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D E C I S I O N
of 11 March 2005

Case Number: J 0019/03 - 3.1.01

Application Number: 00909889.8

Publication Number: 1152708

IPC: A61D 1/00

Language of the proceedings: EN

Title of invention:

Filled edible product, and system and method for production of
a filled edible product

Applicant:

H.J. Heinz Company

Opponent:

-

Headword:

H.J. Heinz Company/CORRECTION OF A NOTICE OF WITHDRAWAL

Relevant legal provisions:

EPC Art. 112(1)(a), 122(1)(6), 133(2), 134(1)
EPC R. 69(1), 88, first sentence

Keyword:

"Retraction of a notice of withdrawal of an application,
responsible person when deciding on an error pursuant to
Rule 88, first sentence EPC"

Decisions cited:

J 0003/80, J 0004/82, J 0014/82, J 0010/87, J 0011/87,
J 0033/90, J 0003/91, J 0006/91, J 0004/92, J 0042/92,
J 0027/94, J 0007/96, J 0004/97, J 0008/01, J 0006/02,
J 0023/03, T 0824/00, T 0309/03

Catchword:

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Case Number: J 0019/03 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 11 March 2005

Appellant: H.J. Heinz Company
P.O. Box 57
Pittsburgh
Pennsylvania 15230-0057 (US)

Representative: Schmitz, Jean-Marie
Dennemeyer & Associates S.A.
P.O. Box 1502
LU-1015 Luxembourg (LU)

Decision under appeal: Decision of the Examining Division of
24 February 2003 refusing the retraction of the
withdrawal of the application by way of
correction under Rule 88 EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. U. Hoffmann
S. C. Perryman

Summary of Facts and Submissions

- I. This appeal is against the decision of the Examining Division of the European Patent Office deciding to refuse the appellant's request for retraction of the withdrawal of the application in suit, European patent application no. 00 909 898.8.
- II. The European Patent application in suit was filed as international application PCT US 00/00498 on 27 January 2000 in the name of the appellant, a company having its place of business in the US.
- On 2 August 2001 the application, having the publication no. 1 152 708, entered into the European phase.
- III. With faxed letter dated 4 September 2002, received by the EPO on the same day, the appellant, acting through one of its duly appointed European professional representatives requested as follows:
- "We herewith kindly request to withdraw the above identified patent application and to refund the examination fee according to RRF Article 10b EPC."
- IV. On 16 September 2002 the competent formalities officer carried out the administrative acts following a withdrawal and informed the appellant's representative by a letter of the same day of the acknowledgement of the withdrawal and that the examination fee would be refunded at a rate of 75% in accordance with Article 10b(b) of the Rules relating to fees.

V. By faxed letter dated 25 September 2002, received on the same date, the appellant requested that the withdrawal be cancelled by way of correction under Rule 88 EPC and announced that the reasoning would be sent the next day.

By faxed letter received on 26 September 2002 the reasons for the request for correction were filed. Evidence in support of the facts and circumstances of the present case was submitted by declarations from the professional representative and a person in charge at the representatives' office. As a further request it was requested that the refunded amount be re-debited from representatives' deposit account number.

VI. The fact and the date of the withdrawal of the application was entered in the European Patent Register on 21 September 2002 indicating in brackets the year and the week [2002/45] of the publication in the European Patent Bulletin.

VII. On 6 November 2002 the withdrawal of the present application was published in the European Patent Bulletin 2002/45 under section I.8(2).

VIII. On 4 December 2002 the European Patent Bulletin 2002/49 was published. Under section I.12(22) it was stated that the corrected date of the withdrawal of the application with the publication number 1 152 708 was 4 September 2002.

IX. With communication pursuant to Article 113 EPC posted on 8 January 2003 the EPO informed the appellant that the requirements for allowing the retraction of the

withdrawal under Rule 88 EPC seemed not to be fulfilled. In response to this communication from the Examining Division the appellant informed the EPO by letter of 5 December 2003 that the request for revocation of the withdrawal of the application was maintained and that an appealable decision was requested.

