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**Datasheet for the decision
of 15 January 2020**

Case Number: J 0007/19 - 3.1.01

Application Number: 09734244.8

Publication Number: 2273476

IPC: C03C17/34, G09F9/30, B32B17/06,
B32B7/12, G02F1/1333,
H01L51/50, H05B33/02, H05B33/10

Language of the proceedings: EN

Title of invention:
TRANSPARENT SUBSTRATE

Applicant:
Nitto Denko Corporation

Headword:
Withdrawal of application/Nitto Denko

Relevant legal provisions:
EPC R. 139

Keyword:
"Request for correction of a withdrawal of an application (not allowed)"

Decisions cited:

J 0008/80, J 0004/82, J 0006/91, J 0004/97, J 0010/08,
J 0004/03, J 0019/03, G 0001/12, decision of the Board of
Appeal of the German Patent Office of 9. January 1954 H 1694
III/79b - 1 B 18/52

Catchword:

The notion of a mistake eligible for correction under Rule 139
EPC does not cover the scenario where a declaration of
withdrawal reflects the true intention of the applicant, but
is based on wrong assumptions.



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Case Number: J 0007/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 15 January 2020

Appellant: Nitto Denko Corporation
(Applicant) 1-1-2, Shimohozumi
Ibaraki-shi
Osaka 567-8680 (JP)

Representative: Hoffmann Eitle
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Arabellastraße 30
81925 München (DE)

Decision under appeal: **Decision of the Examining Division dated
11 February 2019, rejecting the request to
correct the withdrawal of European patent
application EP 09 734 244.8.**

Composition of the Board:

Chairman W. Sekretaruk
Members: R. Romandini
C. Josefsson

Summary of Facts and Submissions

- I. On 17 April 2009 the appellant filed European patent application No. 09 734 244.8 (henceforth: the application) as an international patent application claiming the priority of three Japanese filings. The request for entry into the European phase was made on 20 October 2010.

- II. On 9 June 2016 the appellant withdrew the application. It also requested a refund of any fees which had been already paid but had not yet fallen due.

- III. As a consequence, the procedure was closed on 15 June 2016. Furthermore, by means of a communication dated 20 June 2016, the examining division acknowledged the withdrawal of the application and informed the applicant that 75% of the examination fee would be refunded. The declaration of withdrawal was published in the European Patent Register on 9 June 2016 and in the European Patent Bulletin on 20 July 2016 (No. 29/2016).

- IV. By submission of 20 June 2017 the appellant filed a request for correction pursuant to Rule 139 EPC. It explained that the request to withdraw the application and to be refunded the official fees had been erroneous. It had been based "on the erroneous belief" that the claims of the withdrawn European patent application were the same as the claims of a corresponding Japanese patent application. The appellant had not realised that this assumption was wrong until April 2017. If the appellant had been aware of the different scope of the claims of the European patent application, it would never have decided to

abandon the application. Hence, there was a divergence between the applicant's true intention and the procedural step that had been taken.

- V. In the same submission the appellant made the following declaration: *"We herewith declare that Applicant will not exercise any rights originating from the present European patent application and/or the resulting European patent (once granted) in relation to any third party who, in a designated contracting state, has used or made effective and serious preparations for using the invention which is the subject of the present application and the resulting European patent in the period between the publication of abandonment by the EPO and the publication of the EPO of the present request for correction. That is, we declare that Applicant will not enforce the patent against any third party as defined above, so that said third party may continue such use in the course of his business or for the needs thereof without need for payment of any license fees."*
- VI. According to the appellant, the purpose of this declaration was to avoid any adverse effect on the public in the event that the request for correction of the withdrawal was allowed. Such adverse effects were conceivable if a member of the public had relied on the EPO's publication of the withdrawal of the application when deciding to use the claimed invention or to make preparations to use it. In that scenario, the declaration would have ensured that any activities could be continued without interference.
- VII. Following a communication of the examining division dated 15 February 2018 under Article 113 EPC, in its letter of 3 December 2018 the appellant then amended

this undertaking so as to extend it up to the point in time at which the request for correction was granted. In a submission of 25 June 2018 the appellant withdrew all the designations other than Germany. The applicant was of the view that, following this amendment, the question of whether the declaration would offer enough protection for third parties should be determined solely according to German law, since any granted patent could be enforced only in Germany.

VIII. The examining division rejected the appellant's request. The reasons given are summarised as follows:

(a) The primary addressee of a declaration of withdrawal is the public, not the EPO.

(b) In accordance with the case law of the boards of appeal, an erroneous withdrawal can only be corrected if the public has not been officially notified of the withdrawal at the time it is retracted. In the case in hand the letter of withdrawal was published in the Bulletin and in the Patent Register before the request for correction was made.

