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**Datasheet for the decision
of 15 March 2006**

Case Number: J 0037/03 - 3.1.01

Application Number: 99908592.1

Publication Number: 1060343

IPC: F21V 8/00

Language of the proceedings: EN

Title of invention:

Optical fiber and illumination device

Applicant:

MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

-

Headword:

Withdrawal of application/3M I

Relevant legal provisions:

EPC R. 88
RRF Art. 10b

Keyword:

"Conditional withdrawal of application (effective) -
correction of withdrawal of application (no)"

Decisions cited:

G 0002/04, J 0011/80, J 0010/87, J 0004/97, J 0004/03,
J 0012/03, J 0025/03, J 0014/04

Catchword:

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Case Number: J 0037/03 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 15 March 2006

Appellant: MINNESOTA MINING AND MANUFACTURING COMPANY
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Decision under appeal: Decision of the Formalities Officer, acting for
the Examining Division of the European Patent
Office, posted 9 May 2003.

Composition of the Board:

Chairman: M. B. Günzel
Members: R. Moufang
E. Dufrasne

Summary of Facts and Submissions

- I. The present appeal concerns the decision of the Formalities Officer, acting for the Examining Division, of 9 May 2003 which refused the request of the applicant (appellant) for correction of the withdrawal of the European patent application 99 908 592.1.

- II. The above application was originally filed as international application PCT/US99/04445 claiming the priority of a US application of 2 March 1998. In the international phase the European Patent Office (EPO) acting as International Searching Authority (ISA) as well as International Preliminary Examining Authority (IPEA) prepared an international search report and an international preliminary examination report. The requirements for entry into the European regional phase were fulfilled on 29 August 2000. Examination under Article 94 EPC was requested.

- III. By letter dated 5 December 2001, received at the EPO on the same day, the applicant stated the following:
"Provided that the substantive examination has not yet begun, we herewith withdraw the above European patent application and request that the examination fee is partly or in full refunded according to Art. 10b of the Rules Relating to Fees of the European Patent Office."

- IV. On 19 December 2001 the EPO sent out a communication in which it acknowledged to have received the declaration of withdrawal on 5 December 2001. It stated that the 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 of the application was entered in the Register of European Patents on 20 December 2001. The mention of the withdrawal was later published in the European Patent Bulletin on 6 February 2002.

- V. By letter dated 27 December 2001, received on the same day, the applicant informed the EPO that the withdrawal had been made erroneously and was "retracted" in accordance with Rule 88 EPC. The applicant requested that the application be further prosecuted and that no refund of the examination fee should be made. It moreover requested that no entry of the withdrawal should be made in the Register for European Patents and in the European Patent Bulletin.
- VI. By letter dated 7 February 2002, the applicant again requested examination of the application and paid the examination fee again. By a further letter of 25 February 2002 the applicant submitted facts and arguments in support of its request for retraction/correction of the withdrawal.
- VII. The request of the applicant was refused by the decision of the Formalities Officer, acting for the Examining Division, of 9 May 2003.
- VIII. On 18 July 2003 the applicant filed an appeal against the above decision and paid the appeal fee. A statement setting out the grounds of appeal was received on 19 September 2003. On 12 October 2005 the Board summoned to oral proceedings and set out its preliminary view on the merits of the appeal.

IX. On 15 March 2006 oral proceedings took place before the Board. The appellant requested that the decision under appeal be set aside and that the patent application be declared not withdrawn. At the end of the oral proceedings the Chairman announced the Board's decision.

X. Appellant's arguments which are relevant to this decision and which were presented in the written submissions and at the oral proceedings may be summarised as follows:

- (a) The withdrawal of the application was not effective since the condition under which it was made, namely that the substantive examination had not yet begun, was not fulfilled. The present application was originally filed as an international application for which the EPO acted both as International Searching Authority and as International Preliminary Examining Authority. Since usually the examiner acting in the international phase became the First Examiner during the regional phase and, when writing a first communication in the regional phase, frequently only referred to the objections raised during the international phase, substantive examination had already begun.
- (b) The withdrawal was made erroneously and could therefore be corrected under Rule 88 EPC. The public was not officially notified of the withdrawal when the request for "retraction" was filed on 27 December 2001. At that time the withdrawal had not yet been published in the European Patent Bulletin, but only in the Register

of European Patents. There was a clear legal distinction between the entry of information in the Register, on the one hand, and the official notification to the public in the Bulletin, on the other hand, both being parts of a two step procedure. The distinction was laid down in the EPC and could not be changed by mere factual developments such as the availability of the Register online. Furthermore, the EPO did not assume liability for the accuracy of information entered in the Register and accessed online.

Reasons for the decision

Admissibility of appeal

1. The appeal satisfies the requirements of Articles 106 to 108 and Rule 64 EPC and is therefore admissible.

Validity of conditional withdrawal

2. The declaration of the applicant to withdraw its application was made under the negative condition that the substantive examination had not yet begun. In the same letter reference was made to Article 10b of the Rules relating to Fees (RRF). This provision stipulates *inter alia* that the examination fee shall be refunded at a rate of 75% if the European patent application is withdrawn after the Examining Division has assumed responsibility but before substantive examination has begun.

3. As stated by the Enlarged Board of Appeal in its decision G 2/04 (OJ EPO 2005, 549, point 3.2.1 of the reasons), procedural declarations must in general not be subject to any conditions since in the interest of legal certainty and efficiency of proceedings it should be clear from the outset whether a declaration is valid. This applies in particular to declarations initiating or terminating a procedure. It has thus been held that the withdrawal of an application is only effective if it is completely unqualified and unambiguous (cf. J 11/80, OJ EPO 1981, 141, point 5 of the reasons).

4. However, the requirement that procedural declarations be unconditional does not apply without exception as evidenced by the recognition of the filing of auxiliary requests (G 2/04, *ibidem*). There are further situations where conditional procedural declarations may be acceptable as long as they are not made dependent on an uncertain event outside the proceedings. In particular, it may occur that a patent applicant is uncertain as to whether his application has entered a specific procedural stage and that he wishes to withdraw his application only if this procedural stage has not yet been reached. Thus, in the above-cited decision J 11/80 (point 4 of the reasons) the Legal Board of Appeal considered it as "not uncommon" that an applicant withdrew his application under the condition that the contents of the application remained undisclosed to the public.

5. The Board notes in this context that, when Article 10b RRF was introduced in 1988, a notice of the President of the EPO dated 15 July 1988 was published in OJ EPO 1988, 354, stating, *inter alia*, that "[a]n applicant

unsure whether substantive examination has begun and wanting to withdraw the application only if he will receive the 75% refund may make withdrawal contingent upon the refund ('conditional' withdrawal)". The validity of such a conditional withdrawal has been explicitly recognised in the decision J 4/03 of 9 September 2004 (cf. points 6 and 7 of the reasons) on the grounds that the fulfilment of the condition can be easily ascertained by the EPO and does not depend on any decision to be made or discretion to be exercised by the EPO, or on any further action of the applicant. The Board agrees with this conclusion.

6. The appellant claims that the condition of the withdrawal was not met since the substantive examination had already begun. The appellant argues that the present application was originally filed as an international application for which the EPO acted both as International Searching Authority and as International Preliminary Examining Authority and that usually the examiner acting in the international phase becomes the First Examiner during the regional phase. However, under the PCT the international phase and the regional phase are clearly conceived as separate. In particular, as can be derived from Rule 107(f) EPC, a request for international preliminary examination filed under the PCT does not extend to the regional phase, but a request for examination has to be filed anew, in accordance with the provisions of the EPC. Thus, for the definition of the start of the substantive examination before the EPO as a regional patent granting authority, acts done by the EPO as an international authority under the PCT are not relevant. Furthermore, if the line of argument of the appellant

were correct, the scope of application of Article 10b RRF would be severely restricted, normally to the detriment of the Euro-PCT applicants who in numerous cases would not benefit any more from the possibility of refund in cases of withdrawal of the application during the regional phase before the EPO. Therefore, acts done by the EPO as International Preliminary Examining Authority under the PCT do not prevent a conditional withdrawal such as the present one from becoming effective.

7. As to the specific facts of the present case, there is no indication in the file that the substantive examination in the regional phase before the EPO had already started. When the competent Formalities Officer acknowledged the withdrawal of the application by communication of 19 December 2001, he stated that the proceedings were terminated and that the examination fee would be refunded at a rate of 75% pursuant to Article 10b(b) RRF. It can be inferred from these statements that the competent Formalities Officer was aware that no action had been taken by the Examining Division starting substantive examination. In the absence of any indication pointing to the contrary, it therefore has to be assumed that the Examining Division had indeed not taken any action which amounted to a start of the substantive examination. The condition made by the applicant for the withdrawal having been fulfilled, the withdrawal was valid when it was declared.

Correction ("retraction") of withdrawal

8. According to the established case law of the Legal Board of Appeal, a statement of withdrawal is binding on the applicant and can only be corrected under very particular circumstances. One of the preconditions for a correction is that, at the time when the request for correction is made, the public has not yet been officially notified of the withdrawal of the application (cf. J 10/87, OJ EPO 1989, 323, point 13 of the reasons, concerning the withdrawal of a designation of a Contracting State; J 4/97 of 9 July 1997, point 6 of the reasons; J 25/03, OJ EPO 2006, 395, point 3 of the reasons).

9. In the present case, the appellant had requested the correction of the withdrawal of the application on 27 December 2001. Although at that date the withdrawal had not yet been published in the European Patent Bulletin, it had already been entered in the Register of European Patents on 20 December 2001, i.e., several days before the request for correction was made. The crucial point in the case under consideration is therefore the question whether the entry in the Register of European Patents has the same official information value as the publication of those entries in the European Patent Bulletin or whether, as argued by the appellant, a clear legal distinction between both forms of publication is laid down in the EPC and has to be respected when deciding on the requested correction of the withdrawal of the application.

10. The above legal issue has already been considered in several recent decisions of this Board in different

compositions (cf. J 14/04 of 17 March 2005, J 25/03, OJ EPO 2006, 395, and J 12/03 of 26 September 2005). The last-mentioned decision (cf. point 7 of its reasons) summarises and comments upon the previous ones as follows:

"In J 14/04 it is stated, that all important information concerning European patent applications is registered first in the Register of European Patents, which thus takes precedence over the European Patent Bulletin, since the European Patent Bulletin contains the entries in the Register of European Patents (cf. point 7, forelast paragraph of the Reasons). In J 25/03 it is stated that 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) and further that 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 European Register of Patents at the time the 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).

These decisions make clear that data in the Register and in the Bulletin have to be the same, have same value as to their credibility and have

the same legal status as a source of official information. Both are means for the public to get the information needed to know the current status of an application or a patent. Therefore it is the position of the Board that the cited decisions have rightly decided that after publication of the withdrawal, be it in the European Bulletin or in the Register of European Patents, the interest of the public to being able to rely on the information conveyed by these means including file inspection, has to prevail over the individual interest of the applicant."

11. The appellant nevertheless is of the opinion that the entry of information in the Register of European Patents should not be regarded as an official notification of the content of the entry to the public. In particular the argument is made that members of the public would not rely on the accuracy of the information in the Register since the EPO does not accept liability for the completeness and accuracy of the data made available in connection with the Register via internet. The Board does not find this argument convincing. It may be true that, when noting an entry of withdrawal in the Register, a cautious third party would wish to confirm this information by consulting the file of the respective application itself. However, in the present case, a file inspection made before the letter of 27 December 2001 was added to the file would not have given the third party any reason to suspect that the withdrawal could be erroneous.

12. The appellant furthermore points to the fact that only a few days elapsed from the mention of the withdrawal

in the Register up to the request for "retraction" and argues that a proper balance between its interests and those of third parties demands that in such a situation the application should not be considered as irremediably lost. However, as already pointed out in the decision J 25/03 (point 11 of the reasons) with respect to a very similar factual situation, the official notification to the public of the withdrawal is a key step and legal certainty would suffer unacceptably if thereafter, even for only a short period of time, a correction of the withdrawal would be allowable in such circumstances as the present ones. The Board also notes the following passages in the decision J 4/03 of 9 September 2004, point 13 of the reasons: "Withdrawal of an application is the gravest procedural step that can be taken. (...) 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".

13. The Board concurs with the conclusions reached in the above-mentioned decisions. It therefore holds that the withdrawal of the application could not be corrected any more after its entry in the Register of European Patents. It follows that the appeal must be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

M. B. Günzel