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**Datasheet for the decision
of 20 July 2015**

Case Number: J 0002/15 - 3.1.01

Application Number: 04751794.1

Publication Number: 1627054

IPC: C12N5/06, A61K35/14

Language of the proceedings: EN

Title of invention:

ALLOGENEIC CELL THERAPY: MIRROR EFFECT

Applicant:

Immunovative Therapies, Ltd.

Headword:

Retraction of withdrawal (no)

Relevant legal provisions:

EPC R. 139

Keyword:

Correction of error - (no)

Decisions cited:

J 0010/87, J 0011/87, J 0027/94, J 0004/97, J 0004/03,
J 0012/03, J 0019/03, J 0025/03, J 0014/04, J 0001/11,
J 0006/13

Headnote:

The withdrawal of an application cannot be retracted once it has been published in the European Patent Register.



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: J 0002/15 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 20 July 2015

Appellant: Immunovative Therapies, Ltd.
(Applicant) Misgav Technology Centre, M.P.
20179 Misgav (IL)

Representative: Carter, Caroline Mercedes
Fry Heath & Spence LLP
The Gables
Massetts Road
GB-Horley, Surrey RH6 7DQ (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office dated 28 August 2014**

Composition of the Board:

Chairwoman C. Vallet
Members: C. Heath
O. Loizou

Summary of Facts and Submissions

- I. This case concerns the retraction of a withdrawal of European patent application no. 04751794.1 with the title ALLOGENEIC CELL THERAPY: MIRROR EFFECT that was derived from the PCT application WO2004US14589 filed on 11 May 2004 in the name of Immunovative Therapies, Ltd. The application on 28 November 2005 entered into the European phase, and was given the internal reference number P51557D EP by the European representative.
- II. On 21 February 2006, the applicant's European representative, Mr. Downing, wrote a facsimile letter to the European Patent Office requesting an unconditional withdrawal of the application. The facsimile mentioned the European application number (04751794.1), the applicant (Immunovative Therapies, Inc.), and provided the reference number "P51557D EP". The text was very short: "We hereby withdraw the application on behalf of the applicant. We request a refund of any fees possible, in particular the examination fee."
- III. The facsimile was published in the European Patent Register on 24 February 2006. The Register indicated the date of withdrawal (21 February), and the expected publication date in the European Patent Bulletin (12 April 2006). Also available for public file inspection was EPO form 2058 on the "Closure of the procedure" dated 22 February 2006 that mentioned the following:

"WDRA 21. 02. 06 - The application has been withdrawn.
PLEASE REVIEW REFUND OF EXAMINATION FEE (75%)."
- IV. An acknowledgement of the withdrawal was sent to the applicant on 27 February 2006, and a refund of the fees

was ordered on 8 March 2006 with the issuance of the corresponding EPO Form 2907.

- V. On 6 March 2006, the representative discovered that the wrong application had been withdrawn and requested a correction by facsimile letter that was received by the EPO on the same day. Reason for this request for correction under Rule 88 EPC 1973 (now Rule 139 EPC) was that the withdrawal had been made in error. A further facsimile received on the same day further elaborated how this error had occurred, and that it had never been the applicant's intention to withdraw the application. It was requested to cancel any preparations for a publication of the withdrawal in the European Patent Bulletin.
- VI. In a letter dated 24 October 2006, the Office indicated that the circumstances did not permit a correction, and pointed to decisions **J 14/04** and **J 25/03**. Despite frequent reminders from the representative, it took the division an inexplicable eight years to issue a formal decision on 28 August 2014 that refused the applicant's request for a correction.
- VII. Against this decision, the applicant filed this appeal on 2 October 2014, paid the corresponding appeal fee on the same day, and on 23 December 2014 submitted the grounds of appeal. Subsequently, the applicant was summoned to oral proceedings scheduled for 20 July 2015. In the Annex to the Summons, the Board indicated its provisional opinion that it would be minded to dismiss the appeal. Thereupon, the applicant in a letter dated 19 June 2015 provided further arguments why the appeal should be allowed.

VIII. On 13 July, Ms. Carter on behalf of the applicant wrote a facsimile letter informing the Board that she would not be attending oral proceedings and that the proceedings should be continued in writing. Oral proceedings were cancelled on 15 July.

IX. The applicant's factual arguments can be summarised as follows:

It had never been the intention of the applicant to withdraw the application, and indeed the applicant's instruction for withdrawal referred to a different application that, however, due to a mistaken e-mail address, had not reached the European representative. Only due to this error had the latter withdrawn the current application as the only pending application by this applicant.

X. The applicant's legal arguments essentially concern two different points.

First, that at the time the retraction of the withdrawal was communicated to the Office, no mention of the withdrawal had been made in the European Patent Bulletin. In accordance with decisions **J 10/87** and **J 4/97**, the withdrawal had thus not been properly communicated to the public, and a withdrawal was still possible. The subsequent decisions **J 25/03** and **J 1/11** that held the opposite should either be reconsidered (as they were fundamentally flawed), or the case be referred to the Enlarged Board of Appeal due to inconsistent case law.