(c) The declaration filed by the applicant on 20 June 2016 could not compensate for the legal uncertainty that would be caused if a retraction were allowed.

IX. With its notice of appeal the appellant requested that this decision be "reversed" and that the "request for correction filed on June 20, 2017, which is subject to the declaration filed on the same day and the supplementary declaration filed on December 3, 2018" be allowed.

X. The appellant's arguments on appeal are summarised as follows:

- (a) By incorporating Rule 139 EPC the legislator acknowledged that applicants in proceedings before the EPO have a justified legal interest in the correction of errors. This provision applied to errors in any document filed with the European Patent Office.
- (b) The principle to which the first-instance decision referred, according to which a declaration of intent could only be retracted if the retraction reached the addressees either before or at the same time as the declaration, was not relevant for the proceedings in this case. Correction and retraction of a declaration were two distinct legal concepts. The proceedings concerned a request for correction, not retraction.
- (c) The request satisfied the requirements laid down by the case law for allowing a correction.

Firstly, the declaration contained a mistake which was correctable under Rule 139 EPC. The decision to withdraw the application had been based on wrong assumptions. The applicant had intended to withdraw a "non existing European application with narrow claims like that Japanese parallel applications, but not to abandon the instant EP application with broader claims". Therefore, there was a divergence between the true intention and the content of the declaration.

Secondly, it was true that the case law of the

boards of appeal had stipulated that a mistake could not be corrected once the withdrawal had been published unless the mistake was recognisable for third parties. However, the case law required the mistake to be recognisable in order to prevent the correction causing detriment to third parties who had legitimately relied on the publication of the erroneous act. In the case in hand, this interest was fully protected by the declaration submitted by the applicant at first instance, which was binding under German law.

Thirdly, the mistake at issue had been made due to an excusable oversight. The factual situation behind the withdrawal was exceptional. In most of the appellant's cases, the claims of a pending European application and the claims of the corresponding Japanese priority application were similar. In the past, the applicant had not seen any need to check the scope of the claims of every individual family member.

Finally, the request for correction had been filed promptly.

XI. Oral proceedings took place on 15 January 2020.

Reasons for the Decision

1. According to Rule 139 EPC linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. This provision has been subject to extensive interpretation by the boards of appeal. According to the case law (J 8/80, OJ EPO 1980, 293, Reasons No. 3; J 4/82, OJ EPO 1982, 385, Reasons No. 3; J 19/03 of

11 March 2005, Reasons No. 3-12; J 4/97 of 9 July 1997, Reasons No. 3), Rule 139 EPC also applies to "corrections of procedural acts if they are submitted by a document", for example to a request for correction of the withdrawal of a designation or of a claimed priority (cf. J 19/03, loc. cit., Reasons No. 3 and 4). In this case the correction would retrospectively modify or eliminate the procedural act concerned.

The provision is of general application (G 1/12, OJ EPO 2014, A114, Reasons No. 35-39). It applies to any declaration or procedural act, including the withdrawal of an application. As correctly pointed out by the appellant, retraction and correction of a declaration are two distinct legal concepts.

2. An applicant's ability to correct a withdrawal, however, is subject to several conditions specified by the case law. The first of them is the existence of a mistake within the meaning of Rule 139(1) EPC.
3. The EPC does not provide a definition of this term; it is the task of the case law to fill this lacuna. According to the case law, "a mistake may be said to exist in a document filed with the European Patent Office if the document does not express the true intention of the person on whose behalf it was filed" (cf. J 8/80, OJ EPO 1980, 293, Reasons No. 4; J 4/82, OJ EPO 1982, 385, Reasons No. 5). Therefore, mistakes which result in a divergence between the party's actual and declared intent are eligible for correction under Rule 139 EPC. As clarified by the Legal Board of Appeal, "the correction must introduce what was originally intended" and "cannot be used to enable a person to give effect to a change of mind or development of plans" (J 8/80, loc. cit., Reasons No.

6; J 6/91, OJ EPO 1994, 349, Reasons No. 2.2; see also G 1/12, loc. cit., Reasons No. 37).

4. In the case in hand, the applicant intended to withdraw the application; its letter of 20 June 2016 correctly expressed this intent. The alleged error relates to the reasons for filing the withdrawal. The applicant mistakenly believed that the claims of the European application did not differ considerably from the claims of the corresponding Japanese application. On the basis of this assumption it decided to abandon the application. There was no divergence between declaration and will. In fact, the only divergence was between what the appellant would have been likely to do had it been aware of all the circumstances and what it actually did. However, divergences between a party's hypothetical intention and the content of a declaration it filed with the EPO do not fulfil the notion of a mistake as developed by the case law. Hence, they are outside the scope of Rule 139 EPC as interpreted by the boards. The correction in this case would not establish what was originally intended, but correct the original intention since it was formed on the basis of wrong assumptions.
5. At the oral proceedings, the applicant raised two objections against this preliminary view. The first was that, while it may be true that the mistake at issue related to the assumptions on which the declaration was based, these assumptions concerned the application itself and not extrinsic factors, e.g. the commercial prospects of the invention or the market situation in Europe or the US. Therefore, it was not an error relating to the motives, contrary to the board's suggestion in the communication issued in preparation for the oral proceedings. The board agrees with this

remark. The mistake concerned specific attributes of the subject-matter referred to in the declaration of intent. However, this characterisation does not change the conclusion as to whether or not applicant's declaration reflected its true intention.

6. The second argument was that, according to the applicant, the case in hand does not materially differ from that on which decision J 10/08 of 16 November 2009 was based, in which the request to correct the withdrawal was granted. In that case, the applicant intended to abandon a PCT application. However, by mistake, it instructed the European representative to withdraw the EP application instead. Similarly, in the case in hand, the applicant did not intend to abandon the European application; it merely intended to abandon a non-existent further application with claims identical to those of the Japanese application. In both cases the withdrawal did not reflect the applicant's true intention. The fact that in J 10/08 there were two pending applications involved, while in the case at hand only one pending application is involved, does not prevent the Board from following the same reasoning as in J 10/08 and grant the request.

The board cannot agree with this argument. The two cases concern two different factual situations and two different types of mistake. In J 10/08, a US attorney mixed up the instructions pertaining to two different applications from the same company. As a consequence of this error, he instructed the European representative to withdraw the European application on behalf of the applicant, while the applicant had actually intended to abandon the PCT application.

In the case in hand, the applicant intended to withdraw

the application at issue but had decided to do so because it had mistakenly attributed specific characteristics to it. There is a clear difference between a situation where a party did not intend what it (or its representative) declared, and a situation where the party intended to declare exactly what it (or its representative) declared, but did so because it mistakenly believed some facts to be true. In the first case the mistake leads to a conflict between declaration and intention; in the second case the mistake affects only the formation of that intention. In the first case the correction would bring the filed document in line with the original intention of the party; in the second case the correction would modify an act or document matching the original intention with an act or document reflecting a different intention that was not influenced by a wrong assumption.

The distinction between errors relating to the declaration, its content or its transmission and errors relating to the assumptions on which the declaration is based is made in the civil law of several contracting states too (see, for example: in Italian law, Article 1433 Civil Code (CC), which concerns errors as to the declaration or its transmission, and Article 1429 Nos. 1-3 CC, which concerns mistakes as to the nature or the subject of the contract, the identity or the characteristics of the other contracting party; in German law, Section § 119(1) BGB, which deals with errors as to the content of the declaration, and Section § 119(2) BGB, which concerns mistakes about the characteristics of a person or a thing; in Swiss law, Article 24(1) Nos. 1-3 of the Federal Act on Amendment of the Swiss Civil Code, Part Five: The Code of Obligations, dealing with errors as to the declaration, and Article 24(1) No. 4, which deals with mistakes as

to the facts on which the declaration is based). In the case law of the boards, only errors relating to the declaration, its content or its transmission fall under the notion of a mistake within the meaning of Rule 139 EPC.

7. There are also good policy reasons for having this limitation. If the notion of a mistake were extended to also cover a scenario where the declaration correctly reflects a party's intentions, but was based on wrong assumptions, any mistaken assessment of the disclosure of the application, the patentability of the invention, the entitlement to priority, the legal provisions or the related case law would make any withdrawal potentially eligible for correction. This would be detrimental to legal certainty (see for similar concerns also the decision of the Board of Appeal of the German Patent Office of 9. January 1954 H 1694 III/79b - 1 B 18/52, GRUR 1954, 118).

As clarified in the case law, the withdrawal of an application "is the gravest procedural step that can be taken" (J 4/03 of 9 September 2004, Reasons No. 12); it produces several effects for both the EPO and the public. After a withdrawal, the EPO has to take several procedural steps and arrange for the refund of the fees. Legal certainty requires that the "EPO must be able to assume that a withdrawal has been made with all the deliberation and care necessary for such a grave step" and that the "European Patent Office can rely on the statements of the parties in proceedings" (J 4/03 of 9 September 2004, loc. cit., Reasons No. 12). After the publication of the withdrawal, the interest of the public is also involved. Third parties must be able to trust information published in the European Patent Bulletin. Therefore, where the applicant has made a

decision on withdrawal without considering all the relevant circumstances, it must bear the consequences.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated