

“Request to correct patent/FISHER-ROSEMOUNT”

European Patent Convention, Arts. 2(2), 19(1), 70(1)(3), 97(1), 100, 109(1), 112(1)(a), 113(2), 123(2)(3), 138; EPC Rules 71, 91, 95, 103(1)(a), 139, 140

Decision of the Enlarged Board of Appeal

23 July 2012 – Case No. G 1/10

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The questions referred to the Enlarged Board of Appeal are answered as follows:

1. Since Rule 140 EPC is not available to correct the text of a patent, a 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.

Available at <http://www.epo.org/law-practice/case-law-appeals/pdf/g100001ex1.pdf>.

European Patent Office – Practice of Correcting the Text of Granted Patents Must Cease

In the case underlying the referral of a point of law to the Enlarged Board of Appeal (EBA), the patent had been opposed on the grounds that a feature in claim 1 of the granted patent had not been disclosed in the application as filed. The proprietor of the patent argued that this resulted from a typographical error made when amending this claim during grant proceedings and that the word “position” in this feature should read “portion”.

On his request, the opposition division took the interlocutory decision to stay opposition proceedings and to remit the case to the examining division for a decision on the proprietor's request for correction of the decision to grant under Rule 140 EPC. On the opponent's appeal, the Board of Appeal considered that there was a fundamental point of law and referred the questions to the EBA whether a

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request for correction of the grant decision filed after the initiation of opposition proceedings is admissible and, if yes, whether the examining division's decision is binding upon the opposition division (see the EBA's answers above).

In the reasons for the decision, the EBA emphasises the need for legal certainty and the protection of third parties and notes that the proprietor has adequate remedies available to ensure that the text of the granted patent is correct. Before grant, the text of the application intended for grant has to be communicated to the applicant for his final approval and an error like a misspelt or incorrect word can be corrected under Rule 139 EPC. If the decision to grant contains an error made by the examining division after the applicant's final approval, so that the text of the patent as granted is not that approved by the proprietor, the proprietor is adversely affected and is entitled to appeal the grant decision.

In addition, the EBA considers that the absence of a possibility to request corrections of the text of the patent under Rule 140 EPC should not prejudice patent proprietors. If on the one hand a correction would be obvious, there could be no surprise and no adverse effect on third parties, because all concerned should read the patent as if corrected. If on the other hand a correction would be less than immediately obvious, then it should not in any event be allowed under Rule 140 EPC.

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