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**Datasheet for the decision  
of 28 June 2011**

**Case Number:** J 0001/11 - 3.1.01

**Application Number:** 06801312.7

**Publication Number:** 1913069

**IPC:** C08K 5/12

**Language of the proceedings:** EN

**Title of invention:**  
POLYVINYL CHLORIDE COMPOSITIONS

**Applicant:**  
EASTMAN CHEMICAL COMPANY

**Opponent:**  
-

**Headword:**  
Retraction of withdrawal (not allowed)

**Relevant legal provisions:**  
EPC Art. 112(1)(a), 127, 129  
EPC R. 139, 143

**Relevant legal provisions (EPC 1973):**  
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**Keyword:**  
"Retraction of withdrawal (no)"  
"Publication in Register"  
"Publication in Bulletin"

**Decisions cited:**  
J 0010/87, J 0004/03, J 0025/03, J 0014/04

**Catchword:**  
-



Case Number: J 0001/11 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 28 June 2011

**Appellant:** EASTMAN CHEMICAL COMPANY  
(Applicant) 100 North Eastman Road  
Kingsport TN 37660 (US)

**Representative:** Rees, Kerry  
Cleveland  
40-43 Chancery Lane  
London WC2A 1JQ (GB)

**Decision under appeal:** Decision of the Examining Division of the  
European Patent Office of 24 August 2010.

**Composition of the Board:**

**Chairman:** E. Dufrasne  
**Members:** C. Heath  
D. Prietzel-Funk

## Summary of Facts and Submissions

I. European patent application 06801312.7 by Eastman Chemical Company was filed on 10 August 2006 as an international application. By letter dated 19 January 2009 received by fax on the same day, and confirmed by letter of 28 January 2009, the authorised European representative of the above application wrote the following:

"On behalf of the applicant I hereby formally withdraw the above application. Please refund the examination fee paid in relation to this application."

II. On 6 February 2009, the withdrawal of the application was recorded in the European Patent Register after a confirmation of the withdrawal was sent to the authorised European representative one day earlier. On 26 February 2009, that is, after the withdrawal was recorded in the European Patent Register, but before it was published in the European Patent *Bulletin*, a request for correction pursuant to Rule 139 EPC was filed. The request stated that the withdrawal was made in error and a correction should be made to the effect that the application was *not* withdrawn. On 11 March 2009, the European Patent Bulletin published the withdrawal of the application, and on 12 March 2009, the applicant was informed as to why the request for correction pursuant to Rule 139 EPC could not be allowed. The applicant subsequently requested an appealable decision against such refusal, and such a decision was rendered on 24 August 2010. The current appeal lies against this decision.

III. On 15 October 2010, the appeal at issue was filed, and the appeal fee was paid on the same day. With the grounds of appeal dated 30 December 2010, the appellant requests that the decision under appeal be set aside and the correction under Rule 139 EPC be allowed to the effect that the withdrawal of this application does not take effect. Oral proceedings were requested should the Board not be inclined to allow the request.

IV. The appellant essentially argued in writing that a request for retraction of a withdrawal of the application should be allowable until such withdrawal has been officially notified in the European Patent *Bulletin* according to Article 129 EPC rather than, as was held in the decision under appeal, the European Patent *Register* according to Article 127 and Rule 143 EPC. In requesting the Board to make this distinction between European Patent Register and European Patent Bulletin, the appellant took note that the Board in two previous decisions - **J 25/03** (of 27 April 2005, OJ 2006, 395) and **J 14/04** (of 17 March 2005, not published in OJ EPO) - in circumstances very similar to the present case came to the conclusion that a notification to the public has been effected once the withdrawal has been published in the European Patent *Register*. However, the appellant invited the Board to follow decisions **J 10/87** (of 11 February 1988, OJ 1989, 323) and **J 4/03** (of 9 September 2004, not published in OJ EPO) where official publication in the European Patent *Bulletin* according to Article 129 EPC was considered as the relevant notification to the general public. Should the Board not be minded to follow the reasoning of these latter two decisions, the appellant requested the Board to make a referral to the Enlarged Board of Appeal

according to Article 112(1) (a) EPC due to an inconsistency in previous case law, and phrased the question as follows: "Is retraction by correction of a withdrawal of a patent application no longer possible if the withdrawal has already been recorded for inspection in the Register (per J 25/03 and J 14/04) or should publication of the withdrawal to the general public in the Bulletin (per J 10/87 and J 04/03) be decisive?"

V. With the Summons to oral proceedings, the Board issued a communication indicating that it would be inclined to follow decisions **J 25/03** and **J 14/04**, that decision **J 04/03** could not be conflicting with the above two decisions, as retraction of the withdrawal had reached the Office only after publication in the Bulletin, and that decision **J 10/87** when considering the basic question of the official notification of the withdrawal to the public, relied on the fact that "file inspection" at the time the decision was rendered could not be equalled to "publication", whereas today's technological environment no longer justified such distinction.

VI. Oral proceedings were held on 28 June 2011 during which the appellant in addition to its previous submissions, argued that even if technology now allowed equal access to the Register and the Bulletin, and information in the Bulletin was extracted from information that had previously been entered into the Register, only an entry in the Bulletin carried with it the legal fiction that the public was "deemed to have been informed". While the Register made information "obtainable", this could not be equalled to the Bulletin that rendered the

information "published". If a withdrawal was indeed "cast in stone" by its mere notification in the Register, why should such withdrawal subsequently be published again in the Bulletin? The appellant therefore requested that the decision under appeal be set aside and that the retraction of the withdrawal be allowed, or, in the auxiliary, that the above question be referred to the Enlarged Board of Appeal.

### **Reasons for the decision**

1. The appeal is admissible.
2. Explicitly withdrawing a pending patent application is a declaration of highest importance for the applicant, since all legal effects of the application such as establishing a preliminary right, are finally abandoned. In light of these consequences, utmost caution is therefore required when declaring the withdrawal of an application.
3. A correction of errors in documents filed with the European Patent Office under Rule 139 EPC is only possible under strictly defined conditions. In the case at issue, the request for retraction of the withdrawal reached the European Patent Office more than a month after the withdrawal was made and after it was recorded in the European Patent Register. Yet it is not primarily the European Patent Office that is concerned with a withdrawal, but the public, for which a withdrawal is of potential interest. It is thus the public that can be regarded as the ultimate addressee of such a withdrawal. Therefore, a withdrawal cannot be

retracted once the public has been officially informed thereof. In a broader sense, this is also reflected in the principle that a declaration of intent can only be retracted if the retraction reaches the addressee either before said declaration or at the same time, a rule that can be found in the civil law systems of many Contracting States of the EPC.

It is not disputed by the appellant that retraction of the withdrawal is no longer possible once the withdrawal has been published in the European Patent Bulletin. The question is thus whether a publication of the withdrawal in the European Patent Register should have the same legal consequences. In the present case, retraction of the withdrawal reached the European Patent Office almost one month after the withdrawal was notified in the European Patent Register, while it had not yet been published in the European Patent Bulletin.

4. Starting point for the Board's analysis is decision **J 10/87**. The headnote of this decision (and also point 13 of the reasons) reads as follows:

"A request for retraction of a withdrawal of the designation of a Contracting State filed after publication of the patent application may be allowable under Rule 88 EPC [1973] in appropriate circumstances, in particular if

(a) the public has not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal is applied for;

... "

In other words, retraction of a withdrawal, be it of a designation of a Contracting State, or, as in the current case, the application as a whole, is basically considered possible until the public has been officially notified of the withdrawal.

5. In applying the criteria in decision **J 10/87**, the examining division had allowed a request for retraction of a withdrawal in considering that the withdrawal had not been officially notified to the public. While the withdrawal had already been entered into the Register, it had not yet been published in the Bulletin. The withdrawal could be noticed by the public via a public file inspection. The Board in that case took the view that the possibility of a public file inspection could not be equalled to an official publication, and paragraph 10 of the reasons reads as follows:

*"10. After due consideration, weighing the interests of the public against those of the applicant, the Board is of the opinion that a withdrawal which could only be noticed by inspection of the file can justifiably be treated differently from a withdrawal which was officially published. Legal certainty for third parties is of greater importance after official publication of a withdrawal by the European Patent Office than after a withdrawal which can only be discovered by inspection of the file."*

6. While the Board takes note of the distinction of public file inspection and publication in the European Patent Bulletin made in the decision **J 10/87**, it is of the opinion that internet technology as implemented by the



European Patent Office has made this distinction no longer relevant for determining the basic condition of the official notification of the withdrawal to the public. The European Patent Register nowadays allows for a file inspection online no different than the European Bulletin allows for an online access of its contents. Since 1 January 2005, the Bulletin has been issued in electronic form only, and paper copies are no longer available. The previous distinction between "inspection" that required either a personal visit to the European Patent Office or a specific oral or written request regarding a particular application, and a "publication" effected by sending out the European Patent Bulletin to the world at large seems no longer justified or justifiable. The progress of technology for the question of inspection of the Register and publication of the Bulletin was dealt with in detail in the decision **J 25/03** that relates to facts very similar to the present case, and that goes into considerable detail as to the technical possibilities of access both for the Register and the Bulletin.

7. In decision **J 25/03**, an application was unconditionally withdrawn, and such withdrawal was published in the Register of European Patents before the applicant requested correction under Rule 88 EPC 1973 (now Rule 139 EPC) of its earlier withdrawal of the application. At that point in time, no publication of such withdrawal had taken place in the European Patent Bulletin. The question was thus whether mention in the Register of European Patents according to Article 127 and Rule 143 EPC counted as an official information to the public. The Board in the above-mentioned case answered this question in the affirmative, and in its

reasoning went into considerable detail. Paragraphs 8 to 10 of the decision in this respect read as follows:

*"8. Decision J 14/04 refers to the European Patent Convention, which in Chapter II of Part VII sets out the "Information to the public or official authorities".*

*According to Article 127 EPC [1973], the European Patent Office shall keep a register, to be known as the Register of European Patents, which shall contain those particulars the registration of which is provided for by this Convention.*

*Rule 92 EPC [1973] further lists the entries in the Register, which includes, in paragraph (n), the date on which the European patent application is refused, withdrawn or deemed to be withdrawn.*

*These references to the text of the European Patent Convention clearly support the official character of the entries in the Register of European Patents, in particular the mention of the withdrawal of a patent application.*

*Moreover, Article 129(a) EPC [1973] states that the European Patent Bulletin contains entries made in the Register of European Patents.*

*This indicates clearly that the contents of the European Patent Bulletin relies on entries in the Register of European Patents. It corroborates the official character of the entries in the Register of European Patents and, to a certain extent, even its precedence over the European Patent Bulletin.*

*So, contrary to what is alleged by the Appellant, legal effects are associated not only with the publication in the European Patent Bulletin, but also with entries in the Register of European Patents. As an example, unless*

*the conditions of Rule 20(3) EPC [1973] are met, it is the person registered as applicant, i.e. the person whose name is entered into the Register of European Patents, who is the party to the proceedings and who is deemed to be entitled to exercise the right to the European patent, in accordance with Article 60(3) EPC [1973] (J 26/95, OJ EPO 1999, 668, point 2 of the Reasons), irrespective of whether or not the right to a European patent belongs to him as a matter of substance (see Article 60(1) EPC).*

*9. As to the public character of the content of the Register of European Patents, Article 127 EPC [1973] mentions that it is open to public inspection. As regards the European Patent Bulletin, Article 129(a) EPC [1973] explicitly refers to it as being a publication.*

*No conclusive difference can however be derived simply from this minor and strictly literal difference. In a broader approach, the public dimensions of the European Patent Bulletin and of the Register of European Patents have to be considered in the framework of how these official sources of information have actually been made available by the European Patent Office to the public since the time the withdrawal of the patent application had been mentioned in the Register of European Patents. Both the European Patent Bulletin and the Register of European Patents are similarly offered freely to the public via EPOLINE<sup>®</sup>, on the internet. Not only is it possible for any person to access the Register of European Patents on-line but also a service is offered which allows tracking changes in all files of published applications, using tailor-made lists of patent applications. Combined with an*

*additional software tool, it renders it possible to compare data and identify changes immediately, or even automatically to receive an e-mail alert every time a change occurs in any of the cases previously selected in the Register of European Patents (at that time through WebRegPro. See WebRegPro: monitoring patent applications using the epoline<sup>®</sup> online European Patent Register, EPIDOS News 4/2002, December 2002, also published on the European Patent Office internet site, in the News, on 20 December 2002).*

*These factual elements surrounding the official character of the information available support the general availability to the public of the entries in the Register of European Patents, from the day they appear therein.*

*Consequently, an entry in the Register of European Patents also amounts to a notification to the public as well as a publication in the European Patent Bulletin.*

*10. For these reasons, the Board holds that the public has been officially notified of the withdrawal of the patent application by its mention in the Register of European Patents on 11 January 2003, before 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.*

*The Board considers that legal certainty and the balance to be made of the applicant's and of third parties' interests do not allow the application of Rule 88 EPC [1973] in the present circumstances to authorise the retraction of the withdrawal of the patent application."*

8. In adopting the above considerations, the Board takes the view that decision **J 10/87** was necessarily fact-specific in that in its analysis of what made the withdrawal officially notified to the public, it relied on certain, then existing technical features of the file inspection system that allowed for a distinction between *inspection* and *publication*. Subsequent development of technology no longer allows for such distinction, as had been set out in great detail in the decision **J 25/03**.
  
9. Still, the Board acknowledges that the appellant advanced a second line of argument that has not been explicitly dealt with in previous decisions, namely, that despite the technical and functional approximation of Register and Bulletin, only the latter carries the presumption of an official publication. In other words, as much as the public may be able to obtain information from the Register technically and functionally equivalent, but earlier as from the Bulletin, the public is deemed to have been officially informed only by information that is contained in the Bulletin, and only information in the latter is "cast in stone" and can be relied upon by the public as legally certain.
  
10. As a starting point, it should be said that both the European Patent Register according to Article 127 EPC and the European Patent Bulletin according to Article 129(a) EPC are official sources of information to the public. There is nothing that would allow a distinction as to which of the two is more official, reliable or decisive. Both are listed in the EPC under the same chapter II that is entitled "Information to

the public or to official authorities". The function of the Register as information to the public is confirmed by the heading of chapter IX of the EPC Rules "Information to the public" that in Rule 143 in particular deals with the Register.

11. This is not to say that the Bulletin has no functions other than those of information. On the contrary. For example, only a publication in the Bulletin gives effect to the decision to grant a patent (Article 97(3) EPC), and only the publication of the mention of the grant of the European patent in the Bulletin triggers the nine-month period for a notice of opposition, Article 99(1) EPC. Furthermore, only the Bulletin carries a specific publication date. It is, in fact, published on a weekly basis. Contrary to what the appellant alleges, entries into the Bulletin are no more "cast in stone" than those of the Register, and can be corrected either under Rule 140 EPC, or by way of a decision.
12. Yet, as far as the function of information to the public is concerned, the Board is unable to deduce a fundamental difference between Register and Bulletin.
13. For its request to refer the case to the Enlarged Board of Appeal, the appellant relies on decisions **J 10/87** and **J 04/03** that allegedly conflict with decisions **J 25/03** and **J 14/04**. As regards decision **J 04/03**, the Board is unable to see any conflict with decisions **J 25/03** and **J 14/04** already for the fact that in the specific circumstances of **J 04/03**, a request for correction of an allegedly erroneous withdrawal was made only *after* publication had been effected in the

European Patent Bulletin. For that reason, the question as to whether an entry in the European Patent Register could qualify as a relevant notification to the public did not arise in that case. As regards decision **J 10/87**, it has been explained above why this case should be followed as to the condition of the absence of official notification of the withdrawal to the public, but distinguished from subsequent cases as to the actual application of that condition due to the limited technical possibilities of file inspection back in the 1980ies, as has already been decided in **J 25/03** and **J 14/04**. Therefore, the Board in the present case sees no need to refer a question to the Enlarged Board of Appeal under Article 112(1) EPC.

14. The Board thus takes the view, that, first, there is no reason to deviate from decisions **J 25/03** and **J 14/04**, that, second, advanced technology has made the distinction of "inspection" and "notification" relied upon in case **J 10/87** no longer applicable, that, third, there is no justification for distinguishing official information to the public by way of the Register or the Bulletin, and that, fourth, the decision **J 04/03** does not address the case of a request for correction after entry of a withdrawal in the Patent Register, but before publication in the European Patent Bulletin.
15. In conclusion of the above analysis, the appellant's requests for retraction of the withdrawal of its application as a correction of an error under Rule 139 EPC must be refused.

**Order**

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

The appeal is dismissed.

Registrar

Chairman

C. Eickhoff

E. Dufrasne