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D E C I S I O N
of 17 March 2005

Case Number: J 0014/04 - 3.1.1

Application Number: 94119155.3

Publication Number: 0661836

IPC: H04B 7/26

Language of the proceedings: EN

Title of invention:

Device for automatic synchronisation of data bursts

Applicant:

Alcatel Standard Electrica, S.A.

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 67(4), 122(2), 122(6), 127, 129

EPC R. 88, 92, 94, 95

Keyword:

"Request for correction of a withdrawal of an application (not allowed)"

"Opposability of mentions recorded in the Register of European Patents Public interest"

Decisions cited:

J 0012/80, J 0015/86, J 0010/87, J 0006/91, J 0004/97

Catchword:

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Case Number: J 0014/04 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 17 March 2005

Appellant: Alcatel Standard Electrica, S.A.
Ramirez de Prado, 5/6
E-28045 Madrid (ES)

Representative: Privat VIGAND
16, Rue Henri Barbusse
F-91200 Athis-Mons (FR)

Decision under appeal: Decision of the Receiving section of the
European Patent Office posted 15 December 2003
refusing the request for correction of the
withdrawal of the European Patent application
No. 94119155.3 pursuant to Rule 88 EPC.

Composition of the Board:

Chairman: J.-C. Saisset
Members: E. Lachacinski
J. H. Van Moer

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal, received on 12 February 2004, against the decision of the Examining Division, dispatched on 15 December 2003, concerning the refusal to correct the withdrawal of application No. 94 119 155.3 filed on 5 December 1994, claiming a priority of 31 December 1993.

II. By a letter dated 30 July 2001, received at the European Patent Office on 6 August 2001, the application was unconditionally withdrawn.

By a letter dated 13 August 2001 (EPO Form 2077) the applicant was informed of the receipt of the declaration of withdrawal of the European patent application on 6 August 2001.

The examination fees were refunded on 18 December 2002.

III. On 7 January 2003, the applicant informed the European Patent Office that he had filed a request for correction of errors pursuant to Rule 88 EPC dated 12 September 2001. Although the receipt of this request had been confirmed to the applicant by letter (EPO Form 1037) dated 15 September 2001 there had been no response to this request.

IV. On 23 January 2003, the applicant sent a copy of both the letter dated 12 September 2001 and the acknowledgment of receipt stamped by the Office on 15 September 2001.

V. By a letter dated 12 September 2001 the applicant filed a statement to support the request to correct the earlier withdrawal of the application. He stated that the error in withdrawing the application was a simple human one due to an oversight. He also filed exhibits to show the nature of the error and that nothing else would have been intended than what was offered as the correction. The intention of the applicant had been to withdraw the designations of NL and SE only and not to withdraw all countries. He also added that if, necessary, the interests of third parties could be protected by a national court applying Article 122(6) EPC *mutatis mutandis*.

VI. In the decision under appeal, the Examining Division of the EPO stated that a valid withdrawal is binding on the applicant since the public interest requires certainty about the withdrawal (Legal advice No. 8/80, EPO 1981,6) and that, according to decision, J 10/87, OJ 1989, 323, three of the four specific requirements for the retraction of the withdrawal of an application under Rule 88 EPC were not fulfilled for the following reasons:

(i) The retraction of the withdrawal of the application was delayed as, when the request was originally received on 15 September 2001, the withdrawal of the application, which had been received on 6 August 2001, had already been published in the Register of European Patent on 10 August 2001.

(ii) The entry in the Register of the European Patents which took place on 10 August 2001 showed that

the mention of the withdrawal would be published in the European Patent Bulletin No. 01/39 of 26 September 2001.

- (iii) Decision J 4/97, not published (point 6 of the decision) allows a correction if the withdrawal is retracted before the entry in the Register of European Patent and does not affect the public interest.

VII. In its statement of grounds, the appellants argued essentially as follows:

- (i) The erroneous withdrawal of the application due to an excusable inadvertence has not been contested by the Examining Division.
- (ii) The request for retraction of the withdrawal of the application received on 15 September 2001 was sent in time and not tardily since between the moment when the error occurred and the moment when the applicant informed the EPO, only one and a half months had elapsed.

In decision J 10/87, the time which elapsed between the error occurring and the request for correction was practically twice the corresponding time in the present case.

Moreover, authorizing the correction does not of itself prevent the EPO from closing the proceedings within a reasonable period [(iv) last paragraph of point 14 of the above cited decision)], since the Examining Division had

already sent the notification under Rule 51(4) EPC which only needed to be agreed.

- (iii) According to decisions J 12/80, OJ 1981, 143 and 10/87, OJ 1989, 323 third parties can be sufficiently protected by national jurisdictions applying Article 122(6) EPC mutatis mutandis if the correction were accepted.
- (iv) Decisions J 15/86, OJ 1988, 417 and J 10/87 and J 04/97 hold that the most important condition to be fulfilled in order to accept the correction of the retraction of the withdrawal of an application is that the public has not been **officially** informed of the withdrawal announced in the **European Patent Bulletin**.

Decision J 10/87 in particular emphasizes that the correction must be allowed if the public has not yet been notified officially by the EPO of the withdrawal at the time the retraction of the withdrawal is applied for.

It is necessary for the withdrawal to have been published in the European patent Bulletin.

At the date of the publication on 26 September 2001 the European patent Bulletin should have shown that a request for correction of the withdrawal of the application had been made, if the request and the accompanying dossier had not been mislaid by the EPO.

These circumstances justify accepting the correction of an error since the EPO is, in part, responsible for the situation (J 12/80 and J 6/91, OJ 1994, 349 in particular point (6) i)).

- (v) Oral proceedings were requested should the Board of Appeal intend to refuse to revoke the decision under appeal.

VIII. On 19 October 2004 the Board of Appeal issued a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal.

IX. At the oral proceedings held on 17 February 2005 the appellant's representative requested that the decision under appeal be set aside, that the retraction of the withdrawal of the application be accepted and that the examination of the application be continued.

X. During the oral proceedings the appellant's representative added that, taking into account the jurisprudence and particularly decisions J 10/87 and J 4/97, at the time the request for cancellation of the withdrawal was received on 15 September 2001 the public had not officially been informed of the withdrawal of the patent application in the publication of the European Patent Bulletin.

He stated that the list of selected publications of the European Patent Office published each year in the Official Journal mentions only the following as sole **Official Publications**: the European Patent Convention, the Guidelines for examination in the EPO, the Official

Journal of the EPO, **the European Patent Bulletin**, the European patent applications and specifications.

He emphasized that the *epoline*[®] Register Plus contained under the rubric **Other publications of the EPO** does not constitute an official publication of the EPO.

- XI. After closing the debate and after deliberation the Board announced that the decision will be issued in writing on 17 March 2005.

Reasons for the Decision

1. The appeal is admissible.
2. The appellants do not contest that the letter dated 30 July 2001 contained a clear statement requesting withdrawal of their patent application.

The provisions of Article 67(4) EPC, which state that the European patent application shall be deemed never to have the effects set out in paragraphs 1 and 2 of Article 67 when it has been withdrawn, deemed to be withdrawn or finally refused, must be applied from 6 August 2001, the date of receipt of the aforementioned letter, until 15 September 2001, the date of the receipt of the request for correction.

Consequently, during that period the European patent application has to be considered as never having had a protective effect in favour of the applicant.

3. According to J 15/86 (Point 10) it is, in the public interest, too late to ask for retraction of a letter of withdrawal once withdrawal of the European patent application has been notified to the public in the European Patent Bulletin.

J 10/87 (Point 8) added that the public interest in being able to rely on information officially published by the European Patent Bulletin must rank higher than the interest of a patent applicant wanting an erroneous statement which has already been notified to the public to be ignored. Legal certainty must prevail.

4. In the present case, the paramount issue which must be considered concerns the legal effects of the two requests by the applicant dated 31 July 2001, received on 8 August 2001, and dated 12 September 2001, received on 15 September 2001, respectively with regard to the third parties in the light of the jurisprudence of the Boards of Appeal.
5. The appellants maintain that the public was not officially aware of the request for retraction of the withdrawal received at the EPO on 6 August 2001 since this information was only published in the European Patent Bulletin on 26th September 2001, without taking into consideration the request for correction of the withdrawal received on 15 September 2001, i.e. 11 days before the publication in the bulletin.

This interpretation appears nevertheless to be incorrect.

J 10/87 (Point 13) determines the conditions to be fulfilled for a correction of a request of withdrawal under Rule 88 EPC.

In the present case:

- (i) The condition that the erroneous withdrawal of the designation of a Contracting state is due to an excusable oversight is fulfilled since the Board is inclined to admit that the mention - drop all countries.... instead drop NL, SE.... - in the minutes dated 5 July 2001 is a clerical mistake and not the consequence of a change of mind.
- (ii) Contrary to the opinion of the department of first instance, the condition that there be no undue delay in seeking retraction is also fulfilled, since the period of one and a half months is not as long as the period foreseen in decision J 10/87, where a period of two and a half months did not constitute an undue delay.
- (iii) However, 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 is not fulfilled, considering the interpretation given by the Board to the term "officially notified".

- 6. Citing J 4/97, and in particular point 6, the appellant's representative alleges that in case like the present one, the only documents providing **official** information are those which appear on the list of

selected publications of the European Patent Office, in particular the European Patent Bulletin. The fact that the Register of European Patents is not quoted in this list indicates in its view that this Register is not intended to provide official information to the public.

7. The Board shares the view of decision J 10/87 (Point 8) stating in particular that the public interest lies in being able to rely on information officially published by the EPO.

However the crucial question to be answered is: how the words "official publication" have be interpreted in the context of the European Patent Convention?

Definitions given in the Shorter Oxford English Dictionary 5th edition Volume 2 are:

"Official": *"Of or pertaining to an office or position of trust, authority or service; of or pertaining to the duties or tenure of an office; formal, ceremonious"*.

"Officially": *"....with or according to official authority"*.

"Notify": *"Make known, publish, intimate, give notice of, announce"*.

Considering these definitions the official character of a document or of a publication can thus result on the one hand from a formal or structural standpoint, i.e. the organ or authority that publishes the information, or on the other hand from the objective nature of the published document.

Chapter II of the seventh party of the EPC sets out how the public is to be informed.

This is achieved by means of the Register of European Patents, public inspection, the European patent Bulletin and the Official Journal of the EPO (Article 127 to 129 EPC).

There are also exchanges of information between the EPO and the official instances (Central industrial property office of the Contracting States, organisations entrusted with the task of granting patents, judicial authorities,)

According to the European Patent Convention, the European Patent Bulletin and the Register of European Patents both constitute official publications.

The appellant's allegation based on the distinction in the list of the selected publications in the Official Journal consequently cannot be accepted.

According to Article 127 EPC the European Patent Office shall keep a register "which shall contain those particulars the registration of which is provided for by this Convention".....**"The Register shall be open to the public inspection"**.

Rule 92 EPC mentions the entries in the Register and, in particular, in paragraph (n), the date on which the European Patent application is refused, withdrawn or deemed to be withdrawn.

This provision means 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 Article 129(a) EPC indicates that the European Patent Bulletin contains "entries made in the Register of European Patents, as well as other particulars the publication of which is prescribed by this Convention".

Registers are books in which entries are made of details to be recorded for reference in order to inform the public (See for instance Trade register in United Kingdom, Handelsregister in Germany, Registre du commerce in France, etc.....).

8. Furthermore, according to Rule 95 EPC the EPO may, upon request, communicate information concerning any file on a European patent application or European patent. Consequently, third parties may consult the files under the conditions set out in Rule 94(1) EPC.

They may also access the Register of European Patents via the national data network or by dialling direct through the public telephone system (Free subscription on the one-line services of the European Patent Office (OJ 1995, 235) according to the Decision of the President of the European Patent Office dated 14 May 1998 (OJ 1998, 360) applied for the date on which the request was filed (12 September 2001) concerning phased implementation and use of the PHOENIX electronic file system for the creation, maintenance, preservation and inspection of files).

At the time of the request for withdrawal, access to the Register of European Patents was freely offered to the public via epline[®] on the Internet.

Consequently, any person can access the Register of European Patents through WebRegPro (**Web Register Program**) using software issued free of charge.

The public can download an unlimited number of cases to compare Online European Patent Register dates and identify changes immediately.

It would consequently be illogical to deny legal effect to the Register of European Patents while the tendency of the EPO is to provide greater speed, confidence, certainty and security for the public through an adequate electronic system.

Any person consulting the Register of European Patents is therefore immediately informed of the development of all status quo granting procedures.

In the present case the Register of European Patents had indicated that the request for withdrawal the patent application was recorded on 6 August 2001.

This request was therefore available to the public on that date.

It is of no relevance whether someone actually consulted this file on the aforementioned date. Only the fact that the information was easily available to the public has to be considered.

9. The Board does not follow with the view that, in the present case, Article 122(6) EPC could *mutatis mutandis* apply in cases of correction under Rule 88 EPC.

As stated in former decisions of this Board (see J 12/80 (Point 9), J 10/87 (Point 11 last paragraph and point 14 iv)), J 6/91 (Point 5.2) and J 4/97 (Point 7) the resolution of any issue relating to the rights of third parties must be left to the national court of competent jurisdiction.

The aim of the provisions of Article 122(6) EPC is to protect third party who, in good faith, has used or made effective and serious preparations for using an invention in the course of the period between the loss of rights and the publication of the mention of the re-establishment of those rights.

These provisions apply to cases where the applicant, in spite of all the due care required, was not in position to observe a time-limit and was re-established in his rights.

In order to grant protection, Article 122(2) lays down two imperative time-limits for filing a request for *Restitutio in integrum*.

After expiration of these time-limits these rights are definitively lost should the applicant not have taken any action.

Third parties are guaranteed that nothing prejudicial to them will arise.

In contrast, Rule 88 EPC does not stipulate time-limits for filing a request for the correction of an error.

Furthermore, it is not at all certain that national jurisdictions would apply the provisions of Article 122(6) EPC to Rule 88 EPC by analogy.

This would constitute a legal uncertainty concerning how these provisions could be applied by the national jurisdictions and would consequently be detrimental to third parties.

10. For these reasons, in accordance with the Notice of the European Patent Office dated 14 December 1992 concerning the withdrawal of the application to prevent publication (OJ 1993, 56), in practice, publication can often be stopped if the declaration of withdrawal was received by the Receiving Section at least four weeks before the date foreseen for publication.

Even if the Board agreed with the appellant's argument that the request for withdrawal of the application was not officially published in the European Patent Bulletin, the request for correction of the withdrawal would not have prevented the publication of the request for withdrawal in the said bulletin for the following reasons:

- the request for withdrawal of the application was published on 26 September 2001 in the European Patent Bulletin.
- this means that the publication of the request retracting the withdrawal should have been

received by the EPO four weeks before the date the publication of the request for withdrawal of the application was due to be published, i.e. before 29 August 2001.

11. Because the request for correction of the withdrawal of the application has to be rejected for the above reasons, the condition set out in Point 14 iv) of J 10/87 is of no relevance.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

P. Martorana

J.-C. Saisset