

xannex3.97

**ANLAGE 3**

**ANNEX 3**

**ANNEXE 3**

**LEITSÄTZE der ENTSCHEIDUNGEN des Jahres 1996, die im ABI. EPA veröffentlicht wurden oder zur Veröffentlichung vorgesehen sind\***

**HEADNOTES to DECISIONS delivered in 1996 which have already been published in OJ EPO, or are scheduled for publication\***

**SOMMAIRES des DECISIONS rendues en 1996 qui ont déjà été publiées dans le JO OEB, ou dont la publication y est prévue\***

**CASE NUMBER: G 1/95, OJ EPO 1996, 615**

**APPLICANT: DE LA RUE**

**OPPONENT: GAO**

**HEADWORD: Fresh grounds for opposition**

**BOARD OF APPEAL: EBA**

**DATE: 19.7.96**

**APPLICATION NO: 5302866.0**

**HEADNOTE:**

In a case where a patent has been opposed on the grounds set out in Article 100(a) EPC, but the opposition has only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based upon Articles 52(1) and (2) EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee.

**AKTENZEICHEN: G 2/95, ABI. EPA 1996, 555**

**ANMELDER: ATOTECH**

**STICHWORT: Austausch der Anmeldungsunterlagen**

**BESCHWERDEKAMMER: GBK**

**DATUM: 14.5.96**

**ANMELDENUMMER: 89118789.0**

**LEITSATZ:**

Die der Großen Beschwerdekammer vorgelegte Rechtsfrage ist wie folgt zu beantworten:  
Die vollständigen Unterlagen einer europäischen Patentanmeldung, also Beschreibung, Patentansprüche und Zeichnungen, können nicht im Wege der Berichtigung nach Regel 88 EPÜ durch andere Unterlagen ersetzt werden, die der Anmelder mit seinem Erteilungsantrag hatte einreichen wollen.

**CASE NUMBER: G 6/95, OJ EPO 1996, 649**

**APPLICANT: GE CHEMICALS**

**OPPONENT: BAYER AG**

**HEADWORD: Interpretation of Rule 71a(1) EPC**

**BOARD OF APPEAL: EBA**

**DATE: 24.7.96**

**APPLICATION NO: 86302328.9**

**HEADNOTE:**

Rule 71a(1) EPC does not apply to the boards of appeal.

**CASE NUMBER: G 7/95, OJ EPO 1996, 626**  
**APPLICANT: ETHICON INC.**  
**OPPONENT: UNITED STATES SURGICAL CORPORATION**  
**HEADWORD: Fresh grounds for opposition**  
**BOARD OF APPEAL: EBA**  
**DATE: 19.7.96**  
**APPLICATION NO: 85305391.6**

HEADNOTE:

In a case where a patent has been opposed under Article 100(a) EPC on the ground that the claims lack an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Articles 52(1) and 54 EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lack novelty in view of the closest prior art document may be considered in the context of deciding upon the ground of lack of inventive step.

**CASE NUMBER: G 8/95, OJ EPO 1996, 481**  
**APPLICANT: UNITED STATES GYPSUM**  
**HEADWORD: Correction of decision to grant**  
**BOARD OF APPEAL: EBA**  
**DATE: 16.4.96**  
**APPLICATION NO: 9311913.1**

HEADNOTE:

An appeal from a decision of an Examining Division refusing a request under Rule 89 EPC for correction of the decision to grant is to be decided by a technical board of appeal.

**CASE NUMBER: J 10/93, OJ EPO 1997, 91**

**APPLICANT: TOUZANI, WILLIAM**

**OPPONENT: COLLAPSIBLE BOTTLE OF AMERICA**

**HEADWORD: Transfer**

**BOARD OF APPEAL: 3.1.1**

**DATE: 14.6.96**

**APPLICATION NO: 87201334.7**

**HEADNOTE:**

A transfer can be recorded in the Register of European Patents even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application.

**CASE NUMBER: J 18/93, OJ EPO 1997, \*\*\***

**APPLICANT: CARDIAC PACEMAKERS, INC.**

**HEADWORD: Correction of mistake**

**BOARD OF APPEAL: 3.1.1**

**DATE: 2.9.94**

**APPLICATION NO: 92303280.9**

**HEADNOTE:**

A correction substituting the name of the applicant is allowable under Rule 88 EPC if there is sufficient evidence to support the request for correction. Rule 88, second sentence, is not applicable.

**AKTENZEICHEN: J 8/94, ABI. EPA 1997, 17**

**ANMELDER: PHOTOGRAPHIC SCIENCES**

**STICHWORT: Wiedereinsetzung**

**BESCHWERDEKAMMER: 3.1.1**

**DATUM: 7.12.95**

**ANMELDENUMMER: 91105595.2**

LEITSATZ:

Die Wiedereinsetzung in die Nachfrist der Regel 85b EPÜ für die Stellung des Prüfungsantrags ist gemäß Artikel 122 (5) EPÜ ausgeschlossen.

**CASE NUMBER: J 16/94, OJ EPO 1997, \*\*\***

**APPLICANT: APPLIED RESEARCH SYSTEMS ARS HOLDING N.V.**

**HEADWORD: Notice of appeal**

**BOARD OF APPEAL: 3.1.1**

**DATE: 10.6.96**

**APPLICATION NO: 93203101.6**

HEADNOTE:

For a notice of appeal to comply with Article 108, first sentence, and Rule 64(b) EPC, it must express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, ie conditional on the main request not being allowed by the department of first instance, is therefore inadmissible.

**AKTENZEICHEN: J 20/94, ABI. EPA 1996,181**

**STICHWORT: Zuerkennung eines Anmeldetags**

**BESCHWERDEKAMMER: 3.1.1**

**DATUM: 24.7.95**

LEITSATZ:

Der Großen Beschwerdekammer werden folgende Rechtsfragen vorgelegt:

I. Ist es für die Begründung eines Anmeldetags einer europäischen Patentanmeldung erforderlich, daß die eingereichte Anmeldung neben einer Beschreibung zumindest einen Patentanspruch enthält, der gesondert von der Beschreibung formuliert und als solcher erkennbar ist?

II. Wenn die Frage zu 1 verneint wird: Genügt es für die Begründung des Anmeldetags im Sinne des Artikels 80 EPÜ, daß zumindest ein Patentanspruch zwar nicht ausdrücklich formuliert, aber aus der beschriebenen Erfindung herleitbar ist?

III. Wenn die Frage zu 2 bejaht wird: Welche Anforderungen sind an die Herleitbarkeit eines nicht ausdrücklich formulierten Patentanspruchs zu stellen:

a) Ist es erforderlich, daß aus dem Text der Beschreibung unmittelbar und eindeutig zumindest ein Anspruch erkennbar ist, oder

b) ist es ausreichend, wenn die Beschreibung eine Erfindung so offenbart, daß ein zu schützender Gegenstand erkennbar ist, für den ein Anspruch formuliert werden könnte?

**AKTENZEICHEN: J 21/94, ABI. EPA 1996, 16**

**ANMELDER: ATOTECH**

**STICHWORT: Berichtigung**

**BESCHWERDEKAMMER: 3.1.1**

**DATUM: 12.4.95**

**ANMELDENUMMER: 89118789.0**

LEITSATZ:

Der Großen Beschwerdekammer wird folgende Rechtsfrage vorgelegt: Können im Wege der Berichtigung nach Regel 88 EPÜ die vollständigen Unterlagen einer europäischen Patentanmeldung, also Beschreibung, Patentansprüche und Zeichnungen, durch andere Unterlagen ersetzt werden, die der Anmelder mit seinem Erteilungsantrag hätte einreichen wollen?

**CASE NUMBER: J 29/95, OJ EPO 1996, 489**

**APPLICANT: AXIS**

**HEADWORD: Divisional application**

**BOARD OF APPEAL: 3.1.1**

**DATE: 30.1.96**

**APPLICATION NO: 2103552.3**

HEADNOTE:

I. The examining division, when allowing amendments submitted by the applicant in reply to the communication under Rule 51(4) EPC, can establish the applicant's approval of the text intended for grant pursuant to Rule 51(6) EPC on the basis of the amendments and of the texts communicated to the applicant to which no amendments have been submitted.

II.. A valid approval of the text intended for grant requires that it is clear which text the applicant has approved. This is not the case if the communication under Rule 51(4) EPC refers to an

enclosed text which is not actually annexed.

**CASE NUMBER: T 597/92, OJ EPO 1996, 135**

**APPLICANT: BLASCHIM**

**OPPONENT: SYNTEX PHARMACEUTICALS**

**HEADWORD: Rearrangement reaction**

**BOARD OF APPEAL: 3.3.1**

**DATE: 1.3.95**

**APPLICATION NO: 81200211.1**

HEADNOTE:

There is no basis in the EPC for the substantiation of inventive step by way of disclaimer. This method may only be used by way of exception for avoiding anticipation, if the subject-matter of a claim cannot be restricted on the basis of the original disclosure in positive terms without unduly impairing its clarity and conciseness.

A hypothetical novelty attack in possible proceedings before a national court, unsupported by pleadings or evidence on the file before the EPO, is not a sufficient reason under the EPC for allowing a disclaimer.

**CASE NUMBER: T 694/92, OJ EPO 1997, \*\*\***

**APPLICANT: Mycogen Plant Science, Inc.**

**OPPONENT: UNILEVER N.V.**

**CENTERNS UNGDOMSFÖRBUND**

**SANDOZ LTD.**

**MONSANTO COMPANY**

**KONINKIJK KWEEKBEDRIJF EN ZAADHANDEL D.J. VAN DER HAVE B.V.**

**STICHTING OPPOSITIE PLANTOCTROOI P/A STUDIUM GENERALE**



**GEN-ETHISCHES NETZWERK**

**MAX-PLANCK-GESELLSCHAFT**

**HEADWORD: Modifying plant cells**

**BOARD OF APPEAL: 3.3.4**

**DATE: 8.5.96**

**APPLICATION NO: 84302533.9**

HEADNOTE:

I. Where an invention relates to the actual realisation of a technical effect anticipated at a theoretical level in the prior art, a proper balance must be found between, on the one hand, the actual technical contribution to the state of the art by said invention, and, on the other hand, the terms in which it is claimed, so that, if patent protection is granted, its scope is fair and adequate (see point 3 of the Reasons).

II. In cases where the gist of the claimed invention consists in the achievement of a given technical effect by known techniques in different areas of application and serious doubts exist as to whether this effect can readily be obtained for the whole range of applications claimed, ample technical details and more than one example may be necessary in order to support claims of a broad scope. Accordingly, claims of broad scope are not allowable if the skilled person, after reading the description, is not able to readily perform the invention over the whole area claimed without undue burden and without needing inventive skill (see points 5 and 19 of the Reasons).

**CASE NUMBER: T 939/92, OJ EPO 1996, 309**

**APPLICANT: AGREVO**

**HEADWORD: Triazoles**

**BOARD OF APPEAL: 3.3.1**

**DATE: 12.9.95**

**APPLICATION NO: 87303463.1**

HEADNOTE:

I. If a claim concerns a group of chemical compounds per se, an objection of lack of support by the description pursuant to Article 84 EPC cannot properly be raised for the sole reason that the description does not contain sufficient information in order to make it credible that an alleged technical effect (which is not, however, a part of the definition of the claimed compounds) is obtained by all the compounds claimed (see Reasons No. 2.2.2).

II. The question as to whether or not such a technical effect is achieved by all the chemical compounds covered by such a claim may properly arise under Article 56 EPC, if this technical effect turns out to be the sole reason for the alleged inventiveness of these compounds (Reasons Nos. 2.4 to 2.6).

**CASE NUMBER: T 951/92, OJ EPO 1996, 53**

**APPLICANT: NEC CORPORATION**

**HEADWORD: Opportunity to comment**

**BOARD OF APPEAL: 3.4.1**

**DATE: 15.2.95**

**APPLICATION NO: 86116953.0**

HEADNOTE:

I. In the context of the examining procedure under Articles 96 and 97 EPC, Article 113(1) EPC is intended to ensure that before a decision refusing an application for non-compliance with a requirement of the EPC is issued, the applicant has been clearly informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance is based, so that he knows in advance of the decision both that the application may be refused and why it may be refused, and so that he may have a proper opportunity to comment upon such reasons and/or to propose amendments so as to avoid refusal of the application.

II. If a communication under Rule 51(3) EPC and pursuant to Article 96(2) EPC does not set out the essential legal and factual reasoning which would lead to a finding that a requirement of the EPC has not been met, then a decision based upon such a finding cannot be issued without contravening Article 113(1) EPC, unless and until a communication has been issued

which does contain such essential reasoning. If a decision is issued in the absence of a communication containing such essential reasoning, Article 96(2) EPC is also contravened, since in order to avoid contravening Article 113(1) EPC it was "necessary" to issue a further communication (following decision T 640/91, OJ EPO 1994, 918).

**CASE NUMBER: T 39/93, OJ EPO 1997, 134**

**APPLICANT: ALLIED COLLOIDS LIMITED**

**OPPONENT: SNF FLOERGER**

**HEADWORD: Polymer powders**

**BOARD OF APPEAL: 3.3.3**

**DATE: 14.2.96**

**APPLICATION NO: 5304517.7**

HEADNOTE:

I. New Rule 71a EPC should not be construed as an invitation to file new evidence or other material departing from the legal and factual framework of issues and grounds pleaded and evidenced throughout the proceedings prior to the hearing of the appeal (point 3.3 of Reasons).

II. The technical problem as originally presented, in accordance with Rule 27(1)(c) EPC, in the application or patent in suit, which is to be regarded as the "subjective" technical problem, may require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee. This reformulation yields a definition of the "objective" technical problem. The latter represents the ultimate residue (effect), corresponding to the objective contribution provided by the subject-matter defined in the relevant claim (features) (Points 5.3.1, 5.3.2, 5.3.3 of the Reasons).

III. Whilst generally accepted definitions of the notional "person skilled in the art" do not always use identical language to define the qualities of such a person, they have one thing in common, namely that none of them suggests that he is possessed of any inventive capability. It is the presence of such capability in the inventor which sets him apart from the notional

skilled person (point 7.8.4 of the Reasons).

**CASE NUMBER: T 167/93, OJ EPO 1997, \*\*\***

**APPLICANT: THE PROCTER & GAMBLE COMPANY**

**OPPONENT: UNILEVER PLC / UNILEVER N.V.**

**HEADWORD: Bleaching agents**

**BOARD OF APPEAL: 3.3.1**

**DATE: 3.5.96**

**APPLICATION NO: 3200938.5**

HEADNOTE:

A decision of a board of appeal on appeal from an examining division has no binding effect in subsequent opposition proceedings or on appeal therefrom, having regard both to the EPC and 'res judicata' principle(s).

**CASE NUMBER: T 583/93, OJ EPO 1996, 496**

**APPLICANT: HYMO**

**OPPONENT: SNF FLOERGER**

**HEADWORD: Water-soluble polymer dispersion**

**BOARD OF APPEAL: 3.3.3**

**DATE: 4.1.96**

**APPLICATION NO: 5308398.8**

HEADNOTE:

I. A lack of communication between the proprietor and its licensee does not afford sufficient justification upon which the board can exercise its discretion to admit requests filed at an extremely late stage into the appeal.

II. Whereas according to the boards' jurisprudence the deletion from a claim of features consistently described as essential is not permissible under Article 123(2) EPC, the converse is not true, so that any attempt to interpret Article 123(2) EPC in the sense that the introduction into a claim of features previously described as non-essential would not be permissible, must fail.

**N° DU RECOURS: T 798/93, OJ EPO 1997, \*\*\***

**DEMANDEUR: LOHR INDUSTRIE**

**OPPOSANT: MONTI, UMBERTO, ING.**

**REFERENCE: Identification du véritable opposant/CONVOI ROUTIER**

**CHAMBRE DE RECOURS: 3.2.1**

**DATE: 20.6.96**

**N° DE LA DEMANDE: 86440073.4**

**SOMMAIRE:**

I. L' article 99(1) CBE, qui ouvre la procédure d'opposition à "toute personne", crée une présomption selon laquelle le véritable opposant est celui qui a formé opposition. En effet, la CBE et les dispositions qui en résultent n'imposent aucune condition de qualité ou d'intérêt à agir. Il convient en conséquence de rejeter les demandes tendant à ce que l'opposition soit déclarée irrecevable quand elles sont fondées comme en l'espèce, soit sur un défaut de qualité de l'opposant tel que : sa profession (mandataire européen agréé), son domaine technique de compétence (différent de celui du brevet objet de l'opposition) ; soit sur un défaut d'intérêt à agir (déclaration de l'opposant selon laquelle il n'agissait que dans le but de compléter sa formation).

II. La présomption de l'article 99(1) CBE ne peut être renversée que lorsque la preuve est apportée, en cours de procédure, qu'un tiers se prétend le véritable opposant. Dès lors, afin de respecter le principe établi par la jurisprudence des chambres de recours selon lequel "les oppositions doivent être formées et poursuivies ... en excluant ... toute incertitude juridique", il peut être demandé à la "personne" qui a déposé l'acte d'opposition en son nom de contribuer à lever le doute (cf. T 635/88).

**CASE NUMBER: T 386/94, OJ EPO 1996, 658**

**APPLICANT: UNILEVER N.V.**

**OPPONENT:**

**CELLTECH LIMITED**

**CHR. HANSENS LABORATORIUM A/S**

**HEADWORD: Chymosin**

**BOARD OF APPEAL: 3.3.4**

**DATE: 11.1.96**

**APPLICATION NO: 82201272.0**

**HEADNOTE:**

Inventive step may be acknowledged in the field of gene technology if there is no reasonable expectation of success that the cloning and expression of a given gene can be carried out. However, in a case where, at the priority date, a skilled person can expect to perform the cloning and expression of a gene in a fairly straightforward manner, and the cloning and expression, although requiring much work, does not pose such problems as to prove that the expectation of success was ill-founded, inventive step cannot be acknowledged.

**AKTENZEICHEN: T 501/94, ABI. EPA 1997, 193**

**ANMELDER: DELPHI AUTOMOTIVE SYSTEMS DEUTSCHLAND GMBH**

**EINSPRECHENDER: AMP INCORPORATED**

**BESCHWERDEKAMMER: 3.5.2**

**DATUM: 10.7.96**

**ANMELDENUMMER: 86100730.0**

**LEITSÄTZE:**

I. Erst nach den wesentlichen Parteivorträgen während einer mündlichen Verhandlung von

einem Einsprechenden genannter und zur Einreichung angebotener schriftlicher Stand der Technik braucht von der Kammer als im Sinne von Artikel 114 (2) EPÜ verspätet vorgebracht nicht zu den Akten genommen zu werden.

II. Ein in einem Streitpatent als nächstkommender oder wesentlicher Stand der Technik angegebenes Dokument, von dem ausgehend die in der Beschreibung dargelegte technische Aufgabe verständlich wird, befindet sich im Einspruchs(beschwerde)verfahren, auch wenn es innerhalb der Einspruchsfrist nicht ausdrücklich aufgegriffen worden ist (vgl. Entscheidung T 536/88, ABI. EPA 1992, 638). Hingegen befindet sich ein in einer Entgegnung als nächstkommender oder wesentlicher Stand der Technik angegebenes Dokument, von dem ausgehend die in der Entgegnung dargelegte technische Aufgabe verständlich wird, nicht automatisch im Einspruchs(beschwerde)verfahren, wenn es innerhalb der Einspruchsfrist nicht ausdrücklich aufgegriffen worden ist.

**CASE NUMBER: T 840/94, OJ EPO 1996, 680**

**APPLICANT: UNION CAMP**

**OPPONENT: AKZO N.V.**

**HEADWORD: Revocation**

**BOARD OF APPEAL: 3.3.1**

**DATE: 26.3.96**

**APPLICATION NO: 87115024.9**

HEADNOTE:

If a party instructs the authorised representative not to pass on any further communication from the EPO it cannot then rely on the fact that information notified to the authorised representative and necessary for continuing the proceedings was lacking.

**CASE NUMBER: T 873/94, OJ EPO 1997, \*\*\***

**APPLICANT: KABUSHIKI KAISHA TOSHIBA**

**HEADWORD: Amended divisional application**

**BOARD OF APPEAL: 3.4.1**

**DATE: 10.7.96**

**APPLICATION NO: 89116770.2**

HEADNOTE:

I. A divisional application has to comply with the requirements of both Article 76(1) EPC and Article 123(2) EPC. Article 76(1) EPC governs the filing of a divisional application and therefore whether it is entitled to the filing date of the parent application and has the same benefit of right to priority as the parent application. Article 123(2) EPC governs amendments to the divisional application subsequent to its filing.

II. Where a proposal for amendment of an application involves the addition of a limiting feature to a claim, application of a "novelty test" is not appropriate to determine whether or not the amendment complies with Article 123(2) EPC, because as explained in Decision G 1/93 (OJ EPO 1994, 541), "Whether or not the adding of an undisclosed feature limiting the scope of protection...would be contrary to the purpose of Article 123(2) EPC...depends on the circumstances".

**NO DU RECOURS: T 958/94, JO OEB 1997, 242**

**DEMANDEUR: THERAPEUTIQUES SUBSTITUTIVES**

**MOT-CLE: Agent antitumoral**

**CHAMBRE DE RECOURS: 3.3.2**

**DATE: 30.9.96**

**NO DE LA DEMANDE: 91904092.3**

SOMMAIRE:

Un brevet européen peut être délivré sur la base de revendications ayant pour objet l'utilisation d'une substance ou d'une composition pour obtenir un médicament destiné à une application thérapeutique déterminée nouvelle et comportant un caractère inventif (G 6/83). Cette utilisation peut être revendiquée aussi bien sous la forme d'application (ou utilisation)



d'une substance ou composition pour obtenir un médicament que celle de procédé (ou méthode) d'obtention d'un médicament caractérisé par la mise en oeuvre de ladite substance.

**CASE NUMBER: T 274/95, OJ EPO 1997, 99**

**APPLICANT: MARS INCORPORATED**

**OPPONENT: WH MÜNZPRÜFER DIETMAR TRENNER GMBH**

**HEADWORD: Re-introduced ground of opposition**

**BOARD OF APPEAL: 3.4.1**

**DATE: 2.2.96**

**APPLICATION NO: 85308677.5**

HEADNOTE:

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the opposition division proceedings (here: a statement to that effect is made by the opponent during oral proceedings), the opposition division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent (following opinion G 10/91).

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the opposition division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of opinion G 10/91, and may consequently be re-introduced into the appeal proceedings without the agreement of the patent proprietor, in the exercise of the board of appeal's discretion.

**CASE NUMBER: T 337/95, OJ EPO 1996, 628**

**APPLICANT: NIHON NOHYAKU**

**HEADWORD: Lower alkyl**

**BOARD OF APPEAL: 3.3.1**

**DATE: 30.1.96**

**APPLICATION NO: 90103338.1**

HEADNOTE:

I. Claims have to be clear for the sake of legal certainty (Nos. 2.2 to 2.4 of the reasons).

II. Since, in the absence of any unambiguous reference point, a relative term such as "lower alkyl" in the field of organic chemistry does not have a generally accepted meaning with respect to its maximum number of carbon atoms, such a term is ambiguous and therefore not suitable for clearly defining the subject-matter for which protection is sought in a claim which is directed to a group of organic compounds per se (No. 2.8 of the reasons).

**CASE NUMBER: T 556/95, OJ EPO 1997, 205**

**APPLICANT: SECURITY TECHNOLOGY CORPORATION**

**HEADWORD: Undeniable systems**

**BOARD OF APPEAL: 3.5.1**

**DATE: 8.8.96**

**APPLICATION NO: 88202620.6**

HEADNOTE:

The conditions for amendment of an application laid down in Article 123(1) EPC in conjunction with Rule 86(3) EPC remain applicable so long as the examining division retains competence over the application, including after the issue of a communication under Rule 51(6) EPC, and until the decision to refuse or grant the application is taken (G 7/93). The right to be heard at oral proceedings under Article 116(1) EPC subsists so long as proceedings are pending before the EPO, and a request for oral proceedings must be granted (ie oral proceedings must

be appointed) before any request of a party (whether procedural or substantive) is decided against that party so as to cause them a loss of rights. This applies also in the case of a request for oral proceedings to discuss amendments submitted after the issue of a communication under Rule 51(6) EPC. The discretion of the examining division under Rule 86(3) EPC must be exercised in such circumstances having regard to Article 116(1) EPC. The Enlarged Board has no power to limit the application of Article 116(1) EPC by means of any guidance it may lay down as to how an examining division should exercise its discretion under Rule 86(3) EPC.

**CASE NUMBER: T 850/95, OJ EPO 1997, 152**

**APPLICANT: UNITED STATES GYPSUM COMPANY**

**HEADWORD: Correction of decision to grant/US GYPSUM III**

**BOARD OF APPEAL: 3.3.2**

**DATE: 12.7.96**

**APPLICATION NO: 9311913.1**

HEADNOTE:

I. In a decision to grant, if the text given for grant is not and obviously cannot be the text corresponding to the real intention of the examining division, there is an obvious mistake within the meaning of Rule 89 EPC and the text erroneously indicated can be replaced by the text on which the division actually wanted to base its decision.

II. The filing of replacement pages for the whole specification should be avoided unless the extent of amendments makes it absolutely necessary.

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\* Diese Leitsätze erscheinen in der Anlage 3 nur in der Verfahrenssprache.

\* These headnotes are published in Annex 3 in the language of the proceedings only.

\* Ces sommaires ne sont publiés dans l'Annexe 3 que dans la langue de la procédure.