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Decision G 1/10 of the European Patent Office (EPO) Enlarged Board of Appeal on Corrections to a Patent Under Rule 140 EPC

Summary of the Decision

This decision concerns whether Rule 140 EPC can be used to correct the text of a patent. Rule 140 EPC states:

'In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected.'

Overtaking existing practice, the Enlarged Board decided that Rule 140 EPC could not be used to correct the text of a patent, even though the text of the patent is part of the decision to grant.

Background

After grant patents can be amended at the EPO during either the opposition or limitation procedures. In addition the EPO had allowed corrections to patents to be made under Rule 140 EPC. The reasoning behind this was that text of the patent was deemed to be part of the decision to grant and thus could be corrected under this rule. Requesting correction of a patent at the EPO is clearly preferable to having to request correction at each national patent office where the European patent had been validated.

The Facts of the Decision

The decision follows a referral of questions from the Technical Board of Appeal handling appeal T1145/09. The case concerns an opposition in which the patentee requested that the opposition be stayed and the case be remanded back to the examining division to correct an error in claim 1. The opposition division issued a decision for this to happen which was appealed by the opponent.

In requesting that the correction be made under Rule 140 EPC by the examining division, the patentee would have benefitted in two ways:

- the correction would have been made in a procedure in which the opponent was not party, and thus would have been unable to comment or appeal against a decision to allow the correction
- the patentee may have been able to prevent the opposition division from looking at whether the corrected claim covered subject matter not previously covered, in violation of Article 123(3) EPC.



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The Technical Board of Appeal's Concerns

The Appeal Board recognised that allowing the patentee's request to correct would have many implications, including possible unfairness towards the opponent. When referring questions to the Enlarged Board it pointed out the following:

- The stay of the opposition proceedings to allow the examining division to decide on the correction would lead to considerable delay
- Rule 140 EPC does not refer to a time limit for the corrections. However if the correction is requested during opposition then 'parallel' proceedings come into existence, which in this case would greatly affect the outcome of the opposition
- The *travaux préparatoires* show that the legislator was particularly concerned that correction under the Rule should not adversely affect third parties.
- Remanding the case to the examining division would change the procedure from *inter partes* to *ex partes*, which would disadvantage the opponent.

The President of the EPO also filed comments along the same lines.

The Questions Referred to the Enlarged Board

1. Is a patent proprietor's request for correction of the grant decision under Rule 140 EPC which was filed after the initiation of opposition proceedings admissible? In particular, should the absence of a time limit in Rule 140 EPC be interpreted such that a correction under Rule 140 EPC of errors in decisions can be made at any time?
2. If such a request is considered to be admissible, does the Examining Division have to decide on this request in *ex parte* proceedings in a binding manner so that the Opposition Division is precluded from examining whether the correction decision amounts to an unallowable amendment of the granted patent?

The Decision of the Enlarged Board

The Enlarged Board took the view that allowing corrections to the text of a patent under Rule 140 EPC should not be allowed given the problems which it could lead to (as described by the Technical Board of Appeal). The Enlarged Board did not provide any legal reasoning to justify its interpretation of Rule 140 EPC, but simply took the view that not allowing corrections to the text of the patent provided was the fairest way to proceed. It also pointed out that in its view the purpose of Rule 140 EPC is for correction of errors by the EPO, and thus could not be used by patentees to correct their own errors.



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The Enlarged Board thus answered the questions referred to it as follows:

1. Since Rule 140 EPC is not available to correct the text of a patent, the patent proprietor's request for such a correction is inadmissible whenever made, including after the initiation of opposition proceedings.
2. In view of the answer to the first referred question, the second referred question requires no answer.

Is the Decision Correct?

Given the facts of the case before it the decision seems to be the right one. There would have been too many negative repercussions in allowing a correction under Rule 140 EPC via the examining division. Whilst the decision prevents patentees from circumventing the opposition division when making corrections, which must be correct, it also makes the system stricter and less user-friendly. However it is probably an unavoidable effect of contentious proceedings that they cause case law to become stricter. That has already happened at the EPO for added matter and priority entitlement where the EPO is probably the strictest patent office.

Correction of Bibliographic Data

One of the *amicus curiae* briefs that was filed considered the issue of correction of a priority claim under Rule 140 EPC. The priority claim forms part of the bibliographic data which is also part of the decision to grant. The Enlarged Board made it clear that its decision only applies to correcting the text of the patent, and thus does not affect the existing practice of allowing correction of the bibliographic data under Rule 140 EPC.