- X. By a decision of the Examining Division issued on 24 February 2003 the request for retraction of the withdrawal by way of correction was refused. The Examining Division stated in the "Summary of facts" of its decision that the withdrawal of the application in suit had been entered in the European Patent Register on 21 September 2002 and had been published in the European Patent Bulletin 2002/49 on 6 November 2002 and, due to a mistake, once again in the European Patent Bulletin 2202/49 on 4 December 2002.

In the reasons for this decision it was pointed out that an applicant who submitted a valid withdrawal was generally bound by its own acts and declarations.

However, referring to Legal Advice no. 8/80 (OJ EPO 1981,6) and decisions J 10/87 (OJ EPO 1989, 323) and J 4/97 of the Boards of Appeal, the Examining Division confirmed the possibility to correct a withdrawal of a patent application made by error in cases where the need for legal certainty and the protection of third parties does not prevail over the interests of the applicant. The Examining Division then took the view that in order to safeguard the interests of the public it was too late to revoke the withdrawal of the present patent application at the time the withdrawal had already been entered into the Register because the

public had already been officially notified of the withdrawal. The Examining Division noted that the entries into the European Patent Register are official as much as the ones in the European Patent Bulletin and did thus not accept the appellant's argument that the public would only have relied on the publication in the European Patent Bulletin.

XI. The appellant filed a notice of appeal by faxed letter on 17 March 2003, paid the appeal fee on the same day and filed a statement of grounds of Appeal by fax on 11 June 2003. Further submissions were filed on 3 February 2005.

XII. The appellant's arguments can be summarised as follows:

- (a) The notice of the withdrawal was erroneous and could be cancelled under Rule 88 EPC since it did not reflect the appellants intention to continue with the application.

The error arose due to a misinterpretation of a returned renewal notice on a form of a company associated with the appellant's European representatives which monitored the payment of fees (the so-called "annuity company"). This form was sent by this annuity company to the appellant's US attorneys and it stated that the annuity concerning the present application in an amount of 370 USD had been due for payment on 27 January 2002 and that one copy of this form should be returned with the instruction "P" for pay and "C" for cancel by 1 December 2001. The form had been marked by the US attorneys with a "C". On the

bottom of this form, a text had been added by a stamp which read as follows: *Annuity/Maintenance fee is to be handled by computer annuity service. Please remove from your annuity calendar.* The text had been signed by the US attorneys and dated November 2001.

According to the appellant's submission, a copy of the aforementioned renewal notice was forwarded by the "annuity company" to the appellant's representatives, who had (allegedly) never before received such a form in cases where the patent application was not to be abandoned.

At that time, the present application had been dealt with on behalf of the European representative by a person who was a master of biochemistry, a holder of a diploma of CEIPI and who had been working there for nearly four years in the field of EPC patent law to the greatest satisfaction but who was not yet qualified as a European representative. This person had noted the renewal notice for the first time on 4 September 2002 and misinterpreted it as an instruction to withdraw the application. He had never before seen this renewal notice due to its being misplaced in the file. In order to safeguard a refund of 75% of the Examining fee the person dealing with the application had quickly written the withdrawal letter of 4 September 2002 and submitted it to the appellant's representative who checked only the European patent application number, but did not check that the withdrawal was in accordance with the appellant's instruction before signing the

letter of withdrawal in reliance on the competence of the person dealing with the application.

According to the appellant, some days after receipt of the EPO notification of the acknowledgement of withdrawal dated 16 September 2002 the person dealing with the case had reviewed the file because he had been going to inform the client that 75% of the Examination fee had been refunded. At this moment he had realised his error in overlooking the bottom part of this renewal notice stating that "Annuity/Maintenance fee is to be handled by Computer Annuity Services" which meant that while the so-called "annuity service" had been instructed to remove the application in suit from its computerised system, this had been no instruction to the European representatives to abandon the application, but had merely indicated that the annuity for the European patent application would be paid through another channel.

By referring to decision T 309/03 (OJ EPO 2004, 91) it was submitted that the representative's omission to check the correctness of the withdrawal with respect to the client's true intention has to be considered an error in the sense of Rule 88, first sentence EPC, because the appellant himself had never changed its mind with respect to the prosecution of this application and the letter of 4 September 2002 had been filed without the knowledge or authority of the appellant due to an administrative error.

The appellant contested the statement in the decision under appeal that the withdrawal of the application in suit had been published in the European Patent Bulletin 2002/45 on 4 November 2002 and filed a copy of page 312 of this European Patent Bulletin concerning its Section I.12(22) where the application number in suit was not mentioned. It was argued that the withdrawal of the application in suit had been recorded for the first time only in European Patent Bulletin 2002/49 on 4 December 2002. The appellant argued that since the request for withdrawal had been filed six weeks before the publication of the withdrawal by the European Patent Bulletin, enough time had been available to the EPO to avoid this publication and, therefore, the publication of the withdrawal had occurred erroneously in the European Patent Bulletin. The appellant should not suffer any damage because of an error made by the EPO.

Additionally, the appellant argued that the withdrawal of the application should only have been published in the European Patent Bulletin once the time limit set in the EPO's communication of 8 January 2003 issued after receipt of appellant's request for correction had expired without response or following a negative reply from the appellant or after the expiration of the deadline for filing an appeal if the appellant had not replied and in any case not before these deadlines, since according to Article 106 EPC an appeal has a suspensive effect.

- (b) Furthermore, the appellant based its request on the fact that the entry of the withdrawal of the patent application into the Register was made on 21 September 2002 and that the request for cancellation of the withdrawal was filed on 25 September 2002, i.e. only 4 days later. Any third party who inspected the Register between 21 September and 25 September 2002 and who was informed that the application was withdrawn would not have relied on this information but would have consulted the Register some time later again because a withdrawal could result from the fact that the application was deemed to be withdrawn under Article 96(3) EPC which would allow the applicant to proceed under Article 121 EPC after having received a notice of loss of rights under Rule 69(1) EPC. The third party would have inspected the Register again after the 25 September 2002 and it would have seen that the most recent event recorded in the Register was a request for decision dated 25 September 2002. This entry would have induced the third party to inspect the file when it would have noticed appellant's letters of 25 and 26 September requesting the cancellation of the withdrawal of the application in suit.
- (c) In a further line of reasoning the appellant relied on the same facts and submissions but additionally submitted a proposal on how the interests of a third party having inspected the European Patent Register between 21 September and 25 September 2002 and relying on the withdrawal of the application could be safeguarded. The

appellant claimed that based on Article 125 EPC, it should be decided that *"Any person who, in a designated Contracting State, in good faith has used or made effective and serious preparations for using the invention which is subject of this published European patent application in the course of the period between the mention of the withdrawal of the patent application in the European Patent Register (i.e. on 21 September 2002) and the earliest day between the publication of the request for the decision concerning the revocation of the withdrawal in the European Patent Register and the day on which our letter requesting the cancellation of the withdrawal has been made available by inspection of the file, may without payment continue such use in the course of his business or for the needs thereof."*

This proposal then dealt with the possible means of giving evidence by the third party concerned.

XIII. During the oral proceedings held on 11 March 2005 the appellant essentially referred to his written submissions and argued that the following question should be referred to the Enlarged Board of Appeal:

"In case a European patent application has been erroneously withdrawn, should a withdrawal retraction requested pursuant to Rule 88 EPC first sentence, on September 25, 2002 (i.e. at the beginning of the career of the on-line Patent Register, starting only about one year ago), filed after the publication of the withdrawal in the online Patent Register and before the

publication of the withdrawal in the European Patent Bulletin be allowed?"

- XIV. At the end of the oral proceedings the appellant requested that the withdrawal of the application be cancelled and the Examination prosecution be continued and, as auxiliary request, that the question submitted at the oral proceedings on 11 March 2005 be referred to the Enlarged Board of Appeal before any decision adverse to the appellant is taken.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 1(1) and 64(b) EPC and is, therefore, admissible.
2. The appellant claimed under point 8 of its statement of grounds of appeal that the withdrawal request dated 4 September 2002 had been submitted due to an excusable error by its professional representative.

It was not contested by the appellant that the wording in the withdrawal letter dated 4 September 2002 "We herewith kindly request to withdraw the above identified patent application and to refund the examination fee according to RRF Article 10b EPC" contained an unambiguous and unconditional statement requesting withdrawal of the application. Therefore according to the jurisprudence of the Boards of Appeal (acknowledged by the statement in Legal Advice from the European Patent Office No. 8/80, OJ EPO 1981, 06), the procedural act of the withdrawal of the application took effect immediately after receipt of the withdrawal

letter at the European Patent Office on 4 September 2002 because to take legal effect it is not necessary that such a receipt is confirmed by the EPO.

Furthermore for avoidance of any misunderstanding, the Board points out that the deliberate withdrawal of an application does not establish any loss of right resulting from the Convention pursuant to Rule 69(1) EPC.

Therefore, the present retraction of the withdrawal could only be justified if a correction of the notice of withdrawal of 4 September 2002 under Rule 88 first sentence EPC can be allowed.

3. Rule 88, first sentence EPC pertains to the correction of errors, errors of transcription and mistakes which occurred in any documents filed with the EPO other than descriptions, claims or drawings filed with the Office.

Correction under Rule 88, first sentence EPC, if allowed, has a retroactive effect with the consequence that the document containing the error has to be regarded as if it was filed in the corrected form (so called *ab initio* effect).

According to the established jurisprudence of the Boards of Appeal which refers to documents relating to the preparation of the European Patent Convention (J 8/80, point 3 of the reasons, OJ EPO 1980, 293; J 4/82 point 3 of the reasons, OJ 1982, 385) Rule 88 EPC also applies to corrections of procedural acts if they are submitted by a document as i.e. a request for correction of designation of a State, of a claimed

priority or as in the present case of the withdrawal of an application (cf. J 4/97, point 4 of the reasons).

4. The Board notes that the application of Rule 88, first sentence EPC to a correction of a procedural act seems to be a more extensive interpretation than the mere wording of the first sentence of Rule 88 EPC indicates. The actual wording relates to factual errors whereas the extensive interpretation would also cover correction of subjective notions. Therefore, this extensive interpretation has to be seen in the context of the whole European Patent Convention (see below) and its statutory principles which must not be violated by a too broad or extensive interpretation of Rule 88, first sentence EPC.

5. It is further obvious that corrections of procedural acts having an *ab initio* effect have a potentially serious impact on an application, in particular if they relate to its territorial extent or to whether the application is pending at all, and raise serious concerns as to legal certainty not only for the applicants vis-à-vis the EPO but also for the public.

Therefore, the jurisprudence of the Boards of Appeal took as a starting point that, as a general rule, an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. J 11/87, points 3.3 and 3.6 of the reasons, OJ EPO 1988, 367; J 27/94, point 8 of the reasons, OJ EPO 1995, 831) and is not allowed to reverse these acts so that they can be considered as never filed (J 10/87, point 12 of the reasons, OJ 1989, 323; J 4/97, point 2 of the reasons).

On the other hand, the Boards of Appeal considered that Rule 88 EPC acknowledges as a further legal value the desirability of having regard to true as opposed to ostensible party intentions in legal proceedings (T 824/00, point 6 of the reasons, OJ EPO 2004, 005) in appropriate circumstances.

6. As a result of the conflict between these two legal principles, the case law reads Rule 88, first sentence EPC so that it confers a discretion on the competent instance to allow or not to allow a correction of an error since it is only stated in this rule that a respective error "may be corrected". Moreover, the fact that the provision is framed as a discretionary power in a rule rather than as an article is evidence that the principle underlying Rule 88, first sentence EPC is seen as a subordinate one which should not prevail in a serious conflict with other values underlying the articles of the EPC such as procedural certainty or legitimate interests of the public.

7. In order to weigh the necessity for legal certainty and the interests of the public against the interest of an applicant, the jurisprudence developed criteria concerning when a correction of procedural acts may be allowable or not. As the appellant only referred to some of these criteria, the Board considers it necessary to provide a more complete list of these criteria as follows:
 - a. whether an erroneous procedural act occurred and was made due to an excusable oversight;

- b. whether the request for correction of a procedural act was made immediately when the representative became aware of the erroneous procedural action;
- c. whether the public had been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied or whether the interest of the public was safeguarded even after this notification (J 14/82, point 8 of the reasons, OJ EPO 1983, 121; J 3/91, point 4 of the reasons);
- d. whether the requested correction results in a substantial delay of the proceedings

(as regards point a. to d cf. J 10/87, point 14 of the reasons, OJ EPO 1989, 323); and

- e. whether the requested correction violates fundamental legal procedural principles (cf. T 824/00, point 8 of the reasons, OJ EPO 2004,005), in particular whether it circumvents defined statutory procedures as for example laid down in Article 122 EPC (cf. J 6/02, point 15 of the reasons, not published in OJ EPO).
- f. In any case, it must be pointed out that the foregoing prerequisites are not exhaustive and the balance of interest has to be determined in each case on the basis of its own facts (cf. the considerations in J 8/01, point 3.5 of the reasons, OJ 2003, 003). In particular, when weighing the interests of the public against those of the applicant, the Board has to consider the criteria "excusable oversight" and "immediately made request"

(see section a. and b. above) although these requirements are not mentioned in Rule 88, first sentence EPC at all.

g. Finally, the admissibility of a request for correction was denied in cases where the pendency of application or opposition proceedings before the EPO had ended before the request was filed (cf. J 42/92, point 6 of the reasons for a request for correction under Rule 88, second sentence EPC) or the requested correction would have had no legal effect on the outcome of the proceedings and no legitimate interest to take action was approved (cf. J 23/03, point 2.2.1 of the reasons).

8. Therefore as regards the correction of procedural acts, the jurisprudence not only confines the application of Rule 88 EPC by imposing a time limit for filing a request for correction but also indicates that the application of Rule 88 EPC is subject to the fundamental legal procedural principles of the EPC on the facts of each single case.

The Board holds that one of these procedural principles is stipulated by the articles of the EPC concerning the power and the responsibility conferred on the professional representative and which has to be considered when the requirement pursuant to Rule 88, first sentence EPC that an error occurred has to be interpreted. Therefore the question arises whose error and what sort of error falls within the scope of Rule 88 EPC. The Board notes that, according to the submissions of the appellant, in the present case the error occurred in the sphere of the representative and

not that of the applicant so that the Board has only to decide on this factual situation.

9. First of all, it should be obvious that a change of mind or a change of decision by a party or its representative would not justify a correction under Rule 88 EPC (cf. J 6/91, point 2.2(3) of the reasons, referring to J 8/80, supra) because this would not concern a correction of an error which already occurred at the time when the document had been filed.
10. The case law of the Boards of Appeal does not distinguish between an error and a mistake because the two expressions are mentioned interchangeably in Rule 88 EPC. Both are equally defined as a mistake or error which exists where a document filed with the EPO does not express the true intention of the person on whose behalf it was filed (J 6/91, point 3(1) of the reasons). Furthermore, the jurisprudence accepted that a mistake or error could result from an omission of the person responsible for the case.
11. According to decision J 6/91 (see above point 10) the concept that an error is indicated when a divergence occurs between the applicant's true intentions and the procedural act actually performed was restricted by decision T 309/03 (supra). There, it has been decided that the mere fact that a representative has filed a notice of appeal before taking note of the applicant's adverse instruction does not justify a correction to the effect that no appeal has been filed (point 2.4 of the reasons, OJ EPO 2004, 091). The decision clarifies that a client's professional representative is responsible for his or her acts (respective omissions).

12. According to Article 133(2) EPC the appellant as a legal person not having its principal place of business within the territory of one Contracting State had to be represented by a professional representative and act through him in all proceedings established by the Convention, other than in filing the European patent application. Thus, according to the EPC the professional representative was authorized to withdraw the application for and on behalf of the appellant by letter of 4 September 2002 without further explicit authorization.

