

El artículo 14(2) del CPE: ¿oportunidad o trampa?

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Sobre la posibilidad de corregir la traducción de una solicitud de patente europea presentada en un idioma que no sea uno de los tres oficiales

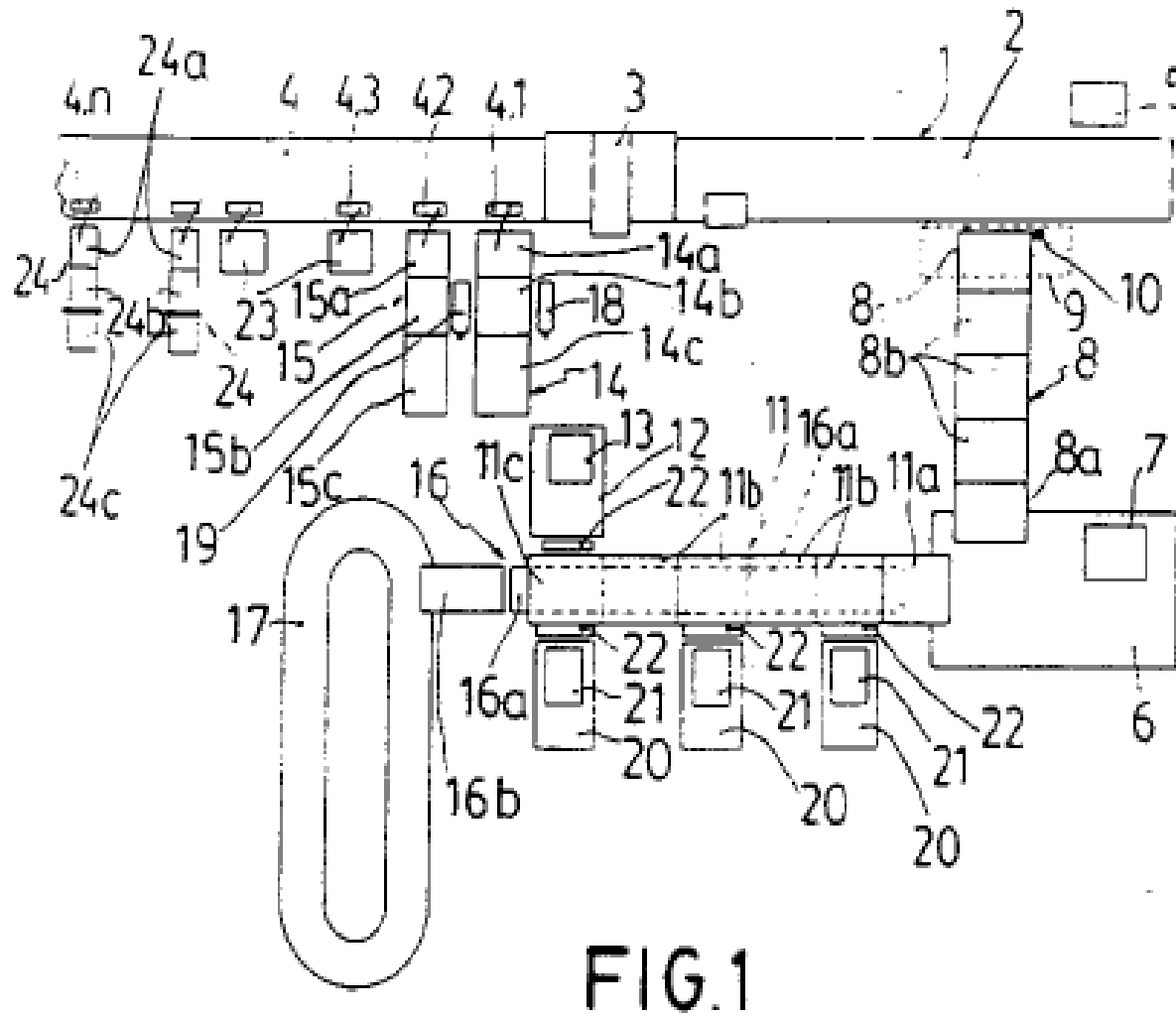
Magnus Stiebe
Barcelona, 13 de marzo de 2017

Introducción: ¿dónde está la *conveyance room*?

- a second conveyor (11) of atypical articles that are passed in parallel operation to the machine (1), from this unpacking station (6) to an auxiliary operator-assisted identification station (12) and located in transverse operation with the first gate (4.1) of that classification area (4) and which ejects the unidentified copies;
- a third conveyor (14) of unidentified copies which extends transversely to the machine (1) from that first gate (4.1) to the auxiliary gate (12).
- **An optional conveyance room (15)** of extemporaneous copies which extends transversely to the machine (1) from a second gate (4.2) that is provided for this purpose in the classification area (4) to the auxiliary station (12);
- associated with this auxiliary station (12) and connected with this control computer (5), a computer (13) for processing atypical unsold articles, unidentified copies and, as an option, extemporaneous copies;
- a fifth conveyor (16) which extends between this auxiliary station (12) and baling and storage means with a carrousel (17) for pre-storage of unidentified and atypical articles for their classification by hand;
- a printer (18) and as an option, a printer (19) designed to assign identification code for unidentified and extemporaneous articles, which are respectively associated with that conveyor (14 and 15) and connected to this control computer (5).

Introducción: ¿dónde está la *conveyance room*?

La pregunta del examinador:



"Where is the conveyance room 15?"

Introducción: ¿dónde está la *conveyance room*?

- un primer transportador (8) de publicaciones invendidas que desemboca en dicha máquina (1) entre dicho puesto de desembalado y un puesto de dosificación de los ejemplares de dichas publicaciones, adyacente a dicha zona de carga (2) de la máquina (1);

- un discriminador (10) de fin de dosificación, asociado a dicho puesto dosificador (9) manual o automático;

- un segundo transportador (11) de artículos atípicos que discurre funcionalmente paralelo a la máquina (1), desde dicho puesto de desembalado (6) hasta un puesto auxiliar (12) nocidos;

operario y ubicado en c

con la primera puerta (

(4) y que está destinad

- un tercer transportador (14) de ejemplares irreconocidos que se extiende transversalmente a la máquina (1) desde dicha primera puerta (4.1) hasta dicho puesto auxiliar (12);

- un opcional cuarto transportador (15) de ejemplares extemporáneos que se extiende transversalmente a la máquina (1) desde una segunda puerta (4.2) prevista al efecto en dicha zona de clasificación (4) hasta dicho puesto auxiliar (12);



COOPERACION

onal: WO 94/16830

de Agosto de 1994 (04.08.94)

JP, US, Patente europea (AT, GB, GR, IE, IT, LU, MC, NL,

¿Qué hacer?

Corregir de acuerdo con el Art. 14(2) del CPE:

(19)  **Europäisches Patentamt**
European Patent Office



B1

(12) **2. DEVICE FOR PROCESSING THE RETURN OF**
(45) D **UNSOLD ARTICLES, according to claim 1, further**
of **including a fourth conveyor of copies found to have**
1 **been returned after a preestablished period of time,**
(21) A **said fourth conveyor extending transversely to the**
(22) D **machine (1) from a second gate (4.2), that is pro-**
vided for this purpose in the classification area (4),
to the auxiliary station (12).

Art. 14(2) CPE: *“A European patent application shall be filed in one of the official languages or, if filed in any other language, translated into one of the official languages in accordance with the Implementing Regulations. Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the application as filed. If a required translation is not filed in due time, the application shall be deemed to be withdrawn.”*

¿Por qué tenemos el artículo 14(2) del CPE?



Estados contratantes al principio (7 Octubre 1977): Alemania (República Federal), **Bélgica**, Francia, Luxemburgo, **Los Países Bajos**, Reino Unido, **Suiza**.

Pero luego llegaron **Suecia**, **Italia**,...

...muchos de los cuales no tenían una lengua oficial que fuera también una de las lenguas oficiales de la EPO.

El Artículo 14(2) intenta compensar la desventaja que sufren los que no tienen el inglés, el alemán o el francés como lengua oficial/materna/principal.

(Y la Regla 6 del EPC pretende compensar con algo de dinero: 30% de la tasa de presentación...para algunos solicitantes...)

¿Cómo se aplica?



Corregir una traducción bajo el Art. 14(2) CPE es sencillo: se presentan nuevas páginas en las que los errores de traducción se han corregido.

A veces (¿procedimientos *inter partes*?) se debe presentar una traducción certificada.

Las correcciones se pueden presentar junto con otras enmiendas, por ejemplo, al contestar a una comunicación bajo el Art. 94(3) o la R. 71(3) EPC.

Art. 70(1) CPE: *“The text of a European patent application or a European patent in the language of the proceedings shall be the authentic text in any proceedings before the European Patent Office and in any Contracting State.”*

Art.70(2) CPE: *“If, however, the European patent application has been filed in a language which is not an official language of the European Patent Office, that text shall be **the application as filed** within the meaning of this Convention.”*

El texto original (en castellano, sueco,...) es el texto que se tiene en cuenta a efectos del Art. 123(2) CPE: *“The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of **the application as filed**.”*

Este es la parte buena: ¿vía libre para corregir y enmendar en base al texto original?

Una vez concedida la patente aplica el Art. 123(3)
CPE:

“The European patent may not be amended in such a way as to extend the protection it confers.”

¡AQUI ESTÁ “LA TRAMPA”!

T287/98 (EP94201912.6)

Descripción presentada en neerlandés (extracto):

Shredderafval is zoals bekend afval dat ontstaat bij de verwerking van **schroot** in een zogenaamde shredder of hamermolen.

With respect to the case under heading, we herewith enclose:

- the text in English in triplicate;
- the certified copy of Belgian patent no 09300783 filed on 28 July 1993;
- an English translation of same.

We wish you good receipt of these documents.

Traducción presentada (extracto):

Shredder waste is, as is known, waste which is produced during the processing of **scrap** in what is called a shredder or hammer mill.

T287/98 (cont.)

The original application in Dutch contained the word "schroot", which means **scrap metal**, as substantiated by the copies of various dictionaries provided by the Appellant. This word was thus not correctly translated into English and nothing other than "scrap metal" was meant in the application as originally filed.

T287/98 (cont.)

Since Article 70(2) EPC provides that in a case referred to in Article 14(2) EPC, i.e. in which the European patent application is filed in a language of a contracting state other than English, French or German, the original text must be taken into account in proceedings before the European Patent Office, in order to determine whether the subject-matter of the application extends beyond the content of the application as filed, the replacement of the word "scrap" by "scrap metal" is allowable under Article 123(2) EPC.

T359/06 (EP96935504.9)

PCT

世界知的所有権機関
国際事務局

特許協力条約に基づいて公開された国際出願



<p>(51) 国際特許分類6 F01N 3/20, 3/02</p>	<p>A1</p>	<p>(11) 国際公開番号 WO97/16632</p> <p>(43) 国際公開日 1997年5月9日(09.05.97)</p>
<p>(21) 国際出願番号 PCT/JP96/03184</p> <p>(22) 国際出願日 1996年10月30日(30.10.96)</p> <p>(30) 優先権データ 特願平7/281784 1995年10月30日(30.10.95) JP 特願平8/35057 1996年2月22日(22.02.96) JP</p> <p>(71) 出願人 (米国を除くすべての指定国について) トヨタ自動車株式会社 (TOYOTA JIDOSHA KABUSHIKI KAISHA)[JP/JP] 〒471-71 愛知県豊田市トヨタ町1番地 Aichi, (JP)</p> <p>(72) 発明者；および (75) 発明者／出願人 (米国についてのみ) 衣笠幸夫(KINUGASA, Yukio)[JP/JP] 五十嵐幸平(IGARASI, Kouhei)[JP/JP] 伊藤隆晟(ITOU, Takaaki)[JP/JP] 〒471-71 愛知県豊田市トヨタ町1番地 トヨタ自動車株式会社内 Aichi, (JP)</p>	<p>(74) 代理人 弁理士 石田 敬, 外(ISHIDA, Takashi et al.) 〒105 東京都港区虎ノ門三丁目5番1号 虎ノ門37森ビル 青和特許法律事務所 Tokyo, (JP)</p> <p>(81) 指定国 CN, JP, KR, US, 欧州特許 (AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE).</p> <p>添付公開書類 国際調査報告書</p>	

T359/06 (cont.)

1. 内燃機関から排出される排気ガス中の有毒成分を捕集する捕集手段と、

前記捕集手段で捕集された有毒成分を除去して前記捕集手段の再生を行う除去手段と、

現時点以降の車両の走行状態を予測する走行状態予測手段と、

前記走行状態予測手段で予測された車両の走行状態に基づいて内燃機関から排出される排気ガスの状態量を予測する排気ガス状態量予測手段と、

前記排気ガス状態量予測手段によって予測された排気ガス状態量に応じて前記除去手段による前記捕集手段の再生を行うべき時期を決定する再生時期決定手段と、

前記再生時期決定手段で決定された時期に到達したときに、前記除去手段による前記捕集手段の再生を実行する再生実行手段と、を具備する内燃機関の排気浄化装置。

T359/06 (cont.)

What is claimed is:

1. An exhaust gas purifying system for an internal combustion engine, comprising:

a trapping means for trapping **poisonous** components of the exhaust gas emitted from the internal combustion engine;

a removing means for regeneration said trapping means by removing the poisonous component trapped in said trapping means;

a running condition predicting means for predicting the running condition of the vehicle after the present time;

an exhaust gas property predicting means for predicting the property of the exhaust gas emitted from the internal combustion engine based on the vehicle running condition predicted by said running condition prediction means;

a regeneration timing determining means for determining the timing when said trapping means is regenerated by said removal means in accordance with the exhaust gas property predicted by said exhaust gas property predicting means; and

a regeneration executing means for executing the regeneration of said trapping means by said removing means when the timing determined by said regeneration timing determining means occurs.

1. An exhaust gas purifying system for an internal combustion engine, comprising:

a trapping means for trapping **polluting** components of the exhaust gas emitted from the internal combustion engine;

a removing means for regenerating said trapping means by removing the polluting components trapped in said trapping means;

a running condition predicting means for predicting the running condition of the vehicle after the present time;

an exhaust gas property predicting means for predicting the property of the exhaust gas emitted from the internal combustion engine based on the vehicle running condition predicted by said running condition predicting means;

a regeneration timing determining means for determining the timing when said trapping means is regenerated by said removal means in accordance with the exhaust gas property predicted by said exhaust gas property predicting means; and

a regeneration executing means for executing the regeneration of said trapping means by said removing means when the timing determined by said regeneration timing determining means occurs.

T359/06 (cont.)

No se explica el cambio de terminología:

According to Rule 86(2) EPC in connection with Art. 157 EPC, enclosed new claims 1 to 13 are filed in triplicate. The new claims 1 to 13 shall replace the pending claims 1 to 9.

T359/06 (cont.)

Hubo oposición:

Opposition à un brevet européen 13. Okt. 2003 Al'Office européen des brevets

réservé à l'OEI

I. Brevet attaqué Numéro du brevet Numéro de la demande Date de la mention de la délivrance (art. 97(4), 99(1) CBE)	N° de l'oppos. OPPO (1) EP859132 96935504.9 15/01/2003
Titre de l'invention EXHAUST EMISSION CONTROL APPARATUS FOR INTERNAL COMBUSTION ENGINE	
II. Unique ou premier titulaire du brevet cité dans le fascicule du brevet TOYOTA JIDOSHA KABUSHIKI KAISHA	
Référence de l'opposant ou du mandataire (max. 15 caractères ou espaces)	
III. Opposant Nom Adresse Etat du domicile ou du siège	OREF OPPO (2) PEUGEOT CITROËN AUTOMOBILES SA Route de Gizy 78943 Vélizy Villacoublay France FRANCE

T359/06 (cont.)

Argumento Art. 100(c) CPE:

3/ Art. 100c) – EXTENSION DU BREVET AU-DELA DU CONTENU DE LA DEMANDE

L'objet du brevet s'étend au-delà du contenu de la demande telle qu'elle a été déposée

3.1/ Revendication délivrée 1

Dans la demande de brevet telle que déposée, il est utilisé dans la revendication 1 le terme de « poisonous component », terme qui se retrouve plusieurs fois dans la description (cf. colonne 1 ligne 4 du brevet) or ce terme a été supprimé de la revendication 1 au cours de la procédure d'examen, et remplacé par le terme « polluting component ».

Il est évident que ces deux termes non clairement pas la même signification, ni la même portée.

Par conséquent, l'objet du brevet s'étend bien au-delà du contenu de la demande telle qu'elle a été déposée et donc le brevet A1 doit être révoqué conformément à l'article 100c) CBE.

T359/06 (cont.)

BoA: 1.2 The appellant alleged that the skilled person would consider that the meaning of "polluting" in the specific context of claim 1 was identical to that of the term "poisonous" used in the application as filed. The appellant did not file evidence in support of this argument but referred to the definitions of "poisonous" and "pollutant" given by "Wikipedia", which, in particular, mentions Paracelsus's principle that *"...everything is a poison, there is poison in everything; only the dose makes a thing not a poison"*, and cites the German Penal Code (StGB), from which it was said to follow that a specific substance cannot automatically

T359/06 (cont.)

BoA: be assigned to the category of pollutant or be excluded therefrom, in which respect the relative quantity and the environmental circumstances are important. The Board is willing to accept that these definitions may well apply in a general context but they do not contradict the respondent's view, which is shared by the Board, that the terms "pollutant" and "poisonous" are normally used for classifying a substance independently of the dose at which it would cause the harmful effect. Some substances, such as the toxin of amanita phalloides, mentioned by the respondent, are indeed classified as poisonous, but not as pollutants. Other substances are sometimes regarded as pollutants (e.g. carbon dioxide) whilst not being regarded as poisonous. Some substances are normally never

T359/06 (cont.)

BoA: classified either as poisonous or as polluting, even if they might be either poisonous or polluting or both, depending on the dose (e.g. table salt, which might be poisonous depending on the dose and the circumstances, or pollutant, e.g. for freshwater). Furthermore, the Board accepts the respondent's view that in the present technical field of exhaust gas purifying systems it is usual to designate as "poisonous" substances that are harmful for the system itself (in particular for the catalyst) independently of their effect on organisms or the environment.

T359/06 (cont.)

BoA:

The above shows that the area defined by "poisonous component" and the area defined "polluting components" do not have clear boundaries when reference is made to the general common understanding of these terms.

Moreover, even considering these terms in the limited context of claim 1, there is no clear basis for coming to the conclusion that they define identical areas.

T359/06 (cont.)

BoA: Accordingly, it is not immediately apparent that the presence of the term "polluting" in claim 1 of the main request instead of the term "poisonous" disclosed in the application as filed does not result in new technical information, contrary to the requirements of Article 123(2) EPC. Analogously, it is not immediately apparent that the replacement of "polluting" by "poisonous" in accordance with the first auxiliary request does not extend the scope of protection, contrary to the requirements of Article 123(3) EPC.

Pero... **¿alguien miró el texto original en japonés?** No he visto referencia alguna al mismo en el expediente. La duda es: ¿Y si el término original japonés se podía traducir como "polluting"?

Claro, que T1483/10 vino después...

T1483/10 (2.2 de reasons for the decision):

“According to Articles 153(2) EPC, an international application for which the European Patent Office is a designated or elected Office, shall be equivalent to a regular European application (Euro-PCT application). Under Article 153(5) EPC Euro-PCT applications shall be treated as European applications. It is also a general principle that such applications must be treated as favourably as those made in a contracting state (see T 700/05 Reasons - paragraph 4.1.1 also T 353/03). Hence, by analogy, Article 14(2) EPC must also allow the translation into English of a PCT application originally filed in Chinese to be brought into conformity with the original Chinese text of the application throughout the proceedings before European Patent Office.”

Un ejemplo reciente



(11) EP 2 412 517 B1

(12)

