of the procedural options available to it for achieving the protection it seeks. Any inconsistency between what the applicant seeks and the intention to grant as communicated to it under Rule 71(3) EPC cannot be retroactively corrected if it approves the latter.

- 1.14 Also the appellant's argument that an approval sent in response to a Rule 71(3) communication could not be interpreted as a waiver of further options or remedies does not convince the Board. Every approval of the text of a patent implies a waiver of the remaining infinity of texts in which a patent could be granted.

1.15 Finally, the appellant argued an adverse effect the decision under appeal would have on the divisional application. In the Board's view, this is not an independent cause of action, but merely a consequence of the legal relationship and dependency of a divisional application on the parent application.

1.16 The Board thus concludes that the appellant is not adversely affected by the decision under appeal and consequently the appeal is inadmissible.

2. Request for further processing

2.1 Not least in light of the appellant's argument that the availability of the remedy of further processing at the time the decision was rendered constituted an adverse effect (*quod non*), the Board finds it appropriate to address this issue.

2.2 In the case of grant an application ceases to be pending on the day before the mention of its grant is published, **G 1/09** (OJ EPO 2011, 336), reasons 4.3.2. The request for further processing was thus filed at the stage when the patent application was no longer pending.

2.3 The appellant took the view that the remedy of further processing did not require a pending application, as one typical situation where further processing could be requested was the case of the application being deemed withdrawn.

2.4 The Board accepts that the remedy of further processing does not require a pending application at the time the request is filed. But already the term "further processing of an application" indicates that it requires an *application*. An application that is deemed withdrawn can return to the stage of a pending application once the request for further processing is successful, but an application that has been granted cannot.

An application that has turned into a granted patent cannot be further processed as an application just as a caterpillar that has morphed into a butterfly cannot return to the stage of a caterpillar.

This is reinforced by the consideration that the non-existence of a time limit for further processing, as advocated by the appellant, might cause considerable problems if such request could be filed during opposition proceedings or even beyond. Third parties relying on a grant in a limited number of Member States could commence the commercial working of the invention in non-designated States and would be left high and dry if the request for further processing led to a subsequent designation of other Member States without the law providing for a good faith clause as in Art. 122 (5) EPC (re-establishment of rights). It would further be less than clear whether a subsequent grant in relation to other, previously non-designated countries would give rise to a new opposition period, and if so, whether for all states (as seems to be the position taken by decision **T 493/08**, as above, point 6.2.1 of the reasons) or only those newly designated (as was the Board's position in the annex to the summons to oral proceedings in this case - after all, even the appellant argued an adverse effect only for the Member States that had not been designated).

Not least decision **G 1/10** (point 6 of the reasons) has stressed that "from its grant, a European patent ceases to be within the jurisdiction of the EPO and becomes, subject only to the possibility of later EPO proceedings by way of opposition or limitation, a bundle of national patents each of which falls within the exclusive jurisdiction of a designated Contracting State." Allowing the remedy of further processing for the entire lifespan of the patent would disregard the fundamental limitation of the EPO's

jurisdiction and devalue the legal certainty provided to third parties by the act of grant.

2.5 Given the Board's interpretation of an applicant's approval in response to a communication under Rule 71(3), the Board further observes that even in the absence of receiving the Notification of loss of rights, the two-months period as specified in Rule 135 EPC should commence from the date of the Communication. This was the point in time when it fell on the applicant to check the complete file of its application at least in regard of the text and designated Member States mentioned in the Communication, and thus the point in time when the applicant should have had constructive knowledge of the designation of five Member States and the failure to designate the others. As the Communication dates from 23 April 2019, the request for further processing filed on 31 July 2019 was made out of time.

2.6 Only in passing, the Board observes that the notification of a loss of rights under Rule 112(1) EPC is a "voluntary service" of the EPO (Case Law, 9th ed. 2019, III.K.4.1), and the Board has some reservations as to whether the lack of receipt of such notice can indeed allow the applicant to request further processing even years after such notification has been dispatched. In the case of designation fees, it is (or was under the EPC 1973) after all the applicant's conscious choice of designating certain countries, but not others, that triggered the notification of a loss of rights in the first place.

Following from the above considerations under 1., the appeal has been dismissed as inadmissible.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Magouliotis

C. Heath

Decision electronically authenticated