As regards the legal capacity of each professional representative under the EPC, the Board holds that even in cases where the representative deviates deliberately from the true intentions of his client for example to do the best for his client, a correction under Rule 88 EPC cannot be allowed because no error or mistake has occurred. Rule 88 EPC must not, for reasons of legal certainty, establish a possibility for a party to limit retroactively the authority of its professional representative to act for and on behalf of his client before the EPO.

Thus, under Rule 88, first sentence EPC it is not sufficient to prove that a divergence has occurred between the true intention of the applicant and the declaration filed by its representative; rather it is additionally required that this divergence was caused by an error of the person who was competent to make the decision on the procedural act before the EPO. Therefore, as a rule, in cases where the party is represented by a professional representative the error

pursuant to Rule 88 EPC must be an error of the representative in expressing his own intentions. The Board has not to decide on the further legal question whether or not a procedural act performed by a professional representative on behalf of his client before the EPO could be corrected under Rule 88 EPC when the representative had acted on a specific but erroneously given instruction of his client because this is not the case here.

13. When applying the foregoing principles to the present case, it must be concluded that the representative did not act erroneously in the sense of Rule 88 EPC.

Appellant's representative admitted by his declaration of 26 September 2002 that before signing the withdrawal letter of 4 September 2002 he only checked the number of the application but nothing else.

According to his statement he relied by mistake on the capacity and the reliability of the person in charge who was allegedly handling the patent application under his supervision. In the Board's view, the error of the person in charge is not decisive in the present case, because this person was not competent and authorised to file any declaration with the EPO for and on behalf of the appellant and was therefore not a person whose error could be considered under Rule 88 EPC. This principle must not be circumvented by a procedural situation where the person allegedly in charge and not being a professional representative decided to withdraw the application and the responsible representative only signed the notice without checking the facts of the case. The fact that the representative had full

confidence in the person in charge was possibly erroneous but this error does not fall within the scope of Rule 88 EPC. The decision about which procedural act should be performed before the EPO falls into the core responsibility of the authorised professional representative which, according to Article 134(1) EPC, must not be delegated to other persons. The case law concerning the requirement of due care pursuant to Article 122(1) EPC already decided that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally (cf. J 33/90, reasons point 3.3). This interpretation can be concluded from the principle laid down in Article 134(1) EPC stipulating that the representation of applicants before the EPO is accorded only to "professional representatives". The same concept applies to the question whether or not an error pursuant to Rule 88, first sentence EPC occurred. If the representative relied on the capacity and the experience of the person in charge he cannot claim that he acted erroneously in the sense of Rule 88, first sentence EPC. By signing the withdrawal letter of 4 September 2002 the appellant's representative did not misinterpret any facts of the present case which, according to his own submissions, he had not monitored. As the professional representative did not know about the existence and content of the renewal notice, there can be no question of the representative misconstruing it.

14. Finally, the appellant cannot claim that the omission of his representative to check the correctness of the withdrawal with respect to his client's true intentions

established an error pursuant to Rule 88 EPC. This omission might be professional negligence but does not establish an error or mistake with respect to the meaning of the declaration signed.

15. Therefore, the Board decides that the notice of withdrawal of 4 September 2002 does not contain a relevant error or mistake which can be corrected under Rule 88, first sentence EPC. The request for correction of this notice is not allowable and the applicant is bound to the withdrawal of the application.

Consequently, as already one requirement pursuant to Rule 88 EPC is not fulfilled, there is no reason for the Board to decide on other requirements of this Rule as developed by the established case law. The Board does not need to decide whether the alleged oversight was excusable or to weigh the public interests against the appellant's interests or to decide whether the protection of third parties under Article 122(6) EPC applies on the present case.

16. As regards the auxiliary request for referral of the legal question cited in the submissions to the Enlarged Board of Appeal the Board points out that pursuant Article 112(1)(a) EPC the requested decision of the Enlarged Board of Appeal must be decisive for the outcome of the present case otherwise the referral would be inadmissible. As the request for retraction of the withdrawal is refused for the lack of an error, the further question whether or not a retraction before the publication can be allowed is not decisive. Therefore, the auxiliary request is to be refused.

Order

For these reasons it is decided that:

1. The request for referral of a question to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset