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**Datasheet for the decision  
of 19 May 2021**

**Case Number:** T 0408/21 - 3.3.05

**Application Number:** 13855497.7

**Publication Number:** 2920328

**IPC:** C21D9/04, C21D1/667, C22C38/04,  
C22C38/14

**Language of the proceedings:** EN

**Title of invention:**

METHOD OF MAKING HIGH STRENGTH STEEL CRANE RAIL

**Applicant:**

ArcelorMittal

**Headword:**

Making high strength steel/ArcelorMittal

**Relevant legal provisions:**

EPC Art. 107, 113(2)  
EPC R. 71(3), 71(5)

**Keyword:**

Admissibility of appeal - party adversely affected by decision  
Basis of decision - text submitted or agreed by applicant (no)

**Decisions cited:**

G 0001/10, G 0001/12, T 2081/16, T 1003/19, T 0265/20,  
T 2277/19, J 0017/04, J 0011/18, T 0843/03, T 0762/05,  
T 1869/12

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0408/21 - 3.3.05

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.05**  
**of 19 May 2021**

**Appellant:** ArcelorMittal  
(Patent Proprietor) 24-26 Boulevard d'Avranches  
1160 Luxembourg (LU)

**Representative:** Lavoix  
Bayerstraße 83  
80335 München (DE)

**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 14 January 2021 granting European patent No. 2920328 pursuant to Article 97(1) EPC.**

**Composition of the Board:**

**Chairman** E. Bendl  
**Members:** G. Glod  
S. Fernández de Córdoba

## **Summary of Facts and Submissions**

- I. The applicant's (appellant's) appeal lies from the examining division's decision dated 14 January 2021 to grant a patent on the basis of application documents as indicated in a communication under Rule 71(3) EPC dated 24 August 2020 following the examination of European patent application No. 13 855 497.7.
- II. The original application contained
- description pages 1 to 14,
  - claims 1 to 19 and
  - drawing sheets 1/6 to 6/6 with figures 1, 2a, 2b, 3, 4 and 5.
- III. In the extended European search report all parts indicated above were properly listed. In the course of examination proceedings the examining division issued communications pursuant to Article 94(3) EPC on 2 November 2017, 11 July 2018 and 12 August 2019. Throughout the proceedings before the examining division, amendment or deletion of the drawing sheets was never suggested by the examining division nor requested by the appellant.
- IV. On 24 August 2020 a communication under Rule 71(3) EPC was sent to the appellant informing them of the examining division's intention to grant a European patent on the basis of its application, listing the following parts:

- description, pages 1 to 14 filed in electronic form on 4 May 2018;
- claims, numbers 1 to 13 filed in electronic form on 6 December 2019.

In addition, it was indicated that pages 1-4 of the description had been amended in order to adapt them to the claims.

- V. The appellant subsequently filed a translation of the claims in the two other official languages and paid the fee for grant and publication on 18 December 2020.
- VI. On 19 March 2021 the appellant appealed the examining division's decision to grant a patent. In its statement of grounds of appeal of 6 April 2021, the appellant argued that the communication pursuant to Rule 71(3) EPC did not contain any reference to an amendment in the drawings. The case was very similar to that underlying decision T 1003/19. Following that rationale the appellant had not been informed of the text in which the examining division intended to grant the patent.
- VII. The appellant requested that the examining division's decision to grant a patent be set aside and that a patent be granted on the basis of the documents underlying the impugned decision, additionally including drawing sheets 1/6 to 6/6 with figures 1, 2a, 2b, 3, 4 and 5.

## **Reasons for the Decision**

1. Admissibility of the appeal
  - 1.1 The appeal is admissible.
  - 1.2 The Board acknowledges that the appellant is adversely affected by the omission of the drawings.
  - 1.3 The granted version of the patent does not correspond to the text it had submitted, or to any of the versions it had agreed to, or to a text deemed to have been approved by it (see below, point 1.12). There is, therefore, a discrepancy between the appellant's request and the examining division's decision.

When looking at the file history it is apparent that the original application contained description pages 1 to 14, claims 1 to 19 and drawing sheets 1/6 to 6/6 with figures 1, 2a, 2b, 3, 4 and 5. There was no indication that the figures would be amended, let alone withdrawn.

In the extended European search report reference was made to pages 1 to 14 of the description as published, claims 1 to 19 as published and drawing sheets 1 to 6 as published. In response to this, the (now) appellant amended the claims and the description by submission of 14 October 2016, thereby making explicit reference to the extended European search report by indicating that (only) the claims and the description were amended (first page, paragraph 2).

In the first communication pursuant to Article 94(3) EPC of 2 November 2017 it was mentioned at the top of

the first page that the examination was being carried out on the basis of these amended application documents, namely description pages 1 to 14 and claims 1 to 15, both filed in electronic form on 14 October 2016. No mention of the drawings was made.

A reasonable understanding of this indication is that only the amended parts of the specification forming part of the renewed examination and being discussed in the following text of the communication were listed, while the drawings, which were neither amended nor withdrawn, were still part of the application documents, but not subject to the considerations given in the communication at issue.

This understanding is also in line with the fact that the later communications of 1 July 2018 and 12 August 2019 also only referred to the latest amendments of the description and the claims at the top of page 1. The communication under Rule 71(3) EPC also only referred to the description and the claims and did not refer to the drawings.

Therefore, all these communications consistently only pointed to the amended parts (i.e. claims and description) of the application.

- 1.4 When trying to clarify the intention behind an action or request, this is frequently done in the Case Law of the Boards of Appeal by identifying the "true will" of the actors in a case. This applies to the will of the applicant/appellant (e.g. J 17/04, point 11 of the Reasons; J 11/18, points 4 and 5 of the Reasons) as well as of the examining division (e.g. T 843/03, point 1 of the Reasons; T 762/05, point 1 of the Reasons; T 1869/12, headnote). Even the Enlarged Board's

decision, G 1/12, elaborates in detail on the notion of the "true intention" behind an action performed (points 30, 31 and 44 of the grounds).

- 1.5 Rule 71(3) EPC, first sentence, reads as follows:  
"Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it *intends* to grant it and of the related bibliographic data." (emphasis added).
- 1.6 In the Board's view this clearly implies the need to indicate those versions of the description, the claims and the drawings which, after detailed and in-depth legal and technical examination, proved to meet the requirements of the EPC. Normally the documents indicated in a communication according to Rule 71(3) EPC correspond to the applicant's request and to the examining division's intention; however, in a case where there appears to be severe doubts as to whether the documents indicated in Rule 71(3) EPC were actually those intended to be granted by the examining division, the Board considers the above-mentioned clarification of the "true will" of the examining division an appropriate means.
- 1.7 The documents indicated in the communication under Rule 71(3) EPC are apparently not in line with those resulting from the examination of the file for the following reasons:
- The drawings formed part of the application as originally filed and were never withdrawn by the (now) appellant.
  - Only the claims and the description were objected to by the examining division and amended by the appellant, but not the drawings.



- Form 2004C does not contain a hint that any deletions or amendments were made by the examining division.
- There is a clear discrepancy between the description referring to the drawings and the absence of any drawings in the "Druckexemplar", which should have been remarked upon by the examining division when allegedly deleting the drawings.

1.8 Apparently neither the members of the examining division nor the (now) appellant realised that the drawings were missing and that the documents referred to in the communication pursuant to Rule 71(3) EPC did not correspond to the documents according to the appellant's request, which included the drawings.

1.9 Therefore, in more detail and in line with the T 1003/19 (point 2.4.4 of the Reasons) the Board concludes that the examining division did not indicate in the communication according to Rule 71(3) EPC the text it intended to grant for the following reasons:

The European Patent Office is held to decide upon a European patent application only in the text submitted, or agreed, by the applicant (Article 113(2) EPC); however, there was never an indication that the figures would be deleted. Such a deletion would also be completely contradictory to the text of the description proposed for grant. The proposed text contains, on page 4, a chapter entitled "Brief Description of the Drawings". In addition, throughout the description reference is made to all the figures. Therefore, it is entirely evident that the examining division considered the figures to be part of the specification on the basis of which a patent should be granted.

It is common practice at the EPO to only suggest amendments which the examining division can reasonably expect the applicant to accept, e.g. making a statement of invention in the description consistent with the claims or correcting any linguistic or other minor errors. In this case description pages 1 to 4 were made consistent with the claims. Removing all drawing sheets including the figures that are mentioned in the description is not an amendment that can be suggested.

It is also good standard practice at the EPO to include every amendment suggested by the examining division not only in the text on the basis of which the patent is to be granted, i.e. in the "Druckexemplar" annexed to the communication under Rule 71(3) EPC (Form 2004C), but also to indicate them in the communication. A special field is provided at the bottom of page 1 of Form 2004C in which amendments proposed by the examining division are to be indicated. In this case, this field was used by the examining division to indicate the amendments of pages 1 to 4 of the description. Deletion of the drawing sheets is not mentioned. Hence, there is no indication that the examining division intended to include such amendments to the application documents submitted by the appellant.

- 1.10 In view of the history summarised above, it can only be concluded that the examining division had no reason or intention to delete the drawings from the list of documents intended for grant.
- 1.11 The Board therefore concludes that in this case neither the documents referred to in Form 2004C nor the documents making up the "Druckexemplar" corresponded to the text, i.e. the description, claims and drawing

sheets, in which the examining division intended to grant the European patent.

1.12 The examining division therefore did not communicate the text it intended to grant by using Form 2004C. Following T 2081/16 (point 1.4.5 of the Reasons) and T 1003/19 (point 2.4.5 of the Reasons), Rule 71(5) EPC correspondingly does not apply in this case, as in the step preceding the deemed approval the applicant has to be informed of the text in which the examining division intends to grant the patent according to Rule 71(3) EPC. Although the (then) applicant received a Rule 71(3) EPC communication, the documents indicated were not those which the examining division intended to grant.

1.13 The Board is aware of decision T 265/20, in which the competent Board did not follow the approach of the above-cited decisions T 1003/19 and T 2081/16 without considering it necessary to refer a question to the Enlarged Board of Appeal.

This case is distinguished from said decision not least in the fact that, as outlined above, the Board could identify convincing reasons why the examining division's true intention was not reflected by the text of the Rule 71(3) EPC communication, whereas the Board in case T 265/20 was not in a position to draw such a conclusion for "the case at hand" (point 2.11 of the Reasons).

This Board considers that the detailed reasons given in T 1003/19 and T 2081/16 are fully convincing and, in cases such as this, lead to a result that prevents the patent applicant from being seriously prejudiced by the absence of a possibility to request corrections under

Rule 140 EPC (see G 1/10, points 8 to 12 of the Reasons). Therefore, the Board sees no need for and refrains from its own referral to the Enlarged Board.

1.14 As the text on the basis of which the patent was granted was not in accordance with the appellant's request, the appellant is adversely affected by the decision under Article 97(1) EPC. With all other requirements pursuant to Rule 101(1) EPC being met, the Board concludes that the appeal is admissible.

1.15 As far as an adverse effect to the appellant is concerned, the facts of this case are different from T 2277/19, in which the Board held the appeal to be inadmissible because additionally incorporating older versions of the drawings into the text intended for grant did not adversely affect the appellant.

## 2. Allowability of the appeal

A decision to grant pursuant to Article 97(1) EPC which is based on an application in a text which was neither submitted nor agreed to by the appellant, as is the case here, does not comply with Article 113(2) EPC. The decision under appeal is therefore to be set aside.

## 3. G 01/10

By analogy with decision T 1003/19 (point 4 of the Reasons) the present situation is different from that underlying G 01/10. In the present case the text intended for grant had not been communicated to the appellant, so Rule 71(5) EPC did not yet apply.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division with the order to grant a patent on the basis of the following documents:
  - description, pages 1 to 14 filed in electronic form on 4 May 2018;
  - claims 1 to 13 filed in electronic form on 6 December 2019;
  - drawing sheets 1/6 to 6/6 as published.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated