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Aktenzeichen / Case Number / N^o du recours : J 06/86

Anmeldenummer / Filing No / N^o de la demande : 80 902 337.7

Veröffentlichungs-Nr. / Publication No / N^o de la publication : WO 81/01242

Bezeichnung der Erfindung:
Title of invention: Method of enzymatic debridement
Titre de l'invention :

Klassifikation / Classification / Classement : A 61 K 37/48

ENTSCHEIDUNG / DECISION
vom / of / du 28 January 1987

Anmelder / Applicant / Demandeur : Riker Laboratories, Inc.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Riker Laboratories

EPO / EPC / CBE Article 125, Rules 51(4) and (5)

Kennwort / Keyword / Mot clé : "Withdrawal - abandonment"
"Interpretation of a specific statement"

Leitsatz / Headnote / Sommaire

- I. A statement "Applicant wishes to abandon this application" may be construed as withdrawal of a European patent application if nothing in the circumstances under which the statement was made could be taken as qualifying such an interpretation.
- II. Article 125 EPC is only applicable in the absence of relevant procedural provisions in the Convention. It is not applicable when the question submitted to the Board is only a question of interpretation of a specific statement made to the EPO by an applicant for a European patent.

Europäisches
Patentamt
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European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : J 06/86

D E C I S I O N
of the Legal Board of Appeal ?
of 28 January 1987

Appellant : Riker Laboratories, Inc.
19901 Nordhoff Street
Northridge, California
USA

Representative : Baillie, Iain Cameron
c/o Ladas & Parry
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D-8000 München 2

Decision under appeal : Decision of the Head of Formalities Section of Directorate General 2 of the European Patent Office dated 11 October 1985 rejecting a request that the EPO should consider the letter filed by the Appellant's representative 10 January 1985 not to be a notice of withdrawal of European patent application No. 80 902 337.5.

Composition of the Board :

Chairman : P. Ford
Member : C. Payraudeau
Member : R. Schulte

Summary of Facts and Submissions

- I. Euro-PCT application No. 80 902 337.7 was filed on 24 October 1980 claiming the priority of two US applications filed on 5 November 1979.
- II. On 16 March 1984, a Formalities Officer of the Examining Division sent to the Appellant's representative a communication pursuant to Rule 51(4) and (5) EPC informing him of the intention of the Examining Division to grant a European patent on the above application.
- III. In answer to this communication, on 14 June 1984, the Appellant informed the Examining Division of his express disapproval of the text proposed in the communication of 16 March 1984, adding "we shall contact you in the near future with details of the corrections that the applicant wishes to make".
- IV. On 9 January 1985, the Formalities Officer phoned to the Appellant's representative to inquire about the corrections which had not yet been submitted and was informed that the case was to be abandoned. On 10 January 1985 the Appellant's representative sent to the EPO a confirmation containing in substance the single sentence "Applicant wishes to abandon this application". This letter was acknowledged on 4 February 1985 by the Formalities Officer with a letter stating "Receipt of the declaration of withdrawal of the European patent application on 10 January 1985 is hereby acknowledged".
- V. On 20 February 1985, the Appellant's representative addressed to the EPO a telex, later on confirmed by a letter, stating that he had not had the intention to withdraw the application and that the Applicant now wished to continue prosecution of the application. In a further

exchange of correspondence with the EPO, the Appellant's representative argued essentially that he had only manifested to the EPO his intention to abandon the case, that is, not to take any further procedural step with respect to the application. This could not be considered as a formal withdrawal of the case. The correct procedure would have been for the EPO to refuse the application.

- VI. By a decision given on 11 October 1985, the Head of the Formalities Section of the Directorate General 2 of the EPO refused to consider the letter filed on 10 January 1985 not to be a notice of withdrawal.
- VII. On 10 December 1985, the Appellant filed a notice of appeal together with a request for restitution of the patent application as an alternative plea, later withdrawn by the Appellant. The appeal fee was duly paid. In his statement of grounds filed on 21 February 1986, the Appellant again submitted that the words "to abandon" could not be interpreted as "to withdraw", citing numerous legal opinions in support of this view as well as a decision of the German Federal Patent Court of 21 December 1970 (B Pat. G E 12, 81) and an exchange of correspondence between the Appellant's representative and the EPO in another case in which the EPO had considered that the expression "the applicant has decided to abandon the application" was not adequate to withdraw the application.
- VIII. In his answer to a communication from the rapporteur of the Board expressing the opinion that, in the circumstances of the case, it seemed that the Formalities Officer had correctly interpreted the letter of 10 January 1985 as a formal withdrawal of the application, the Appellant maintained his former argumentation insisting on the point that the Board was under the obligation (in application of Article 125 EPC) to take into consideration the cited

decision of the German Federal Patent Court. The practice of the EPO in other cases should also be taken into account because "where the action of the Patent Office (even if wrong) establishes a practice, then the patent applicants can expect the practice to be followed. It would be unfair to change the practice suddenly without official promulgation especially if this results in the loss of rights". He annexed to his answer an affidavit, a statement and other documents fully explaining the history of the case and requested oral proceedings.

According to these explanations and to those already given in the statement of grounds, the Appellant's representative, not having received in due time from his client any instruction to complete the grant formalities of the European patent application in suit had addressed to the EPO the above-mentioned letter dated 14 June 1984 in order to maintain the case pending and avoid rejection of the patent application. The representative received later on from his client a letter dated 23 August 1984 asking him to abandon and/or withdraw the case, to which he answered on 5 September 1984 informing his client "we are allowing this case to lapse by failure to complete the grant formalities at the EPO. We shall take no further action regarding this application and have closed our file".

However, at about the same period, the Appellant changed his mind and decided to reinstate the case. He effectively gave the instruction to pay the renewal fee for this application but omitted by mistake to inform the representative.

Consequently, when the secretary of the representative received the phone call from the Formalities Officer on 9 January 1985, she consulted the file which was marked

abandoned and informed the Formalities Officer that the requested amendments would not be filed. She agreed to address to the EPO a confirmation letter which was sent on 10 January 1985 and acknowledged as a withdrawal by the Formalities Officer on 4 February 1985.

On 18 February 1985 the representative received a further communication from his client instructing him to complete the Rule 51(4) procedure. He then addressed to the EPO the above-mentioned telex dated 20 February 1985.

- IX. The request for a hearing was withdrawn by letter of 7 January 1987 in which the Appellant requested the Board to continue the procedure by correspondence.

Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is therefore admissible.
2. The Board has previously held that although the objective content of a letter is decisive to determine whether it constitutes an unconditional response to a question from the EPO, this content is not to be interpreted in isolation but in the context of earlier communications from the Examining Division and letters from the applicant (see J 24/82, J 25/82, J 26/82, OJ EPO 1984, 467).
3. In the present case, the Appellant's representative, in response to the "notice of communication pursuant to Rule 51(4) and (5) EPC" dated 16 March 1984 had written a letter dated 14 June 1984 expressing his disapproval of the text proposed by the Examining Division and indicating that he would shortly propose some corrections. To the verbal inquiries made on 9 January 1985 (i.e. more than six months

later) by a Formalities Officer of the Examining Division, he answered that the case was to be abandoned and he sent a confirmation letter on 10 January 1985.

It is evident that, in this context, the intent both of the Formalities Officer in asking for a confirmation of this telephone conversation and of the appellant's representative in sending the letter of confirmation was to terminate the case without any formal decision.

4. In this context, no other interpretation can be given of this letter of the Appellant's representative which contains only one sentence "Applicant wishes to abandon this application".

Even if it can be accepted that abandonment is simply taking no action and thus allowing the application to fail by failure to take the necessary procedural steps, nevertheless when, as in the present case, the wish to abandon the application is manifested and communicated to the EPO in writing without any limitation or condition, **this action** may rightly be considered as a completely unqualified and unambiguous notice of withdrawal. Even if the formulation does not contain the word "withdrawal", the intent of the applicant has been clearly expressed by his duly authorized representative and is thus irrevocable.

This interpretation is confirmed by the fact that the Appellant's representative did not immediately raise objections to the acknowledgement of withdrawal dated 4 February 1985 but only sent his telex of 20 February 1985 after having received new instructions from his client asking him to revive the case.

5. The fact that in another case, at about the same time, a Formalities Officer of the Examining Division had considered the wording "Applicant has decided to abandon this application. Please refund the grant and printing fees ..." not clear enough to constitute a formal withdrawal cannot be considered as having established a precedent or a practice on which the Appellant's representative is entitled to rely in the present case.

6. The Appellant has referred to various opinions on national law and has also cited a decision given by the German Federal Patent Court on 21 December 1970 which he considered that the Board of Appeal had to take into consideration under Article 125 EPC.

The Board considers that in accordance with its terms, considered in the context of the EPC as a whole, Article 125 EPC is only applicable in the absence of relevant procedural provisions in the Convention. In the present case, the question submitted to the Board is not a question of procedural rules at all but only a question of interpretation of a specific statement, namely "Applicant wishes to abandon this application". For the interpretation of this statement there can be no applicable principle of procedural law within the meaning of Article 125 EPC.

7. Consequently, the Board is of the opinion that the Head of Formalities section of Directorate General 2 of the EPO had correctly interpreted the letter of the Appellant's representative dated 10 January 1985 as a valid notice of withdrawal of the European patent application.

8. Since the appeal is consequently not allowable the request for reimbursement of the appeal fee presented in the Appellant's statement of grounds filed on 21 February 1986

must also be rejected, in conformity with the provisions of Rule 67 EPC.

Order

For these reasons, it is decided that:

1. The appeal against the decision of the Head of the Formalities Section of Directorate General 2 of the European Patent Office dated 11 October 1985 is dismissed.
2. The request for reimbursement of the appeal fee is rejected.

The Registrar:

Submitted 3.2.87
CP 28.1.87
J. Pfe

The Chairman:

Peter Lind