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**Datasheet for the decision  
of 2 December 2011**

**Case Number:** J 0018/10 - 3.1.01

**Application Number:** 05792677.6

**Publication Number:** 1929366

**IPC:** G03B 21/14

**Language of the proceedings:** EN

**Title of invention:**

Power on/off system of thin type projector and method for  
controlling the same

**Applicant:**

LG Electronics Inc.

**Headword:**

Retraction of withdrawal

**Relevant legal provisions:**

EPC R. 139

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

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**Keyword:**

"Retraction of withdrawal of an application (no)"  
"Public officially notified of the withdrawal (yes)"  
"Error form inspection of the complete file (no)"

**Decisions cited:**

J 0008/80, J 0010/87, J 0004/97, J 0004/03, J 0025/03,  
J 0001/11

**Catchword:**

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Case Number: J 0018/10 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 2 December 2011

**Appellant:** LG Electronics Inc.  
(Applicant) 20, Yoido-dong  
1 Youngdungpo-gu  
Seoul 150-721 (KR)

**Representative:** Neobard, William John  
Kilburn & Strode LLP  
20 Red Lion Street  
London WC1R 4PJ (GB)

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 22 February 2010.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** E. Dufrasne  
L. Bühler

## Summary of Facts and Submissions

- I. European patent application 05792677 was filed as an international application. It entered the European phase and was published under number 1929366.
- II. On 3 November 2008, a communication entitled "Proceeding further with the European patent application pursuant to Rule 70(2) EPC" (EPO Form 1224) was dispatched, inviting the applicant to indicate whether it desired to proceed further with the application.
- III. On 5 January 2009, by a letter referring to the above-mentioned communication, the applicant withdrew the application and requested the refund of the examination fee.
- IV. On 9 January 2009, the withdrawal appeared in the European Patent Register and on 11 February 2009 it was published in the European Patent Bulletin.
- V. On 15 January 2009, the Receiving Section confirmed to the applicant the withdrawal of the application and the refund of 100 % of the examination fee.
- VI. By letter dated 18 August 2009 and received on 20 August 2009, the applicant requested re-establishment of rights under Article 122 EPC on the ground that the withdrawal of the application had been unintentional. The request for re-establishment was abandoned by a letter dated 7 September 2009 and received on 11 September 2009.

VII. By another letter dated 7 September 2009 and received on 11 September 2009, the applicant requested correction under Rule 139 EPC of its earlier withdrawal of the application.

VIII. By its decision dated 22 February 2010, the Receiving Section refused the request for retraction of the withdrawal, stating that this request had arrived at the EPO after official notification to the public of the withdrawal by its mention in the Register, and referring to the absence of any reason for a third party to suspect, even after complete inspection of the file, that the withdrawal was erroneous. The Receiving Section cited inter alia decisions J 4/03 and J 25/03.

IX. On 1 April 2010, the applicant lodged an appeal against the decision of the Receiving Section. The appeal fee was paid on 7 April 2010 and the statement setting out the grounds of appeal was filed on 5 July 2010.

X. The arguments of the appellant may be summarised as follows:

It is not challenged that the public was officially notified of the withdrawal of the application by its mention in the European Patent Register and by its publication in the European Patent Bulletin before the introduction of the request for retraction of the withdrawal.

However, a third party inspecting the complete file of the application at the time of the official notification of the withdrawal to the public would have had a strong suspicion that the withdrawal was made in

error since the written opinion and the supplementary search report for the application were extremely favourable. A third party would have therefore expected that the application would proceed to examination with a probable grant of a patent. Further, the reference to the invitation from the EPO requesting it to confirm its intention to further proceed with its application, which the applicant made in the letter withdrawing the application would have surprised a person reading the file, in view of the very positive situation of the application and since there was no need for the applicant to express that it did not wish to continue with the examination of its application.

The appellant also referred to the further conditions for correction that the error must be due to an excusable oversight and that the request for correction must be immediate.

XI. In a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal annexed to the summons to oral proceedings, the Board expressed the preliminary opinion that, the withdrawal of the application having been officially notified to the public by its mention in the European Patent Register and in the European Patent Bulletin, and information to the contrary not having been available to the public at that time even after inspection of the complete file, the retraction of the withdrawal could not be allowed.

XII. Oral proceedings were held on 2 December 2011.

XIII. 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 is admissible.
2. Rule 139 EPC, relied on by the appellant, allows correction of errors under strictly defined conditions (see elements on the origins of the corresponding Rule 88 EPC 1973 in an early decision based thereon, J 8/80, OJ EPO 1980, 293, Facts and Submissions, points IX to XIV, and their strict application in the same decision, point 6 of the Reasons).

Decision J 10/87 (OJ EPO 1989, 323) applied that Rule 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 (not published in the OJ EPO) 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, based on the requirement of legal certainty and balancing the interests of the applicant against those of third parties (J 10/87, points 8 to 13 of the Reasons; J 4/97, point 4 of the Reasons).

Amongst the appropriate circumstances established by decisions J 10/87 and J 4/97 for allowing correction under Rule 88 EPC 1973 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 its established jurisprudence, this Board considers that the public has been officially notified of the withdrawal of an application by the publication of the withdrawal in the European Patent Bulletin or by the mention of the withdrawal in the European Patent Register (e.g. J 25/03, OJ EPO 2006, 395 and J 1/11 of 28 June 2011, not published in the OJ EPO).

However, the Board also normally considers that in order to prevent retraction of the withdrawal, the information available to third parties from the file has to be such that 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 (J 25/03, point 10 of the Reasons).

3. In the present case, the request for retraction of the withdrawal was filed on 11 September 2009, or on 20 August 2009 at the earliest if, for the sake of argument, it were to be considered that in substance the request for re-establishment already constituted a request for correction, re-establishment not being an available remedy. The earlier date would in any case also be long after the mention of the withdrawal in the European Patent Register and its publication in the

European Patent Bulletin, i.e. long after the official notification to the public of the withdrawal.

That is not disputed by the appellant.

4. However, the appellant argued that a third party inspecting the file after the withdrawal would have suspected that the withdrawal was made in error, in view of the positive elements present in the file and the normal expectation that the examination would terminate with the grant of a patent.

The Board cannot follow that line of argument. Even in a case of the application being in a very favourable position in examination proceedings, it remains possible and consistent that, for other reasons, the applicant decides not to proceed further with its application. It is also possible that the applicant is interested in having its application withdrawn immediately instead of having it simply deemed to be withdrawn later.

5. The appellant further argued that its reference to the invitation from the EPO requesting it to confirm its intention to further proceed with its application in the letter withdrawing the application would have surprised a person reading the file.

With regard to that argument, the Board notes that the withdrawal was explicit, unambiguous and unconditional. The Board sees no contradiction arising from the reference made to the invitation to confirm the intention to further proceed. It is not decisive whether a third party could possibly have been



surprised by that reference, since it does not indicate an error.

6. The Board is therefore of the opinion that, the withdrawal of the application having been officially notified to the public by its mention in the European Patent Register and its publication in the European Patent Bulletin, and information to the contrary not having been available to the public at that time, even after inspection of the complete file, the retraction of the withdrawal cannot be allowed.
  
7. Because the request for correction of the withdrawal of the application has to be rejected for the above reasons, it is not necessary to consider any other requirement for such a correction to be allowable or whether it would be fulfilled in the present case.

In particular, it is of no relevance for the present decision whether the error was due to an excusable oversight and whether the request for correction was immediate, as argued by the appellant.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairwoman:

E. Görgmaier

B. Günzel