

Decision of the Legal Board of Appeal dated 27 April 2005

J 25/03 - 3.1.01

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset
Members: E. J. Dufrasne
M. B. Günzel

Applicant/Appellant: MITSUI CHEMICALS, INC.

Headword: Withdrawal of application/MITSUI CHEMICALS

Article: 127, 129 EPC

Rule: 88, 92 EPC

Keyword: "Correction (retraction) of withdrawal of an application (no) - Mention of withdrawal in the Register of European Patents"

Headnote:

I. An entry of a withdrawal of a patent application in the Register of European Patents amounts to its notification to the public as well as a publication in the European Patent Bulletin (cf. point 9 of the Reasons, at the end).

II. A request for retraction of a letter of withdrawal of a patent application is no longer possible if the withdrawal has been mentioned in the Register of European Patents at the time its retraction is applied for if, in the circumstances of the case, even after a file inspection there would not have been any reason for a third party to suspect, at the time of the official notification to the public, that the withdrawal could be erroneous and later retracted (cf. points 10 and 11 of the Reasons).

Summary of facts and submissions

I. On 14 April 2003, the appellant (applicant) lodged an appeal against the decision of the Examining Division despatched on 13 February 2003 concerning the refusal to retract the withdrawal of application 96933616.3 filed on 9 October 1996. The appeal fee was paid on the same day and the statement of grounds of appeal was filed on 20 June 2003.

II. The application-in-suit was filed in Japanese as a PCT application. After entry into the regional phase before the EPO, its translation into English was published by the EPO on 24 September 1997.

III. By a letter dated 18 December 2002 and received at the European Patent Office on the same day, the application was unconditionally withdrawn by the applicant.

By a letter dated 13 January 2003 (Form 2077), the Examining Division acknowledged the withdrawal of the application.

IV. By a letter dated 15 January 2003 and received at the European Patent Office on the same day, the applicant requested correction under Rule 88 EPC of its earlier withdrawal of the application.

V. In the decision under appeal, the Examining Division stated that the request for retraction of the withdrawal arrived in the EPO after publication in the Register of the withdrawal of the application, on 11 January 2003. The Examining Division therefore held it would have been against the public interest to accept the retraction, citing decisions J 10/87, J 22/95 and J 4/97.

VI. In its statement of grounds and during oral proceedings, the appellant argued essentially as follows:

Decisions J 10/87 and J 4/97 are the fundamental ones in the present case. According to these decisions, a request for retraction of the withdrawal of an application as a whole may be allowable under Rule 88 EPC if:

- (a) the public has not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal is applied for;
- (b) the erroneous withdrawal is due to an excusable oversight;
- (c) there is no substantial delay of the proceedings;
- (d) the EPO is satisfied that the interests of third parties who may possibly have taken notice of the withdrawal by inspection of the file are adequately protected.

Declarations have been submitted which explain and support the factual circumstances of the misunderstanding between the applicant and its Japanese representative which had led to the unconditional withdrawal by the European authorised representative. This results from an excusable oversight.

There was no undue delay in seeking retraction of withdrawal since the request for retraction had been filed only one day after the mistake had been noticed by the Japanese representative.

Third parties were informed as of 15 January 2003, in the public part of the file, of the request for retraction of the withdrawal and thus warned against relying on the information published in the Register on 11 January 2003. Consequently, third parties were sufficiently protected over the very short time period from 11 January to 15 January 2003. That time period of four days during which third parties had no means to be aware of the request for retraction of the withdrawal, even by inspecting the official file is very short. This distinguishes the situation in the present case from a situation referred to in cited decision J 14/04, where the corresponding intervening time was more than one month, which is substantially longer.

The public had not been officially notified of the withdrawal of the application at the date of its retraction, this official notification to the public being only achieved by the publication of the withdrawal in the Bulletin and not by its entry in the Register.

VII. In a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal, the Board summoned the appellant to oral proceedings and expressed the preliminary opinion that, the withdrawal of the application having been officially notified to the public by its mention in the Register of European Patents and information to the contrary not being available to the public, its retraction could not probably be allowed.

In a further notification a copy of decision J 14/04 was sent to the appellant for consideration in view of the oral proceedings.

VIII. Oral proceedings were held on 27 April 2005.

IX. The appellant requested that the decision under appeal be set aside and that the retraction of the withdrawal of the application be allowed.

Reasons for the decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.
2. Rule 88 EPC, the application of which is requested by the appellant, allows correction of errors under strictly defined conditions (see elements on the origins of Rule 88 EPC in an early decision based thereon, J 8/80, OJ EPO 1980, 293, Facts and Submissions, points IX to XIV and its strict application in the same decision, point 6 of the reasons).

Decision J 10/87 (OJ EPO 1989, 323) applied Rule 88 EPC so as to allow the retraction of the withdrawal of the designation of a Contracting State in a published patent application, in appropriate circumstances.

Decision J 4/97 of 9 July 1997 applied the reasoning of J 10/87 to allow the retraction of the withdrawal of a published patent application as a whole.

These two decisions carefully consider the exceptional character of the correction of errors under Rule 88 EPC, based on the requirement of legal certainty and balancing the interests of the applicant and of third parties (J 10/87, points 8 to 13 of the reasons, J 4/97, point 4 of the reasons).

The appellant does not challenge the basic relevance of these decisions nor the conditions developed therein and, on the contrary, referred to them in its argumentation.

3. Amongst the appropriate circumstances established by decisions J 10/87 and J 4/97 for allowing correction under Rule 88 EPC is the condition that "at the time the retraction of the withdrawal is applied for, the public has not been officially notified of the withdrawal by the EPO" (J 10/87, point 13 of the reasons).

In decision J 10/87, that condition was fulfilled, since the withdrawal of the designation was not published in the European Patent Bulletin before the retraction of the withdrawal had been applied for (point 14 of the reasons). The Board also clearly stated in that decision that legal certainty must prevail and that the public interest in being able to rely on information officially published by the European Patent Office must rank higher than the interest of a patent applicant in having its statement withdrawing the application, already notified to the public, corrected.

In decision J 4/97, that condition was also fulfilled since retraction of the withdrawal of the patent application was requested before the withdrawal had been published in the European Patent Bulletin and even before it had been mentioned in the Register of European Patents (point 6 of the reasons).

In the earlier decision J 15/86 (OJ EPO 1988, 417), the Board also considered that it was too late to ask for retraction of a withdrawal once the withdrawal had been notified to the public in the European Patent Bulletin.

4. It can be deduced from these decisions that for Rule 88 EPC to apply, the withdrawal of a published patent application must not have been officially notified at the time the retraction of the withdrawal is requested, in the interest of legal certainty, and balancing the interests of the applicant and of the third parties.

These decisions also clearly state that publication in the European Patent Bulletin of the withdrawal is an official notification thereof, which renders its further retraction impossible.

However, they do not directly answer the question submitted in the present case, i.e. whether or not the mention of the withdrawal in the Register of European Patents has to be considered as an official notification to the public which would render retraction of the withdrawal impossible from said mention, even before further possible publication of the withdrawal in the European Patent Bulletin.

In other words, these decisions establish that the withdrawal has been officially notified to the public and its retraction is no longer possible if the withdrawal has been published in the European Patent Bulletin. However, it cannot be inferred therefrom, contrary to the appellant's argument, that said publication in the European Patent Bulletin is necessarily the only instrument to officially notify the public of the withdrawal and to render its further retraction impossible.

5. The question is then whether mention in the Register of European Patents or publication in the European Patent Bulletin can be assimilated as both being official notifications to the public.

6. In decision T 824/00 (OJ EPO 2004, 5, point 8 of the reasons in fine), publication in the European Patent Bulletin and mention in the Register of European Patents are considered as being comparable when decision J 10/87 is interpreted as preventing retraction after the withdrawal was published in the European Patent Bulletin or even after publication in the Register of European Patents.

7. In decision J 14/04 of 17 March 2005, a situation very similar to the present one was considered where retraction of the withdrawal of a patent application was requested after mention of the withdrawal in the Register of European Patents but before its publication in the European Patent Bulletin.

In that case, it was examined whether the mention of the withdrawal of a patent application in the Register of European Patents should properly be considered as an official notification to the public in the sense of the condition established by decisions J 10/87 and J 4/97.

8. Decision J 14/04 refers to the European Patent Convention, which in Chapter II of Part VII sets out the "Information to the public or official authorities".

According to Article 127 EPC, the European Patent Office shall keep a register, to be known as the Register of European Patents, which shall contain those particulars the registration of which is provided for by this Convention.

Rule 92 EPC further lists the entries in the Register, which includes, in paragraph (n), the date on which the European patent application is refused, withdrawn or deemed to be withdrawn.

These references to the text of the European Patent Convention clearly support the official character of the entries in the Register of European Patents, in particular the mention of the withdrawal of a patent application.

Moreover, Article 129(a) EPC states that the European Patent Bulletin contains entries made in the Register of European Patents.

This indicates clearly that the contents of the European Patent Bulletin relies on entries in the Register of European Patents. It corroborates the official character of the entries in the Register of European Patents and, to a certain extent, even its precedence over the European Patent Bulletin.

So, contrary to what is alleged by the Appellant, legal effects are associated not only with the publication in the European Patent Bulletin, but also with entries in the Register of European Patents. As an example, unless the conditions of Rule 20(3) EPC are met, it is the person registered as applicant, i.e. the person whose name is entered into the Register of European Patents, who is the party to the proceedings and who is deemed to be entitled to exercise the right to the European patent, in accordance with Article 60(3) EPC (J 26/95, OJ EPO 1999, 668, point 2 of the Reasons), irrespective of whether or not the right to a European patent belongs to him as a matter of substance (see Article 60(1) EPC).

9. As to the public character of the content of the Register of European Patents, Article 127 EPC mentions that it is open to public inspection.

As regards the European Patent Bulletin, Article 129(a) EPC explicitly refers to it as being a publication.

No conclusive difference can however be derived simply from this minor and strictly literal difference.

In a broader approach, the public dimensions of the European Patent Bulletin and of the Register of European Patents have to be considered in the framework of how these official sources of information have actually been made available by the European Patent Office to the public since the time the withdrawal of the patent application had been mentioned in the Register of European Patents. Both the European Patent Bulletin and the Register of European Patents are similarly offered freely to the public via *epoline*[®], on the internet. Not only is it possible for any person to access the Register of European Patents on-line but also a service is offered which allows tracking changes in all files of published applications, using tailor-made lists of patent applications. Combined with an additional software tool, it renders it possible to compare data and identify changes immediately, or even automatically to receive an e-mail alert every time a change occurs in any of the cases previously selected in the Register of European Patents (at that time through WebRegPro. See WebRegPro: monitoring patent applications using the *epoline*[®] online European Patent Register, EPIDOS News 4/2002, December 2002, also published on the European Patent Office internet site, in the News, on 20 December 2002).

These factual elements surrounding the official character of the information available support the general availability to the public of the entries in the Register of European Patents, from the day they appear therein.

Consequently, an entry in the Register of European Patents also amounts to a notification to the public as well as a publication in the European Patent Bulletin.

10. For these reasons, the Board holds that the public has been officially notified of the withdrawal of the patent application by its mention in the Register of European Patents on 11 January 2003, before the request for retraction of the withdrawal. Even after possible inspection of the complete file, there would not have been any reason for a third party to suspect at that time that the withdrawal could be erroneous and later retracted.

The Board considers that legal certainty and the balance to be made of the applicant's and of third parties' interests do not allow the application of Rule 88 EPC in the present circumstances to authorise the retraction of the withdrawal of the patent application.

11. Because the request for correction of the withdrawal of the patent application has to be rejected for the above reasons, any other requirement for such a correction or its possible fulfilment in the present case need not be considered.

In particular, it is of no relevance for the present decision that only four days lapsed from the mention of the withdrawal in the Register of European Patents to the introduction on the file of the request for retraction of the withdrawal.

The official notification to the public of the withdrawal is a key step and legal certainty would suffer unacceptably if further delay, even for an allegedly "short" period of time, were permitted for retraction of the withdrawal in such circumstances as the present ones, where even after possible inspection of the complete file there would not have been any reason for a third party to suspect, at the time of the official notification to the public of the withdrawal, that the withdrawal could be erroneous and later retracted.

Order

For these reasons it is decided that:

The appeal is dismissed.