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**D E C I S I O N**  
**of 9 September 2004**

**Case Number:** J 0004/03 - 3.1.1

**Application Number:** 95939068.3

**Publication Number:** 0786978

**IPC:** A61F ???/00

**Language of the proceedings:** EN

**Title of invention:**  
Device for foot stabilization

**Applicant:**  
Roth, Ivar E.

**Opponent:**  
-

**Headword:**  
Retraction of withdrawal/ROTH

**Relevant legal provisions:**

EPC Art. 122(6)

EPC R. 88

**Keyword:**

"Postponement of oral proceedings - no"

"Withdrawal unambiguous and effective - yes"

"Retraction of withdrawal of application after publication of  
withdrawal in European Patent Bulletin - not allowable"

**Decisions cited:**

J 0015/86, J 0010/87, J 0011/94, J 0027/94, T 0037/97

**Catchword:**  
-



Case Number: J 0004/03 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 9 September 2004

**Appellant:** Roth, Ivar E.  
512 Carnation Avenue  
Corona del Mar  
California 92625 (US)

**Representative:** Becker, Eberhard, Dr.  
Patentanwälte  
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**Decision under appeal:** Decision of the Examining Division dated  
27 August 2002 refusing the request for  
retraction of the withdrawal and reinstatement  
of the application by way of a correction under  
Rule 88 EPC.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** H. Preglau  
S. C. Perryman

## Summary of Facts and Submissions

- I. European patent application No. 95 939 068.3 was filed originally as international application PCT/US 95/14 355 on 12 October 1995.
- II. By fax of 19 October 2001, confirmed by letter received at the Office on 22 October 2001 the then European representative of the applicant stated "Conditionally upon receiving at least a partial refund of the examination fee, we hereby withdraw the application".
- III. With letter dated 31 October 2001 the Examining Division acknowledged the withdrawal of the European patent application, stated that the proceedings were terminated as from withdrawal, and announced the refund of the examination fee at a rate of 75% according to Article 10b(b) of the Rules relating to Fees.
- IV. With letter dated 22 April 2002 the retraction of the withdrawal and reinstatement of the application by way of a correction under Rule 88 EPC was requested. It was explained that the withdrawal was made in error and did not reflect the true intention of the applicant, who only instructed the paralegal dealing with foreign annuities at his US attorney's office "Do not file any foreign annuity extensions", but gave no explicit instructions to withdraw the application.

Following this, the paralegal had instructed the then European representative by fax of 12 October 2001 to "allow the application to go abandoned". By fax of 15 October 2001 the then European representative had mentioned the possibility that a partial refund of the

examination fee might be obtainable if examination had not yet commenced, and asked whether the application should be formally withdrawn and a refund obtained. By fax of 18 October 2001, the US attorney's office had instructed such withdrawal in order to obtain a refund, but without referring the question back to the applicant.

Also filed was a copy of an e-mail of 12 December 2001 from the applicant to the US attorney, as evidence of the applicants recollection of the events and his intentions at the time, stating, inter alia:

"I can't stand being billed for five separate reminder notices that my renewal fees are due when they are all due at the same time and where one letter stating you owe X would do.

I just put my head in a hole when I got that bill. It put me in a bad way that I did not want to deal with the fees any more.

I sent a fax to [paralegal dealing with annuities] at your office and told her not to file any foreign annuity extensions.

I told her to stop work on the patients [sic] period. She told me if I changed my mind I had 6 months to do so, but there may be some penalty fees.

Instead of stopping work she contacted not just the annuity extensions that were pending but all the countries.

I did not authorize this. I was then sent a bill for all this work, plus countries that were not up for renewal were notified that I did not wish to proceed. Thus making matters worse and adding my expense..."

V. With letter dated 18 June 2002 the Examining Division informed the representative that correction of an error under Rule 88 EPC might only be allowable if the preconditions set out by the established case law of the Boards of Appeal of the European Patent Office were met. These preconditions for allowing a correction under Rule 88 EPC were summarised in the following four points:

- the public had not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was requested
- the erroneous withdrawal was due to an excusable oversight
- the requested correction did not result in a substantial delay of the proceedings
- the Office was satisfied that the interests of third parties who might possibly have taken notice of the withdrawal by inspection of the file were adequately protected.

One of these preconditions was not met as the request for correction was filed after the publication of the withdrawal of the European patent application in the European Patent Bulletin. Following decision J 15/86 (OJ EPO 1988, 417) it was too late to ask for a retraction of a withdrawal once the withdrawal was published in the European Patent Bulletin.

VI. In its answer dated 15 August 2002 the representative argued that the Office laid undue emphasis on the

rights of third-parties over those of the applicant. The interests of third-parties could be protected by the application by national courts of provisions corresponding to Article 122(6) EPC. He maintained the request for correction under Rule 88 EPC and asked auxiliarily for an appealable decision.

VII. The Examining Division then issued a formal decision dated 27 August 2002, refusing the request for correction under Rule 88 EPC. The reasons given were that according Legal Advice No. 8/80 (OJ EPO 1981, 6) a valid notice of withdrawal which had been received at the EPO was binding on the applicant. According to paragraph 2 of this Legal Advice the EPO attached various direct, legal consequences to a notice of withdrawal by the applicant and for an orderly grant procedure it was necessary that the legal effects resulting from a valid notice of withdrawal cannot be subject to uncertainty as would be caused by allowing retraction of a validly expressed and notified intention. Further as stated in Board of Appeal decision J 15/86 (OJ EPO 1988, 417) it was too late to ask for a retraction of a letter of withdrawal once the withdrawal had been notified to the public in the European Patent Bulletin. The representative had been sent an the acknowledgement of withdrawal of the European patent application, and been informed that proceedings were terminated as from withdrawal of the application and that the examination fee would be refunded at a rate of 75% pursuant to Article 10b(b) of the Rules relating to Fees. The withdrawal had been entered in the European Patent Register on 2 November 2001 and published in the European Patent Bulletin on 19 December 2001. As the conditions for a correction

- under Rule 88 EPC were not met the request had to be refused.
- VIII. Against this decision an appeal was lodged on 21 October 2002. The appeal fee was paid the same day. The statement of grounds was filed on 3 January 2003. The applicant requested retraction of the withdrawal and reinstatement of the application by way of a correction under Rule 88 EPC. As an auxiliary request oral proceedings should be held in the event that rejection of the appeal were contemplated.
- IX. In his reasoning he explained again the background of the erroneous withdrawal and repeated his point of view, already expressed before the Examining Division that there is undue emphasis placed on the rights of third parties over those of the applicant. Third parties might be sufficiently protected by national provisions corresponding to Article 122(6) EPC. This was indicated in J 10/87 as well.
- X. In a communication accompanying the summons dated 2 June 2004 to oral proceedings set for 9 September 2004 the Board gave a preliminary opinion on the case, referring to the established case law of the Boards of Appeal, which did not allow corrections after the publications in the European Patent Bulletin, and set a deadline of one month before the scheduled date for any further written submissions to be made.
- XI. A request for postponement of the already scheduled oral proceedings, filed on 5 August 2004 by telefax, by a new representative on the grounds that there were further facts that the applicant wished to put before

the board, but that the evidence on these would not be ready by the deadline set, that the applicant himself wished to be present at the oral proceedings but could not do so on the date set, and that there had been a change of representative, was rejected by the Board.

- XII. By letter, dated 30 August 2004, the appellant repeated his requests and stated, that the European Patent Office should not have accepted the withdrawal because it had been made under condition. Several decisions of the Boards of Appeal stated that procedural declarations must not be subject to any condition and in particular J 27/94 ruled that in the interest of legal security, a procedural declaration has to be unambiguous. This implied that it must not be subject to any condition, leaving it open whether the EPO could proceed further on the basis thereof.

It was further argued, that a correction under Rule 88 EPC should be allowable because of the special situation when the erroneous withdrawal had been made. The applicant himself never had the intention to abandon his European patent application. This was supported by a declaration from the paralegal in the applicant's US attorney's office dealing with the applicant's foreign applications. She confirmed that she had merely received instructions from the applicant not to accrue further annuity related expenses, and that she had instructed the then European representative to withdraw the application to obtain a refund without conferring with the applicant and contrary to her usual practice. She attributed this to the shock of the events of 11 September 2001 and due to



undergoing clinical care during her pregnancy with her first child.

- XIII. On 9 September 2004, oral proceedings were held. In these proceedings the appellant repeated the arguments put forward during the written procedure.

Concerning the allowability of a correction under Rule 88 EPC he emphasized in particular that the existing jurisprudence did not achieve a proper balance between the interests of the applicant and those of the public. The applicant who had benefited the public by disclosing the invention merited an opportunity to resurrect the application even after publication of its withdrawal. The interests of third parties would be sufficiently safeguarded by applying provisions equivalent to Article 122(6) EPC as stated in decision J 10/87.

It was requested that the decision under appeal be set aside, the letter of 19 October 2001 be corrected so that the withdrawal of the European Patent application was cancelled, and that the case be remitted to the first instance for further prosecution.

- XIV. At the end of the oral proceedings the Board announced its decision.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

*Request for postponement of oral proceedings*

2. According to the notice of the Vice-Presidents Directorates-General 2 and 3 dated 1 September 2000 concerning oral proceedings before the EPO (OJ EPO 2000, 456) oral proceedings are to be cancelled and another date fixed only if there are serious reasons which justify the fixing of a new date.
  
3. Evidence in support of an application under Rule 88 EPC should be filed during the proceedings before the first instance, as all relevant circumstances should already be known to the applicant or his advisers. Only exceptionally should new evidence be filed for the first time on appeal and then this should be at the start of appeal proceedings. The desire of an appellant to file unspecified new evidence at an unspecified future date, as expressed in the letter of 5 August 2004 on behalf of the present appellant cannot amount to a serious reason for postponing oral proceedings. Even in ex parte proceedings such as the present, where the Board does not have to consider the interests of other parties in a properly conducted procedure, the appellant must attempt to file any facts or evidence he wishes to rely on before the set date of oral proceedings so that the Board can exercise its discretion under Article 114(2) EPC whether to admit the further evidence or not, on the basis of the relevant material.
  
4. The desire of the appellant himself to be present at oral proceedings does not of itself amount to serious grounds for postponing the oral proceedings to a date

at which the appellant can be present, in the absence of other special circumstances of which none appeared in the present case. The present appeal against the decision of the first instance turns essentially on how the law is to be applied to facts which are not in dispute, and so the presence or absence of a party who is duly represented in the proceedings should have no impact on the course of the proceedings or the final decision. The situation would be different if the party unable to attend were also a witness the Board wished to hear on facts potentially critical for the outcome.

5. Nor can the Board treat the change of the representative as of itself a serious substantive reason to postpone the oral proceedings. As stated in decision T 37/97 of 22 November 2002 (not published in OJ of the EPO), a newly appointed representative can be assumed to have ascertained that he is in a position to attend already appointed oral proceedings. Nor could the present case be considered of such complexity that a postponement of oral proceedings is essential so that the new representative can properly prepare himself.

**Unambiguous withdrawal or not**

6. The withdrawal statement filed on behalf of the appellant (see point III above) can only be understood as being shorthand for a phrase such as "*Conditionally upon [the patent grant procedure still being at an early enough stage for the applicant to be entitled under the provisions of Article 10b of the Rules relating to Fees to a total or partial refund of the examination fee on withdrawing the application so that the applicant will be]* receiving at least a partial

refund of the examination fee, we hereby withdraw the application" (words in italics added by Board). Whether this condition was met or not was a fact wholly within the knowledge of the EPO. Fulfilment of the condition did not depend on any decision to be made or discretion to be exercised by the EPO, or on any further action of the applicant. As this factual condition was met the EPO was obliged to acknowledge and act on the withdrawal and make a refund accordingly, all of which it did. The statement raised no procedural ambiguity, and nothing which would have required the EPO to check back with the applicant's representative.

7. The argument of the appellant that the withdrawal should not have been acted on by the EPO as it was conditional and thus presumably should be treated as a nullity finds no support in the cited decisions of the Boards of Appeal. Thus decision J 27/94 of 27 February 1997 (not published in OJ EPO) relied on in particular by the appellant states in point 8:

"In the interests of legal certainty the board has stated that procedural declarations have to be unambiguous (J 11/94, OJ EPO 1995, 596). This implies that such a declaration must not be subject to any condition, leaving it unclear whether or not the EPO can proceed further on the basis thereof."

The withdrawal statement filed leaves no doubt as to the procedural steps the EPO must take, and must thus be taken as a valid statement of withdrawal.

**Rule 88 EPC**

8. Rule 88 first sentence EPC in principle allows the correction of errors and mistakes in any document filed with the EPO. Whether this wording of Rule 88 EPC allows its application to completely negate the sole intention deliberately expressed in a letter withdrawing an application, which letter, as in this case, correctly reflects the intentions of its sender, may need to be reconsidered in future. In the present proceedings the Board limits itself to considering whether the conditions for a correction established by the jurisprudence and set out in Legal Advice No. 8/80 (OJ EPO 1981, 6) are met. This Legal Advice states under point 5 that in case of an erroneously filed withdrawal of a European patent application, Rule 88 EPC may be. But this only means that the European Patent Office has a discretion to allow such a request, not that the request must necessarily be allowed.
  
9. Based upon the wording "...may be corrected..." the jurisprudence of the Boards of Appeal has established several preconditions which have to be met so that a correction will be allowed, the principal precondition being:

that the public has not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was requested.

This is the precondition of critical relevance to the present case. Other preconditions also exist, namely that the erroneous withdrawal was due to an excusable oversight, that the requested correction did not result

in a substantial delay of the proceedings, and that the Office was satisfied that the interests of third parties who might possibly have taken notice of the withdrawal by inspection of the file were adequately protected. These further preconditions are not alternatives to the principal one but additional, and should all be met for a correction to be allowed. The underlying idea of all these preconditions is to prevent any abuse of this provision to correct errors to the detriment of third parties.

10. It is clear from the file and has not been disputed by the appellant that the request for retraction of the withdrawal of the application had been made after notification of the withdrawal in the European Patent Bulletin, the official publication instrument of the EPO. That means that the public had already the information that the application no longer existed so that the principal precondition for allowing a correction is not met, and the request for correction must be refused.

**Additional points argued**

11. The Board accepts on the evidence that the appellant did not himself intend to withdraw the application. But this is irrelevant where the public has been informed in the European Patent Bulletin of the withdrawal. Whether the withdrawal occurred as a result of an excusable mistake or not is irrelevant, and the board has no occasion to consider whether the appellant's own manner of indicating his intentions was a contributory cause of the erroneous withdrawal or the sole cause was