EUROPEAN PATENT SPECIFICATION

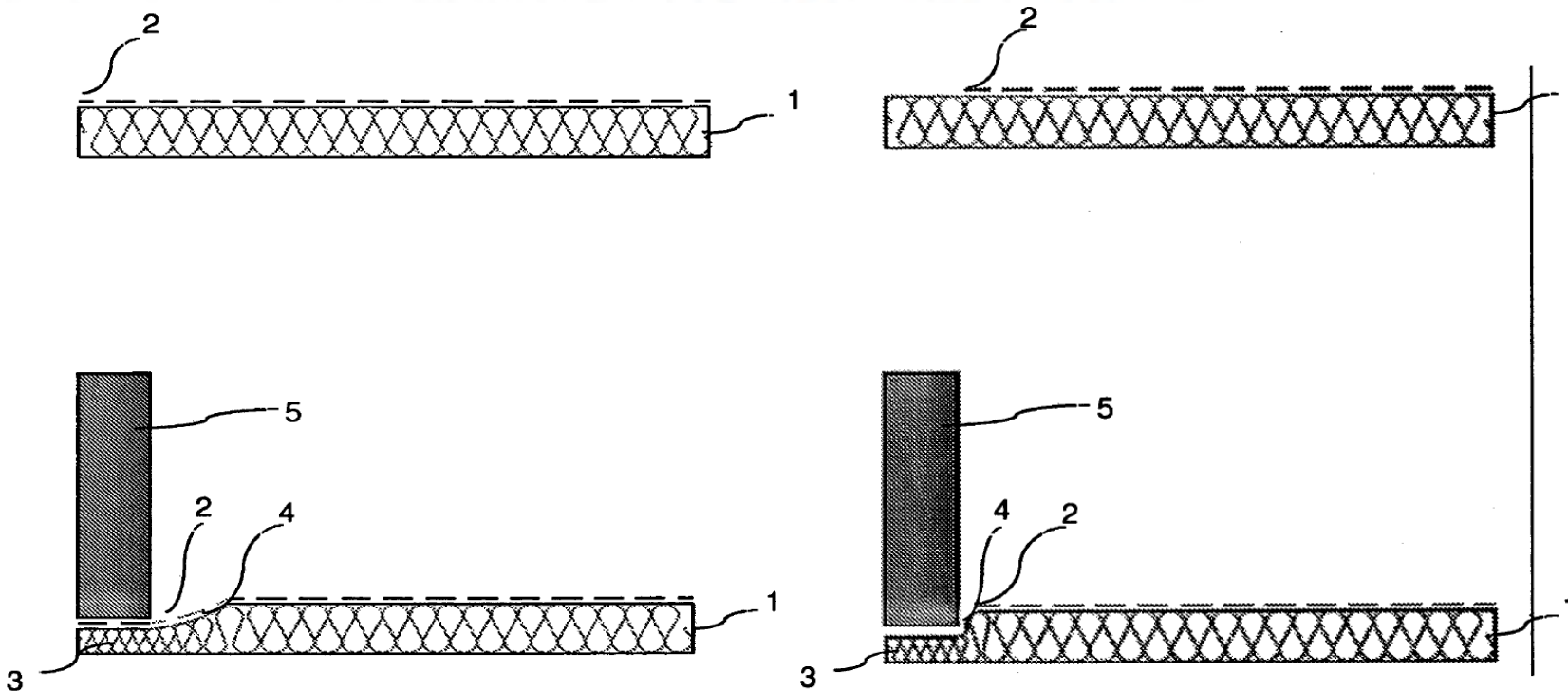


FIG. 1

Estado de la técnica

FIG. 2

Realización de la invención

Reivindicación 1 de la patente:

1. System for the formation of small curvature radius in preformed mineral wool panels having a covering thin web on one or both faces, apart from other eventual external covering elements, with a higher structural rigidity, of the type used for the manufacture of conductions for ventilation or air conditioning comprised of a mineral wool core, particularly a glass fiber core, **characterized in that** at least one of the covering thin webs has a width less than the total width of the panel, leaving at least one end longitudinal band of the panel free of the covering web, so that a joint may be formed by a grooving and tonguing with curvature radius smaller than usual.

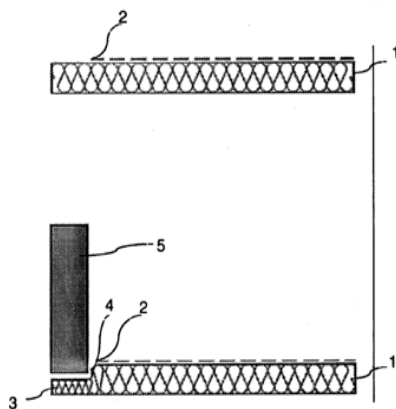


FIG. 2

¿Suena raro?

Sí que suena raro. Vamos a investigar.

(30) Priority: 28.07.2010 ES 201000978

¿Prioridad española? A ver en qué idioma se presentó...



Request for grant of a European patent

44-B Technical documents	Original file name:	System file name:
B-1	Specification in admissible non-EPO language Spanish version.pdf 3 claims2 figure(s)	SPECNONEPO.pdf
B-2	Translation of specification description.pdf figure(s) to be published: ; abstract; 1	SPECTRANEPO-1.pdf
B-3	Translation of specification claims.pdf figure(s) to be published: ; abstract; 1	SPECTRANEPO-2.pdf
B-4	Translation of specification abstract.pdf figure(s) to be published: ; abstract; 1	SPECTRANEPO-3.pdf
B-5	Translation of specification drawings.pdf figure(s) to be published: ; abstract; 1	SPECTRANEPO-4.pdf

Fees	Factor applied	Fee schedule	Amount to be paid
001 Filing fee - EP direct - online	0.8	105.00	84.00
002 Fee for a European search - Applications filed on/after 01.07.2005	1	1 105.00	1 105.00
005e Designation fee - For all contracting States designated for applications filed on/after 01.04.2009	1	525.00	525.00
Total:		EUR	1 714.00

Reivindicación 1 de la solicitud de patente:

Original en
castellano:

1. Sistema de conformación de pequeños radios de curvatura para paneles de lana mineral preformados provistos de **velo** de recubrimiento por una o ambas caras, además de otros posibles recubrimientos exteriores, de rigidez estructural incrementada, del tipo de los que se utilizan para la fabricación de conductos de ventilación o climatización, compuesto por un alma central de lana mineral, en especial de lana de vidrio, **caracterizado** porque al menos uno de los **velos** tiene un ancho inferior al del panel, dejando al menos una banda longitudinal extrema del mismo libre de velo para que de esta forma se pueda conformar un machihembrado con radios de curvatura inferiores a los habituales.

Traducción
al inglés:

1. System for the formation of small curvature radius in preformed mineral wool panels having a covering **thin web** on one or both faces, apart from other eventual external covering elements, with a higher structural rigidity, of the type used for the manufacture of conductions for ventilation or air conditioning comprised of a mineral wool core, particularly a glass fiber core, characterized in that at least one of the covering **thin webs** has a width less than the total width of the panel, leaving at least one end longitudinal band of the panel free of the covering web, so that a joint may be formed by a grooving and tonguing with curvature radius smaller than usual.

Pregunta: ¿velo ≈ thin web?

“Notice of opposition”: 5 páginas sobre Art. 100(c) CPE
Algunos extractos:

(III) REGARDING ART. 100(c) EPC

It follows from Art. 70(2) EPC that in the present case, the text of the “*application as filed*” is the original Spanish text. Thus, for the purpose of Art. 100(c), the text of the patent as granted has to be compared with the original Spanish text, as filed on 7/7/11.

“Notice of opposition”: 5 páginas sobre Art. 100(c) CPE Algunos extractos (cont):

As the translation was not corrected during the pre-grant prosecution of the application, the patent was granted with this wording of claim 1.

However, the filing of the alleged translation violated Art. 123(2) EPC, as it introduced changes to the subject-matter that were not supported by the application as filed in Spanish. Due to the generally unclear language of the application in general and the claims in particular (both in Spanish and in English), it is difficult to assess the full importance of the changes in scope that took place due to the filing of the English version. However, it is established practice under the EPC that Art. 123(2) EPC is to be applied strictly.

In the present case, it appears that at least the following differences between the original Spanish text of the application as filed and the English text of the patent as granted, justify revocation under Art. 100(c) EPC:

“Notice of opposition”: 5 páginas sobre Art. 100(c) CPE Algunos extractos (cont):

"velo" → "thin web"

The term "velo" has a clear meaning in Spanish, and it does not correspond to a "thin web". The correct translation into English is "veil". We are not aware of any support for the translation of "velo" into "web", and even less into "thin web". Reference is made to **Collins**, page 921 (for the translation of "velo"), and to **Oxford**, page 1746 (for the meaning of "web"). That is, not only is a "velo" a "veil" rather than a "web", but the application as filed is also completely silent on whether the item in question is thick or thin. That is, apart from the non-supported change of "velo" into "web", there is a non-supported addition of "thin". Thus, the amendment not only fails to comply with the so-called disclosure test (no thin web was disclosed in the application as filed), but it also fails to comply with the so-called novelty test: a system including a "thin web" would be novel over a similar system in which instead of a "thin web" there was a (more or less thick or thin) "veil".

This violation of Art. 123(2) EPC appears to be especially serious taking into account that the "veil" or "velo" appears to relate to the core of the invention.

Respuesta de la titular de la patente:

(III) REGARDING ART. 100(c) EPC

The Article 100(c) of the EPC reads as follows:

"(c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed."

We agree in that, for the purpose of Art. 100(c), the text of the patent as granted has to be compared with the original Spanish text, the "application as filed" on 07/07/2011.

In principle, we request to maintain as granted in its entirety the opposed patent. However, in order to avoid any potential non observance of the Art. 123 (2) EPC, and following Rule 139 EPC, we file the Auxiliary Requests 2 and 3 with the modifications of the translation of the expressions listed below. In said list, the first term is the original word in Spanish in the application as filed, the second term is the current translation to English, the third term is the a first alternative translation into English (Aux Req 2), and the fourth term is the a second alternative translation into English (Aux Req 3), if different from Aux Req 2.

Respuesta de la titular de la patente (cont):

(III.1) Regarding claim 1:

> first term → second term → third term (Aux Req 2) → fourth term (Aux Req 3), if different from Aux Req 2

> "velo" → "thin web" → "web" (Aux Req 2) → "veil" (Aux Req 3)

Comunicación de la División de Oposición:

Communication pursuant to Article 101(1) and Rule 81(2) to (3) EPC

Further **examination of the opposition(s)** is based on the following documents:

3 Translation / Art. 100(c) - 123(2) EPC

3.1 The Division agrees with both parties that in the present case the "application as filed" is the Spanish text filed on 07 July 2011 (Art. 70(2) EPC).

A translation into English was also filed on the same day. Based on this English translation the contested patent was granted.

3.2 The Opponent has raised objections under Art. 123(2) EPC / 100(c) EPC. According to the Opponent several terms which appear in the granted patent are mistranslated so that the features referred to by the mistranslated terms have no basis in the application as filed. For instance, "velo" (Spanish application as filed) should have been translated into "veil" and not into "thin web".

According to Rule 5 EPC the EPO may require a certificate that a translation corresponds to the original text.

Comunicación de la División de Oposición (cont.):

The annotated European Patent Convention (Derk Visser, 18th revised Edition, ISBN 978-90-78310-07-5); p.22, point 6) elaborates that the EPO may request a certified translation "if there is any doubt about the accuracy of the translation".

In the present case, even the Proprietor appears not to dispute that the English translation is not entirely correct (see proprietor's response to the notice of opposition, p.4, l.6-8).

Hence there are serious doubts concerning the correctness of the present English translation. An examination under Art. 123(2) EPC is however only possible if the exact content of the application as filed is known.

The Patentee is therefore requested to file a certified translation of the Spanish application as filed into English.

This translation will then form the basis for the further examination of the patent under Art. 100(c) / 123(2) EPC.

Comunicación de la División de Oposición (cont.):

- 3.3 It can be noted that a correction of the translation is possible at any stage, including opposition proceedings.

- 3.4 Corrections which offend against Art. 123(3) EPC are however not allowable. (Derk Visser, 18th revised Edition, ISBN 978-90-78310-07-5); p.22, point 5).

La titular de la patente presenta traducción certificada.

La reivindicación 1 se corrige de la siguiente manera:

1. A ~~s~~system for the formation of small curvature ~~radii~~ in preformed mineral wool panels having a covering veil~~thin~~~~web~~ on one or both faces, apart from other ~~possible~~~~external~~ external covering elements, with a higher structural rigidity, of the type used for the manufacture of duct~~se~~~~ductions~~ for ventilation or air conditioning comprised of a mineral wool core, particularly a glass wool~~fiber~~ core, characterized in that at least one of the covering veil~~thin~~~~webs~~ has a width less than the ~~total~~~~width~~ of the panel, leaving at least one end longitudinal band of the panel free of the covering veil~~web~~, so that a tongue and groove~~joint~~~~joint~~ may be formed ~~by a~~~~grooving~~~~and~~~~tonguing~~ with curvature ~~radii~~ smaller than usual.

Argumentos de la oponente antes de vista oral:

(2) REGARDING ARTICLE 123(2)&(3) EPC

In form 2906 annexed to the summons the Opposition Division already pointed out some of the problems that have to be considered due to the presence of apparently inconsistent requests that are all in contradiction with the latest one of the multiple alternative translations that so far have been submitted by the Proprietor.

Regarding this latest translation, that is, the certified one filed in response to the examination report mailed on 17/6/15, we observe the following:

Argumentos de la oponente antes de vista oral (cont.):

(2.1) REGARDING ART. 123(3) EPC

The Proprietor's letter of 14/10/15 fails to explain why the modified text could reasonably be considered to comply with Art. 123(3) EPC. The Proprietor argues in said letter that "*the new translation do not offend Art 123(3) EPC as the new translation is more precise, which goes in the opposite direction of 'to extend the protection it confers'" (sic).*

The preliminary opinion already identified some of the flaws of this statement. In our view, due to its relevance, this statement still merits some attention:

Argumentos de la oponente antes de vista oral (cont.):

(2.1.1) BLATANT VIOLATION OF ART. 123(3)

The sweeping statement made by the Proprietor completely fails to address the remarkable change from "*thin web*" to "*veil*". Not surprisingly, here, the Proprietor has preferred not to enter into details. Now, changing from "*thin web*" to "*veil*" does not seem to imply any enhanced preciseness, rather the contrary: "*veil*" is not more precise than "*web*", and the term "*thin*" has simply been removed, rendering the claimed matter not more but less precise.

Whereas we do not rule out that there may be some specific types of *veils* that actually can be regarded as *thin webs* (such as thin veils in some kind of web form), many veils are not webs as all, and some veils may not even be particularly thin. What is important in what regards the application of Art. 123(3) EPC is whether the change from "*thin web*" to "*veil*" implies that the scope of claim 1 as per the so-called certified translation filed with the Proprietor's letter of 14/10/15 includes matter that was not encompassed by claim 1 of the patent as granted. It clearly does.

Argumentos de la oponente antes de vista oral (cont.):

Just for the sake of completeness, enclosed please find copies of selected pages from the *Oxford Advanced Learner's Dictionary, eighth edition, 2010* (Oxford University Press, Great Clarendon Street, Oxford OX2 6DP, Great Britain) (that is, from the dictionary referred to as "**Oxford**" in our notice of opposition) and recent print-outs from www.wordreference.com, showing the definitions of the terms "*thin*", "*web*" and "*veil*" in the language of the proceedings. Changing from "*web*" to "*veil*" does not make the language "*more precise*" as alleged by the Proprietor, but shifts the scope of the claim from "*webs*" to "*veils*", and removing "*thin*" inevitably expands the scope of the claim.

A change from "*web*" or "*veil*" to "*thin web*" or "*thin veil*", respectively, might have provided for the enhanced precision alleged by the Proprietor, but changing from "*thin web*" to "*veil*" implies shifting the scope of the claim so as to extend the protection conferred by the patent (if maintained as amended) to matter not within the extent of the protection conferred by the patent as granted.

Argumentos de la oponente antes de vista oral (cont.):

Thus, to the extent that the Proprietor requires the patent to be maintained on the basis of the certified translation including the shift from *"thin web"* to *"veil"*, any such request should be rejected for incompliance with Art. 123(3) EPC.

Lo que la División de Oposición decidió:

13.2 **Art. 123(3) EPC**

Claim 1 as granted concerned mineral wool panels having a covering "thin web".

Claim 1 of the main request concerns mineral wool panels having a covering "veil".

13.2.1 The Patentee has argued that the replacement of "thin web" with "veil" did not lead to a broadening of the scope of claim 1.

Neither the term "web" nor the term "veil" had an exactly defined meaning in the art but in essence, the terms related to the same thing. If anything, the term "veil" was more restricted compared to the term "thin web".

Lo que la División de Oposición decidió (cont.):

The term "web" implied some type of network structure of interconnected elements, the elements for instance being fibrous and having cross-over points and empty spaces between the elements.

The term "veil" basically meant the same. For instance the term "veil" implied a certain degree of transparency as found in a light woven structure, which in turn could also be called a "thin web".

It could also be noted that the "veil" was described to act as a distribution plate for forces acting on the panel. It was well-known that net-like structures were best-suited to distribute loads so that the skilled person would have known that a "veil" is a specific type of a "thin web".

Lo que la División de Oposición decidió (cont.):

The Division agrees with some of the arguments brought forward by the Patentee, most notably with the Patentee's understanding and interpretation of the term "web".

The Division shares the Patentee's interpretation that the term "web" unambiguously implies some type of network structure of interconnected elements, the elements for instance being fibrous and having cross-over points, the structure having empty spaces between the elements.

In contrast, the Division is of the opinion that a compact material like aluminium foil is not a "web".

Lo que la División de Oposición decidió (cont.):

During the discussion of a lower-ranking request, the Patentee argued that at the atomic level, also aluminium foil is a "web", but this interpretation appears to be artificial and unrealistic in the technical context of the present invention.

The Division further agrees with the Patentee that webs or web-like materials can also be considered as veils.

However, the Division is of the opinion that the term "veil" is not restricted to web-like materials but also covers materials which the skilled person would not consider as webs.

The Division is convinced that, unlike the term "web", the term "veil" does not imply the structural limitations mentioned above but relates more to the function of the material: A "veil" is a material that covers another material. As long as a material fulfils this covering function, it can be regarded as a "veil", regardless of its structure.

Lo que la División de Oposición decidió (cont.):

It follows that a facing made of aluminium foil would be covered by claim 1 of the main request, while it was not covered by claim 1 as granted.

The Division would like to point out that aluminium foil is actually used as covering material in mineral wool panels used for ducts as can be seen for instance from D6 (col. 1, l.11-16 and col. 3, l. 2). Hence the question of whether aluminium foil is covered by claim 1 or not is not a purely academic one, but highly relevant for the assessment of a possible broadening of the scope.

Moreover it cannot be derived from the application as filed that particular facing materials, i.e. only web-like materials, are to be used in the present invention. Quite the opposite, the application points out that the problems caused by the conventional facing materials are overcome by the invention without having to replace these conventional facing materials.

Lo que la División de Oposición decidió (cont.):

Thus, the amendment resulted in a broadening of the scope of claim 1 so that the requirement of Art. 123(3) EPC is not met.

Similar considerations apply to the deletion of the term "thin". While the limitations implied by the term are not totally clear, the presence of this term in the claim certainly excludes web materials which are so thick that the skilled person would not reasonably consider them to be "thin".

This limitation is no longer present in claim 1 of the main request. While it is true that the term "veil" might also imply a certain "thin-ness", this limitation is much less explicit than the corresponding limitation of granted claim 1.

Therefore the Division is of the opinion that also for this reason the requirement of Art. 123(3) EPC is not met.

Therefore the main request is not allowable.

Lo que la División de Oposición decidió (cont.)
(después de analizar las auxiliary requests):

18 Decision

As none of the requests on file is allowable, the Opposition Division has decided to revoke the patent (Art. 101(3)(b) EPC).

¿Hubo recurso?

Sí, pero no...



European patent application No. **11173002.4**

APPEAL
for immediate attention

- I. **Findings** No notice of appeal filed but appeal fee paid!
1. Appeal in which **more than one party** is involved (opposition procedure, except when all oppositions have been withdrawn). **Refer the case to the Board of Appeal without delay using EPO Form 2703.**

¿Qué podemos hacer para evitar esta “trampa”?

➤ ¿Presentar las solicitudes PCT y EP en inglés?

➤ ¿Y si reivindican prioridad de una solicitud española? ¿Riesgo de perder la prioridad si hay un error de traducción (G2/98)?

➤ ¿Presentar también la prioritaria en inglés?

➤ ¿Nunca empezar con una solicitud española (redactada en español) de patente o de modelo de utilidad?

➤ **Tener cuidado con la “jerga” de los inventores.** ¿Qué es un “velo”? ¿Cuál es el término correcto en inglés? ¿En alemán? ¿En chino?

➤ Cuando redactas en un idioma... **¡pensar en la traducción a los demás!**

Esto da para pensar...¿cuántas patentes actualmente en vigor son potencialmente nulas “por culpa de la traducción?”

¡MUCHAS GRACIAS POR SU ATENCIÓN!

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