Second, that in applying the principles laid down in the decision **J 12/03**, there were circumstances of the case that upon a file inspection would give a third party every reason to suspect that the withdrawal was

erroneous, or not yet effective. The applicant in this respect mentioned a wrong reference number, the fact that the European Patent Register envisaged a publication date of the withdrawal in the European Bulletin as of 12 April, and that not all procedural steps for the withdrawal had been completed when the retraction was requested. In other words, a notional third party upon inspecting the Patent Register would understand that the withdrawal was deferred (until 12 April) and conditional (upon a refund of the relevant fees). The retraction of the withdrawal had been received by the Office before 12 April 2006 and before the fee refund had been carried out, and should thus be allowed.

- XI. The applicant thus requests that the decision under appeal be set aside and that the correction/retraction of the withdrawal of the application submitted on 21 February 2006 be allowed. In the auxiliary, the case should be referred to the Enlarged Board of Appeal due to the above-mentioned inconsistency in case law.

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 is subject to Rule 139 EPC that reads:

"Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction."

Correction under Rule 139, first sentence EPC, if allowed, has a retroactive effect with the consequence that the document containing the error has to be regarded as if it was filed in the corrected form. While one can indeed question whether a difference between what has been intended and what has actually been communicated can qualify as a "mistake in a document", case law has based the retraction of a withdrawal on this provision (e.g. decision **J 1/11** (of 28 June 2011), point 3 of the reasons), yet under rather stringent conditions as set out in, first, decision **J 19/03** (of 11 March 2005), point 5 of the reasons:

"[T]he jurisprudence of the Boards of Appeal took as a starting point that, as a general rule, an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. **J 11/87**, OJ EPO 1988, 367, points 3.3 and 3.6 of the reasons; **J 27/94**, OJ EPO 1995, 831, point 8 of the reasons) and is not allowed

to reverse these acts so that they can be considered as never filed (**J 10/87**, OJ 1989, 323, point 12 of the reasons; **J 4/97** of 9 July 1997, point 2 of the reasons)."

The reason for such a restrictive approach is further set out in decision **J 1/11**, point 3 of the reasons:

"[I]t 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."

4. The first argument advanced by the applicant turns on the question whether the public has been officially informed. In this respect, the applicant relies on the decision **J 10/87** that made a distinction between a publication in the European Patent Register and a publication in the European Patent Bulletin:

"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."

5. This issue was further discussed in **J 1/11**:

"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** [of 27 April 2005, OJ 2006, 395] 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..."

Decision **J 1/11** therefore came to the following conclusion:

"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."

6. The applicant in the case at issue has pointed to a "fundamental inconsistency" between the decisions in case **J 10/87** and **J 4/97** on the one hand, and **J 25/03** and **J 1/11** on the other. The Board acknowledges that the reasoning of the more recent decisions led a change in the case law due to the evolution of technical means. This cannot be seen as an inconsistency in the case law where cases on the same subject matter arrive at different results and have a different reasoning whilst being decided at the same time. The Board is further of the opinion that this inconsistency has been comprehensively addressed in the above-cited passage of the decision **J 1/11**, and the Board sees no need to elaborate this further. The Board also notes that the decision **J 1/11** dealt with the question as to whether the case should be referred to the Enlarged Board of Appeal, and declined such referral on the following grounds:

"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** [of 9 September 2004] that allegedly conflict with decisions **J 25/03** and **J 14/04** [of 17 March 2005]. 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."

The Board fully shares this reasoning, and therefore the respective request of the applicant is to be refused.

The applicant in this case further relies on the decision **J 4/97**. However, the facts of this decision differ from the present case in that the retraction of the withdrawal reached the EPO prior to any entry into the European Patent Register and thus had not been made public in the first place.

The applicant's additional arguments for a referral are the fact that the decisions giving equal weight to the publication in the European Patent Register "have been taken by the sole Legal Board of Appeal", often by the same judges, and that there was no "opportunity for a fully independent review of the reasoning developed by Legal Board of Appeal".

Under Art. 112 EPC a referral can only be made "in order to ensure uniform application of the law, or if a point of law of fundamental importance arises." Neither of these two conditions apply to the case at issue.

7. The Board thus takes the view that in line with previous case law, the publication of a withdrawal in the European Patent Register amounts to an official publication thereof, and that a retraction of the withdrawal could thus have been effected only prior to a publication in the Register.
8. With the second line of argument, the applicant alleges that the withdrawal was ambiguous, deferred or conditional, and therefore the retraction as communicated on 6 March 2006 should have been allowed. The Board in this connection examines whether any of the above was objectively so, or, if not, whether it could have been so understood.
9. According to the applicant, the withdrawal was ambiguous. While the European representatives allocated the internal reference "P51557D EP" to this file, both in the letter of 28 November 2005 and in the letter of withdrawal, the EPO has consistently identified the internal reference as "P51657D EP". In other words, the EPO got the representative's internal reference wrong.

The letter of withdrawal certainly contained the reference the representative had previously allocated to this file, and a previous mistake by the EPO in regard of the representative's internal reference created no ambiguities. After all, an internal reference number allocated by the representative to a specific case may help the representative to identify the file, but will otherwise be meaningless for third parties or the Office. Neither would they have identified the application on the basis of a representative's internal reference number.

10. The applicant further argues that when the retraction was communicated, the Office had not yet completed all acts necessary for carrying out the withdrawal, as the fees had not yet been reimbursed. As the withdrawal was made conditional upon the reimbursement of the fees, a retraction could still be validly made. The Board notes in this respect that a reimbursement of outstanding fees is a consequence of the withdrawal, not a condition. Only the withdrawal creates a legal basis for the reimbursement of outstanding fees. The applicant's arguments in this respect therefore fail to convince the Board.

11. The applicant has further argued that the date of withdrawal should be the date of publication in the European Patent Bulletin. The Register merely contained the information that the withdrawal would become effective at a later date, namely 12 April 2006. According to Rule 143 (n) EPC, the European Register shall contain the following information: "date on which the application is refused, withdrawn or deemed withdrawn". The copy of the register as of 3 March 2006 as furnished by the appellant indicates the following information:

"Withdrawal of application - Date of publication
12-04-2006 (2006/15).

.....

Application withdrawn or deemed withdrawn

Withdrawal of application 21-02-2006 [2006/15]"

Objectively, this information means that the application was withdrawn on 21 February 2006, and that such withdrawal would be published in the Patent Bulletin of 12 April 2006. There is no information that points to an effective date of the withdrawal only on 12 April 2006, and decision **J 1/11** has clearly spelt out that a publication in the European Patent Register has the same legal effect as a publication in the European Patent Bulletin, unless otherwise specified. Furthermore, EPO Form 2058 regarding the closure of procedure issued on the day after the withdrawal, that is, 22 February 2006, also specified the date of withdrawal as 21 February 2006. So did Form 2077 dated 27 February 2006 sent to the representative.

- 12. The Board thus considers that the withdrawal was neither ambiguous, nor conditional, nor deferred.
- 13. The applicant, however, argues that the withdrawal, or the information imparted by the Office, could have been so understood by a third party, and in this respect relies on decision **J 12/03** (of 26 September 2005), point 7 of the reasons, setting out

"that a request for retraction of a letter of withdrawal of a patent application is no longer possible if the withdrawal has been mentioned in the European Register of Patents at the time the retraction is applied for 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." Decision **J 06/13** (of 23 July 2013, point 4 of the reasons) takes "any reason" to mean that "in the interest of legal certainty for third parties, and taking into account the public function of the register, a third party upon file inspection must have had good reason to suspect that the withdrawal was made in error in order to allow a retraction thereof."

14. Regarding the internal reference number, as has been pointed out above, first, the reference number in the withdrawal was exactly the one whereby the representative had identified this application, and, second, neither the Office, nor a third party would identify a patent application based on such internal reference number. Consequently, no ambiguity was created in this respect that could have given third parties or the Office good reason to suspect that the withdrawal was made in error.

15. As to the possibility of understanding the withdrawal as conditional upon the reimbursement of fees, the Board takes the view that a third party would not have understood the sentence "We request a refund of any fees possible, in particular the examination fee" as a condition for the withdrawal, first, because this is legally impossible (see above), and second, because the wording does not suggest so. The sentence even leaves open the possibility of a withdrawal without a reimbursement of fees (in case this was not "possible"). Rather, the wording indicates a sequential order: The application is withdrawn, and based on such withdrawal, a reimbursement is requested.

16. The last point advanced by the appellant is that the information as presented in the Register could give rise to the notion that the withdrawal was intended to take effect only on 12 April 2006. Any third party before relying on the withdrawal would thus wait until such date. The Board disagrees. An informed user of the Register would be aware of the distinction between the date of withdrawal, and the information of when such withdrawal would be published in the European Patent Bulletin. Exactly because the Register carries the same legal weight as the Bulletin, and this has been confirmed by various decisions (see above), an informed user would see no need to wait for the publication of the withdrawal in the European Patent Bulletin before relying on the information about the withdrawal. This is the more so as EPO Form 2058, issued on 22 February 2006, clearly indicated "The application has been withdrawn."
17. Summarising, the Board affirms previous case law that the mention of a withdrawal in the European Patent Register is tantamount to an official information of such act to the public, and for the case at issue holds that such withdrawal was unambiguous, unconditional and became effective as of the date of receipt by the Office. A withdrawal after publication in the European Patent Register was thus no longer possible, and the examining division was therefore correct in rejecting the request for a retraction of the withdrawal made after such publication of the withdrawal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:



C. Eickhoff

C. Vallet

Decision electronically authenticated