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**Datasheet for the decision  
of 16 November 2009**

**Case Number:** J 0010/08 - 3.1.01

**Application Number:** 05744133.9

**Publication Number:** 1742530

**IPC:** A61K 33/38

**Language of the proceedings:** EN

**Title of invention:**

Antimicrobial coating for inhibition of bacterial adhesion and  
biofilm formation

**Applicant:**

Bacterin International, Inc.

**Opponent:**

-

**Headword:**

Retraction of withdrawal/BACTERIN

**Relevant legal provisions:**

EPC Art. 54(2), 54(3), 80, 97(1)  
EPC R. 139

**Relevant legal provisions (EPC 1973):**

RRF Art. 10b(b)  
EPC R. 88

**Keyword:**

"Retraction of withdrawal of a patent application"

**Decisions cited:**

J 0010/87, J 0004/97, J 0012/03, J 0025/03, J 0014/04,  
J 0007/06, J 0008/06, T 0123/82

**Catchword:**

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Case Number: J 0010/08 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 16 November 2009

**Appellant:** Bacterin International, Inc.  
600 Cruiser Lane  
Belgrade, MT 59718 (US)

**Representative:** Elsworth, Dominic Stephen  
Hargreaves Elsworth  
6 Charlotte Square  
Newcastle-upon-Tyne  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office posted 13 March 2008  
concerning European application No. 05744133.9.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** H. Preglau  
E. Dufrasne

## Summary of Facts and Submissions

- I. The appeal lies from the decision of the Receiving Section of 13 March 2008 which refused the request of the applicant for revocation of the withdrawal of the European patent application No. 05744133.9 and held that the application was withdrawn with effect from 6 August 2007.
- II. The above-mentioned application was originally filed as international patent application PCT/US 2005/015162 on 28 April 2005 and entered into the regional phase before the EPO on 24 October 2006. With letter dated 31 July 2007, received by the EPO on 6 August 2007, the application, European Patent Application no. 05744133.9, was withdrawn and remittal of any refunds to the deposit account was requested.
- III. On 10 August 2007 the withdrawal was encoded. Also on 10 August 2007 the EPO received a letter of the same date by fax from the representative of the applicant with the following content:
- "With reference to my letter dated 31st July 2007, if that letter has not been received at the European Patent Office, please ignore the request to withdraw the European Patent Application No. 05744133.9 as it was sent in error."*
- IV. By letter dated 3 October 2007 the representative of the applicant repeated that the request for withdrawal of the European patent application no. 05744133.9 was made erroneously and requested correction under Rule 88 EPC 1973. To justify this request, the representative pointed out that he had been instructed by the US

attorney of the applicant on 27 July 2007 to withdraw the application. He requested therefore the withdrawal, but was contacted by the US attorney on 9 August 2007, who informed him that the applicant might not have intended to abandon the application. He had not received any further communication by the Office but had found out by file inspection that the withdrawal had been published in the European Patent Bulletin on 12 September 2007.

The applicant's US attorney was involved with two separate applications for the same applicant and the instructions for these applications were inadvertently crossed. Therefore the e-mail of the US attorney to the European attorney to abandon the European patent application No 05744133.9 was sent as a result of a miscommunication between the client and the US attorney. Further evidence was available and would be filed in due course.

- V. By letter dated 9 October 2007 the Receiving Section informed the representative about the refund of the search fee according to Article 10b(b) RRF 1973.
- VI. With letter dated 19 October 2007 the representative acknowledged its receipt but repeated that the request for withdrawal of the application was made in error and the search fee should not be refunded.
- VII. On 30 October 2007 the Receiving Section issued a notification under Article 113 EPC, stating that the withdrawal was effective from 6 August 2007 because of the unambiguous wording of the respective letter received on that date. It appeared in the European

Patent Register in the early morning of 10 August 2007 after the weekly publication run during the night of 9 August 2007. The representative's letter dated 10 August 2007 was received by fax on 10 August 2007 at 12.37 hrs and therefore after the publication of the withdrawal. This letter was not available to the public until after the weekend on 13 August 2007 at 13.58 hrs, which was the first opening of the letter in the Table of Contents of the electronic file by the Formalities Officer. Only after the closing of that message would public file inspection have been possible. The formal request for correction of the error under Rule 88 EPC 1973 was received no earlier than 3 October 2007. Reference was made to decisions J 14/04, J 25/03, J 7/06 and J 8/06 and to the fact that the public had already been officially informed about the withdrawal and had no reason to suspect that it was erroneous. With regard to legal certainty and the balance to be made between the applicant's and third parties' interests it was not possible to apply Rule 88 EPC 1973. The applicant was invited to file comments or to request an appealable decision.

- VIII. With letter dated 21 December 2007 the representative of the applicant agreed that the Office correctly regarded the application as withdrawn following his letter dated 31 July 2007. However, his letter dated 10 August 2007 could only be understood as a request for correction of an error under Rule 88 EPC 1973. As an example of broad interpretation of Rule 88 EPC 1973 reference was made to decision J 12/03. It was further stated that the EPC and its Regulations only refer to dates of filing but not to specific times of filing, e.g. Article 80 EPC, Article 54 EPC.

Even if the letter dated 10 August 2007 was not seen as a request for correction of an error the letter dated 10 August 2007 would have been sufficient warning for third parties that the withdrawal might be erroneous and might be retracted later, as was formally done afterwards by letter dated 3 October 2007.

The letter was accompanied by several affidavits to show that the withdrawal had been declared in error.

An appealable decision was requested.

IX. By decision dated 13 March 2008 the request for revocation of the withdrawal of the application under Rule 139 EPC (former Rule 88 EPC 1973) was refused and the withdrawal with effect from 6 August 2007 confirmed. The refund of any fees paid afterwards was ordered.

X. The reasons for the decision can be summarised as follows:  
The Applicant is bound by his procedural declaration once received by the EPO (Legal Advice No 8/80, OJ EPO 1981,6). A correction under Rule 139 EPC is only possible as long as the public has not been officially notified of the withdrawal by the EPO. As the public had already been officially informed of the withdrawal by publication in the European Patent Register when the letter with the request to ignore the letter containing the withdrawal was received, a correction could not be allowed as in this case the interest of the public weighs higher than the interest of the applicant.

XI. An appeal was lodged against this decision on 22 May 2008, the appeal fee was received on the same day and the statement of grounds of appeal was filed on 15 July 2008.

The appellant first argued, that "there is no basis in the EPC or its Regulations for referring to specific times of filing, just to dates of filing".

Reference was made to Articles 80, 54(2), 54(3) and Rule 131 EPC 1973. Reference was also made to the Case Law of the Boards of Appeal, 5th ed., 2006, p.47, para 1.1.1. and 1.2. and to decisions T 123/82, J 25/03 and J 12/03.

XII. The appellant further argued, that the letter, which arrived at the Office on the day of the publication of the withdrawal would have been sufficient warning for the public in case of file inspection, that the withdrawal was in doubt and might be retracted later.

XIII. The appellant requested to set the decision of the Receiving Section aside and to reinstate the application. Oral proceedings were requested in case the Board would not allow the reinstatement of the application.

### **Reasons for the Decision**

1. The appellant admits that the Receiving Section was right to interpret the request for withdrawal of its application as unconditional and reacted correctly by entering this withdrawal in the European Patent

Register but is of the opinion, that this entry could be deleted, because the declaration was made in error.

2. The matter to be dealt with is the request of the appellant to retract this withdrawal under Rule 139 EPC because it was, according to the appellant, made erroneously. This Rule allows correction of errors in documents filed with the EPO, these errors being defined as linguistic errors, errors of transcription and mistakes.
3. In the case under consideration the document filed with the EPO did not show any kind of such an error. The error was not of a factual kind but of a mental one. Therefore it has to be examined, whether the correction of such an error can also be subsumed under Rule 139 EPC.
4. The Boards of Appeal have dealt with this question in a great number of decisions. One of those decisions on the question of a possible retraction of a procedural declaration is J 10/87 (OJ 1989, 323) with reference to earlier decisions. In this decision the Board developed the preconditions under which a correction of a procedural declaration may be allowed, namely that the public had not been officially notified of the withdrawal by the EPO, that the erroneous withdrawal was due to an excusable oversight, that the requested correction would not delay the proceedings substantially and that the interests of third parties who might have taken note of the withdrawal by inspection of the file were adequately protected.



Under point 8 of the reasons of that decision the Board already stated that the cited case law was sound, because the public interest must rank higher than the interest of a patent applicant wanting his erroneous statement already notified to the public to be ignored. In these cases, legal certainty had to prevail.

5. These considerations have been confirmed by several other decisions during the following years up to the present (e.g. J 4/97, J 12/03, J 25/03, J 14/04, J 7/06, J 8/06, all not published in OJ). From all these decisions it is clear that a withdrawal of a European patent application can only be retracted as long as the public has not been officially informed about the withdrawal.
6. The Board can accept that it was not the intention of the appellant in the present case to withdraw the application but that this was due to a misunderstanding between the various representatives of the appellant dealing with the case. There would also be no particular delay of the proceedings if such a correction would be allowed.
7. The Board now concentrates on the examination of the time aspect, that means the question of when the public was officially informed of the withdrawal and when the letter containing the request for retraction of the withdrawal reached the Office.
8. The particularity of the present case might be seen in the fact that the letter, containing the request for "ignoring" (i.e. implicitly retracting) the former letter containing the withdrawal of the European patent

application was considered by the Receiving Section as having arrived at the Office on the day of the official publication of the withdrawal.

9. With respect to the importance of the exact dates which are decisive for the allowability or non-allowability of the retraction the Board has requested an investigation concerning the entry of the withdrawal into the European Patent Register and its public availability.

The result can be summarised as follows:

The letter of withdrawal dated 31 July 2007 was received by the Office on 6 August 2007 (official stamp No 53, 06 Aug.2007). On 8 August 2007 this letter was dealt with by an EPO official and encoded on 10 August 2007 as "legal status". The procedure of encoding is not to be understood as synonymous with the valid public access to the corresponding data in the European Patent Register. There are two further steps necessary (adding the data to different internal databases) which generally takes 1 to 3 days. As in the present case the encoding took place on a Friday (10 August 2007), it cannot be established by the EPO that the information was made available to the public, i.e. that the public was officially notified of the withdrawal before Monday, 13 August 2007.

10. The letter dated 10 August 2007, containing the request for retraction of the withdrawal was received by the EPO by fax on the same day (Fax report: received at the EPO on Aug 10,2007, 12:37:11 page 1 and 2).

11. From the above it follows that the letter containing the request for retraction of the withdrawal was received before the date on which it can be established that the public was officially informed about the withdrawal.
  
12. In line with decision J 25/03 it has also to be considered if the public, even after file inspection would have had reason to suspect, that the withdrawal could be erroneous and later retracted or not. In the course of the investigations made it turned out that the content of the letter dated 10 August 2007 was also accessible via the European Patent Register Plus facilities by inspection of the file documents on 13 August 2007. Consequently the public would have had the information about the withdrawal and the request for its retraction at the same time and would therefore have been sufficiently warned that there possibly was something wrong with it.
  
13. Under these circumstances the Board is satisfied that the public would not have been misinformed or misled by the information published in the European Patent Register.
  
14. The Board therefore concludes that the withdrawal of the application may be retracted in the present case by correction under Rule 139 EPC.

**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The withdrawal of the European patent application No. 05744133.9 by the appellant's letter dated 31 July 2007 is declared to be without effect.
3. The case is remitted to the Receiving Section for further prosecution.

The Registrar:

The Chairman:

W.Roepstorff

B.Günzel