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D E C I S I O N
of 4 May 2000

Case Number: T 1008/99 - 3.4.2

Application Number: 97201407.0

Publication Number: 0791860

IPC: G03G 5/06

Language of the proceedings: EN

Title of invention:
Organic photoconductor

Applicant:
INDIGO N.V.

Opponent:
-

Headword:
Correction of errors in a divisional application

Relevant legal provisions:
EPC Art. 76(1), 123(2)
EPC R. 88

Keyword:
"Correction of errors in a divisional application by
replacement of the description as filed by the description of
the parent application - no"

Decisions cited:
G 0003/89, G 0002/95, T 0284/85, T 0441/92, T 0873/94

Catchword:
-



Case Number: T 1008/99 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 4 May 2000

Appellant: INDIGO N.V.
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Decision under appeal: Decision of the Examining Division of the European Patent Office posted 29 June 1999 rejecting the applicant's requests for a correction pursuant to Rule 88 EPC and for re-establishment of rights in connection with European patent application No. 97 201 407.0.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. Klein
B. J. Schachenmann
M. A. Rayner
V. Di Cerbo

Summary of Facts and Submissions

- I. The appeal lies from a decision of the Examining Division rejecting, *inter alia*, a request for correction of errors pursuant to Rule 88 EPC in the European patent application No. 97 201 407.0 filed as divisional application of European patent applications No. 90 907 505.3 and/or 93 203 341.8.
- II. The rejected request aimed at a replacement of the mistakenly filed description and claims of the divisional application referred to above by the description of the parent application No. 93 203 341.8. The Examining Division, applying the principles of the decision G 2/95 of the Enlarged Board of Appeal, came to the conclusion that such replacement by way of correction under Rule 88 EPC contravened Article 123(2) EPC since it introduced subject-matter extending beyond the content of the divisional application as filed.
- III. In the statement setting out the grounds of appeal the appellant argued essentially as follows:

The first instance had applied the principles laid down in the decision G 2/95 incorrectly. For divisional applications the filing date was the date of the parent application and, consequently, the original disclosure was the disclosure of the parent application. In this respect, a divisional application was nothing more than a separate application for subject-matter already disclosed in the parent application. Thus, allowing the appellant's request would not lead to an extension of the original disclosure after the original filing date and would therefore comply with the principles set out in decision G 2/95.

IV. In an annex to the summons to oral proceedings requested by the appellant on an auxiliary basis the Board pointed to the jurisprudence of the Boards of Appeal according to which divisional applications, once they have been validly filed, were separate and independent from their parent applications and must therefore comply independently with all requirements of the EPC, including Article 123(2) EPC. Moreover, the Board expressed doubts whether the requested correction was obvious in the sense that it was immediately evident that nothing else would have been intended than what was offered as the correction (Rule 88 EPC, second sentence). It was also mentioned that the application in suit had been published and that, therefore, a replacement of the published description could affect the public interest.

V. In the course of the oral proceedings the appellant referred to the decision T 441/92 of the Boards of Appeal which, in his view, described a "two step" approach. In a first step, a divisional application should be examined with respect to the requirements of Article 76(1) EPC. Thereafter, and only once the requirements of Article 76(1) were met, the application should be examined for the other requirements of the EPC, including Article 123(2) EPC. Thus, allowing the appellant's request for correction would merely ensure that the conditions of Article 76(1) EPC were met. If the application documents were first corrected in accordance with Article 76(1) EPC, they would then meet the requirements of Article 123(2) EPC as, subsequently, no amendment to these documents would have taken place.

As far as the other requirements for a correction under

Rule 88 EPC were concerned, the appellant submitted that it was not unusual for a divisional application to have exactly the same description as the parent application. It was not, therefore, unreasonable to assume that the applicant indeed intended to file a description corresponding to that of the parent application. As regards the interest of the public, the appellant pointed out that the application in suit was published with a clear statement that it was a divisional application and that the (already published) parent applications were clearly indicated on the front page. Thus, everybody could easily inform himself about the content of the parent applications so that it was immediately apparent that an error must have been made.

VI. Consequently, the appellant requested that the decision under appeal be set aside and that the following requests for correction be granted:

- replacement of the description and claims as filed by the description and the claims filed with letter on 4 May 1998 (main request), or
- replacement of the description as filed by the description filed with letter on 4 May 1998 (auxiliary request).

Reasons for the Decision

1. The appeal complies with the provisions of Rule 65 EPC and is therefore admissible.
2. In the circumstances of the present case, the request for correction of errors concerns a European divisional

application which was filed with a wrong description not related to the earlier (parent) applications. The wrongly filed description should therefore be replaced by the description of one of the parent applications mentioned in the request for grant of the divisional application.

2.1 Rule 88 EPC refers to correction of errors in documents filed with the EPO. If the correction concerns the description, claims or drawings, it must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction (Rule 88 EPC, second sentence). This provision was the subject of the opinion G 3/89 (OJ EPO 1993, 117) and the decision G 2/95 (OJ EPO 1996, 555) of the Enlarged Board of Appeal.

2.2 According to the opinion G 3/89, point 3 of the reasons, the parts of a European patent application relating to the disclosure (the description, claims and drawings) may be corrected under Rule 88, second sentence, EPC only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of these documents as filed. Thus, the parts of a European patent application relating to the disclosure must contain such an obvious error that a skilled person is in no doubt that this information is not correct and cannot be meant to read as such. This is not the case if incorrect information only becomes apparent in the light of the proposed correction (see point 5 of the reasons of G 3/89).

In the present circumstances, the application was filed

as a divisional application under Article 76 EPC which, according to the constant jurisprudence (see e.g. T 873/94, OJ EPO 1997, 456), is to be examined quite separately from its parent application and must itself comply independently with all the various requirements of the EPC. For the purposes of Rule 88 EPC, the error must therefore be **apparent from the divisional application itself** and the parent application cannot be used to demonstrate that the error was obvious. Even if it is apparent from the filed description, claims and drawings that they do not go together, it is not immediately clear from the application itself which of these parts is not correct. Already for this reason the requested correction under Rule 88 EPC, second sentence, EPC is not allowable.

- 2.3 Moreover, according to decision G 2/95, point 2 of the reasons, the interpretation of Rule 88 EPC, second sentence, must be in accord with Article 123(2) EPC which means that a correction under Rule 88 EPC is bound by Article 123(2) EPC, in so far as it relates to the content of the European patent application as filed. A correction may therefore be made only within the limits of the content of the parts of the application which determine the disclosure of the invention, namely the description, claims and drawings. Other documents may only be used for proving the common general knowledge on the date of filing.

As far as a divisional application pursuant to Article 76 EPC is concerned, the content of the application which determines the disclosure is that of the divisional application **as filed**, rather than that of the earlier (parent) application. This follows from the constant jurisprudence of the Boards of Appeal

according to which a divisional application must comply with both the requirements of Article 76(1) and Article 123(2) EPC, the latter referring to extensions beyond the content of the divisional application **as filed** (see T 284/85 of 24 November 1998, point 3 of the reasons; T 441/92 of 10 March 1995, point 4.1 of the reasons; T 873/94, OJ EPO 1997, 456, point 1 of the reasons).

Since, in the present case, the requested correction concerns the disclosure, it is inadmissible in so far as it introduces subject-matter extending beyond the content of the divisional application as filed. It was never contested by the appellant that the requested correction would indeed introduce such new subject-matter compared to the divisional application as filed.

3. However, the appellant argued that, in contrast to the jurisprudence referred to above, the only bar to an amendment or correction of the content of a divisional application was the disclosure available on the deemed filing date, i.e. the filing date of the parent application. The Board is unable to share this view for the following reasons.

3.1 First, it should be considered that, according to Article 76(1) EPC, second sentence, a divisional application may only be filed in respect of "subject-matter" which does not extend beyond the content of the earlier application. This implies the filing of application documents defining the "subject-matter" of the divisional. If, for this purpose, the content of the parent application could be used, Article 76(1) EPC would be deprived of any purpose.

- 3.2 Neither is there any legal basis for the "two step" approach (see paragraph V, supra) as derived by the appellant from decision T 441/92. As set out in that decision (point 4.2 of the reasons), "the divisional application must neither extend beyond the content of the earlier (parent) application as filed nor be amended **after filing** in such a way that it contains subject matter which extend beyond the content of the divisional application **as filed**" (emphasis added). Thus, the decision referred to by the appellant does not support his "two step" approach but refers, for amendments after filing, to the content of the divisional application as filed.
4. For these reasons the appellants's requests for correction of errors under Rule 88 EPC, second sentence, must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

E. Turrini