- a mistake by the paralegal excusable in the special circumstances.
12. Withdrawal of an application is the gravest procedural step that can be taken. The EPO is required by the EPC to take certain procedural steps, including making any refund due under Article 10b of the Rules relating to Fees, entering the withdrawal on the Register and publishing it in the Official Bulletin. The application becomes dead without possibility of revival. For an orderly procedure the EPO must be able to assume that a withdrawal has been made with all the deliberation and care necessary for such a grave step. Legal certainty demands that the European Patent Office can rely on the statements of the parties in proceedings. Further the public must be able to trust the information concerning withdrawals published in the European Patent Bulletin. If the Board were to allow a correction despite such publication, third parties could no longer rely on information on withdrawals in the European Patent Bulletin, the official publication of the Office. There is no way of knowing how many people may have relied on withdrawal information appearing in the Bulletin.
13. On behalf of the appellant it was argued that the jurisprudence favours the interests of the public too much over those of the patent applicant in refusing to allow a retraction of a withdrawal once this has been notified in the European Patent Bulletin. But the Board sees no legitimate interest in a withdrawal becoming potentially reversible to the detriment of third parties who have relied on the withdrawal notified in the European Patent Bulletin. An unintended withdrawal should be the rarest of occurrences, and once it is

published in the Bulletin, the interest of public in being able to rely on the information published on all withdrawals outweighs the interests of an applicant in being able to retract an unintended withdrawal in what should be the exceptionally rare case where such an unintended withdrawal has occurred. The Board sees no reason to depart from the established case law on this point.

14. The EPC has no provision for safeguarding the interests of third parties affected by a correction allowed under Rule 88 EPC. The case law thus has allowed such a correction only where the risk that third parties could have acted to their detriment on the initial incorrect information, because they would not have learnt of this without at the same time learning of an allowed or requested correction. It is in this context that publication of the withdrawal in the Bulletin is critical.
  
15. Before the Examination Division it was also argued that following decision J 10/87 (OJ EPO 1989, 323) a correction could be allowed also after the publication of the withdrawal because the interest of the public could be protected by applying provisions corresponding to Article 122(6) EPC by the national courts. This argument misrepresents the decision J 10/87. The latter (see points 13 and 14) explicitly stated that retraction of a withdrawal could only be allowed to take place where it had not been officially notified to the public, and confirmed the necessity of all four preconditions stated in point 8 above being met. Specifically that case concerned the retraction of a withdrawal of the designation of the United Kingdom,



which withdrawal had not been published in the European Patent Bulletin. The appellant in that case had argued that a quite specific provision of UK patent law would allow applying provisions corresponding to Article 122(6) EPC to protect the interests of third parties who had got to know of the withdrawal by inspecting the EPO file before the request for retraction was on file. The Board deciding that case considered that to the public in general the withdrawal was not known, because the EPO did not publish it in the European Patent Bulletin. Any individual persons who, having inspected the file, relied on the declaration of withdrawal of the designation could be protected if a national court applied Article 122(6) EPC *mutatis mutandis*. It was not decided that that such protection would exist. Rather it appears that the then Board concluded that the precondition of adequate protection for third parties was met because the possibility of there being adversely affected individuals could be ignored as being *de minimis* given that the withdrawal had not been published in the European Patent Bulletin, and even if such an affected party should exist it might obtain protection under the relevant national law. Following the legal reasoning of decision J 10/87 cannot lead to the allowance of the present request for retraction of a withdrawal, as this has been published in the European Patent Bulletin.

16. The suggestion by the appellant that under Rule 88 EPC a request for retraction of a withdrawal should be allowed in the absence of evidence that third parties had started using the invention relying on the withdrawal, or of evidence that third parties have inspected the register in the period between the

withdrawal and its attempted retraction has no basis under any provision of the EPC, and would appear impracticable as there would be no basis for attributing any legal effect to the mere absence of such evidence. Most seriously it ignores the fact of publication of the withdrawal in the European Patent Bulletin. The Board sees no reason to deviate from the established jurisprudence to adopt such different criteria for allowing a retraction.

17. In conclusion the various additional arguments on behalf of the appellant are not seen as providing any basis for departing from the reasoning set out in points 8 to 10 above, leading to the conclusion that the request for correction under Rule 88 EPC must be refused and the appeal be dismissed.

## **Order**

### **For these reasons it is decided:**

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset