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**Datasheet for the decision
of 26 April 2007**

Case Number: J 0007/06 - 3.1.01

Application Number: 02750134.5

Publication Number: 1416919

IPC: A61K 9/20

Language of the proceedings: EN

Title of invention:

Dosage forms for immediate gastric release of a calcium transport stimulator coupled with delayed gastric release of a bis-phosphonate

Applicant:

TEVA PHARMACEUTICAL INDUSTRIES LTD.

Opponent:

-

Headword:

Withdrawal of application/TEVA

Relevant legal provisions:

EPC Art. 127, 129
EPC R. 71(2), 88, 92(1)(n)
RPBA Art. 11(3)

Keyword:

"Correction (retraction) of withdrawal of an application (no)"
"Entry of withdrawal in the Register of European Patents"
"Mention of withdrawal in the European Patent Bulletin"

Decisions cited:

J 0015/86, J 0010/87, J 0004/97, J 0012/03, J 0025/03,
J 0037/03, J 0038/03, J 0014/04

Catchword:

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Case Number: J 0007/06 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 26 April 2007

Appellant: TEVA PHARMACEUTICAL INDUSTRIES LTD.
(Applicant) 5 Basel Street
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49131 Petah Tiqva (IL)

Representative: Nachshen, Neil Jacob
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Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 15 December 2005.

Composition of the Board:

Chairman: B. Günzel
Members: E. DufRASne
B. Müller

Summary of Facts and Submissions

- I. The present appeal concerns the decision of the Receiving Section of 15 December 2005 which refused the request of the applicant for revocation of the withdrawal of the patent application 02750134.5 and held that the application was withdrawn with effect from 12 January 2005.
- II. The above application was originally filed as international patent application PCT/US2002/22825. The requirements for entry into the European regional phase were fulfilled on 13 February 2004. Examination under Article 94 EPC was requested.
- III. By letter dated 7 January 2005, received at the EPO on 12 January 2005, the applicant withdrew the above cited application and requested a refund of the search and examination fees.
- IV. The withdrawal of the application was entered in the Register of European Patents on 28 January 2005.
- V. By communication of 3 February 2005, the EPO acknowledged receipt of the declaration of withdrawal. It stated that the proceedings were terminated as from withdrawal of the application and that the examination fee, at a rate of 100%, as well as the search fee, would be refunded (pursuant to Article 10(3) and 10b(a) of the Rules Relating to Fees).
- VI. By communication of 8 February 2005, the EPO confirmed the refund of the search and examination fees.

- VII. On 16 March 2005, the mention of the withdrawal was published in the European Patent Bulletin (No. 2005/11).
- VIII. By letter of 8 April 2005, received on the same day, the applicant informed the EPO that the withdrawal had been made erroneously. It requested that the withdrawal be reversed under Rule 88 EPC and that prosecution proceed on repayment of the necessary fees.
- IX. By communication of 17 May 2005, the Receiving Section informed the applicant that it intended to reject its request.
- X. By a further letter of 15 July 2005, received on the same day, the applicant submitted to the EPO further facts and arguments in support of its request and repaid the examination fee.
- XI. By decision of 15 December 2005, the Receiving Section refused the request for revocation of withdrawal of the application and confirmed the withdrawal of the application with effect from 12 January 2005. In its decision, the Receiving Section stated that the request for correction was filed after the withdrawal of the application was entered in the Register of European Patents and published in the European Patent Bulletin. It held that the public interest in being able to rely on information officially published by the European Patent Office ranked higher than the interest of the applicant who wanted an erroneous statement which had already been notified to the public to be ignored, citing e.g. decisions J 10/87, J 4/97 and J 15/86.

XII. On 14 February 2006, the applicant lodged an appeal against the above decision and paid the appeal fee. A statement setting out the grounds of appeal was filed on 13 April 2006.

XIII. In its statement of grounds of appeal, the appellant referred back to its submissions at first instance, arguing essentially as follows:

- the application was irrevocably withdrawn due to an excusable oversight in the line of communication between the applicant and its US attorney, as supported by witnesses' statements;

- the request for retraction was made in good time once the European representative had become aware of the erroneous withdrawal;

- the withdrawal was retracted shortly after its official notification to the public in the European Patent Bulletin;

Other arguments were presented in view of the other requirements defined in J 4/97 to allow the retraction of the withdrawal of an application. These are not reproduced here, not being decisive in the present case.

The appellant requested that the decision under appeal be set aside in its entirety and that the withdrawal of its application be reversed.

- XIV. By communication of 25 January 2007, the Board summoned the appellant to oral proceedings and set out its preliminary opinion on the merits of the appeal.
- XV. By letter of 15 March 2007, the appellant informed the Board that it would not be represented at the oral proceedings.
- XVI. Oral proceedings were held on 26 April 2007.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.
2. As announced in its letter of 15 March 2007, the appellant was not represented at the oral proceedings. The appellant having been duly summoned, the Board decided to hold the oral proceedings in its absence, according to Rule 71(2) EPC and Article 11(3) of the Rules of Procedure of the Boards of Appeal.
3. According to the established case law of this Board, a statement of withdrawal is binding on the applicant and can only be corrected under Rule 88 EPC 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 (J 10/87 of 11 February 1988, OJ EPO 1989, 323, point 13 of the reasons, J 4/97 of 9 July 1997, point 6 of the reasons).

4. From several recent decisions of this Board (J 14/04 of 17 March 2005, J 25/03 of 27 April 2005, OJ EPO 2006, 395, J 12/03 of 26 September 2005, J 37/03 and 38/03 of 15 March 2006), it can be consistently concluded that an entry of a withdrawal of a patent application in the Register of European Patents under Article 127 and Rule 92(1)(n) EPC amounts to its official notification to the public as well as and even before its publication in the European Patent Bulletin (see in particular J 25/03, point 9 of the reasons, at the end) and further that such an entry prevents any subsequent retraction of the withdrawal 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 (*id.*, points 10 and 11).
5. These decisions make clear that the retraction of the withdrawal of a patent application is in general no more possible when applied for after notification of the withdrawal to the public through entry in the Register of European Patents.
6. In the present case, the applicant had requested the retraction of the withdrawal of the application on 8 April 2005, *i.e.* after the entry of the withdrawal in the Register of European Patents under Article 129 EPC on 28 January 2005. Moreover, in the present case, the request for retraction of the withdrawal had even been filed after the mention of the withdrawal in the European Patent Bulletin. This makes even clearer the official notification of the withdrawal to the public before the filing of the request for its retraction.

The argument raised by the appellant that the retraction was filed "shortly" after the mention of the withdrawal in the European Patent Bulletin is irrelevant since, on the first hand, legal certainty would suffer unacceptably if any further delay, even allegedly "short" were permitted for retraction (J 25/03, point 11 of the Reasons) and, on the other hand, since the first official notification was already achieved by the entry of the withdrawal into the Register of European Patents for more than 2 months at the time of the filing of the request for its retraction.

From this, the Board holds that the public had been officially notified of the withdrawal of the patent application, by its entry in the Register of European Patents and its mention in the European Patent Bulletin, before the filing of 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.

Furthermore, the Board sees no specific circumstances in the present case which would justify distinguishing it and departing from the established case law.

7. The Board therefore concurs with the conclusions reached in the above-mentioned decisions and holds that the withdrawal of the patent application could not be

corrected in the present case under Rule 88 EPC after its entry in the Register of European Patents.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel