

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Ou

Aktenzeichen / Case Number / N° du recours : J 15/86

Anmeldenummer / Filing No / N° de la demande : 82 109 493.5

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 080 592

Bezeichnung der Erfindung: A novel vasodilator compound, process for the
Title of invention: preparation thereof and pharmaceutical
Titre de l'invention : compositions therefrom

Klassifikation / Classification / Classement : C07C 123/00, A61K 31/155

ENTSCHEIDUNG / DECISION

vom / of / du 9 October 1987

Anmelder / Applicant / Demandeur : Ausonia Farmaceutica S.r.l

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Withdrawal of application/AUSONIA

EPO / EPC / CBE Article 125

Kennwort / Keyword / Mot clé : "Withdrawal of patent application" -
"Interpretation of letter" - "Retraction of
withdrawal of patent applications too late" -
"General principles of procedural law"

Leitsatz / Headnote / Sommaire

- I. In practice, in the operation of the European patent system, there is a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there is a dispute as to the applicant's intention has to be considered on its own facts.
- II. It is too late to ask for retraction of a letter of withdrawal once the withdrawal has been notified to the public in the European Patent Bulletin.
- III. Principles of procedural law generally recognized in the Contracting States, within the meaning of Article 125 EPC, do not include specific rules of substantive law of any Contracting State.

**Europäisches
Patentamt**

Beschwerdekammern

**European Patent
Office**

Boards of Appeal

**Office européen
des brevets**

Chambres de recours



Case Number : J 15/86

D E C I S I O N
of the Legal Board of Appeal
of 9 October 1987

Appellant : Ausonia Farmaceutica S.r.l.
Via Laurentia, Km. 24730
Pomezia (Rome)
Italy

Representative : Dr. B. Hansen et al.
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Decision under appeal : Decision of the Head of the
Formalities Section of Directorate
General 2 of the European Patent
office dated 28 November 1985.

Composition of the Board :

Chairman : P. Ford

Members : F. Benussi

C. Payraudeau

Summary of Facts and Submissions

- I. European patent application No. 82 109 493.5 was filed on behalf of the appellant on 14 October 1982.

On 23 July 1984, the EPO gave advance notice, pursuant to Rule 51(4) and (5) EPC, of the intention to grant a European patent. In acknowledging the notice, the appellant's representative pointed out that the fees for grant and for printing had already been paid.

- II. By a communication dated 13 December 1984, the Examining Division of the European Patent Office informed the appellant's representative of the decision to grant a European patent.

- III. On 31 December 1984, the EPO received a letter dated 28 December 1984 from the appellant's representative, the body of which consisted of three consecutive sentences:

"This is to inform you that the applicant company lost their interest in the above European patent and decided to abandon it."

"I kindly ask you not to take any further step for the above patent and send me confirmation that the case will be withdrawn."

"I kindly ask you to let me know also if it is possible to get any reimbursement of the paid taxes, possibly the latest granting and printing fees."

- IV. By letter dated 21 January 1985, the Office informed the appellant's representative that a refund of the grant and printing fees was not possible because the technical preparations for grant of a European patent had already taken place. Subsequently, the appellant appointed a new representative and in a letter dated 29 March 1985, the appellant's new representative submitted that the statements made in the previous representative's letter, had been misinterpreted by the EPO; contested the acknowledgement of withdrawal of the European patent application; and asked that the EPO declare that the patent application is and has always been in force. In the meantime, on 20 March 1985, the public had been given notice that the European patent application had been withdrawn (in European Patent Bulletin No. 12/85).
- V. On 28 November 1985, the Head of Formalities Section of Directorate General 2 issued a Decision holding that the notice of withdrawal had become effective on 31 December 1984 and that, therefore, from this date the European patent application was withdrawn. Accordingly, the appellant's request was refused.
- VI. A notice of appeal against the Decision was filed on 21 January 1986, and the fee for appeal paid. In a Statement of Grounds of Appeal filed on 27 March 1986 it was submitted:
- (i) that the meaning and effect of "abandoning" an application as compared with "withdrawing" it is quite different. As the letter of 28 December 1984 had used both expressions it was entirely unclear;

- (ii) that the request for withdrawal was conditional on repayment of the grant and printing fees.
- (iii) that in accordance with the principles of procedural law generally recognised in the Contracting States (Article 125 EPC), a declaration of intention must be interpreted so as to give effect to the true intention of the person making it. In particular, the appellant cited a Decision of the German Federal Patent Court in which that Court had had to decide a similar case;
- (iv) that the applicant always wanted to maintain the European patent application. He had only informed his previous representative of his intention to allow the national patent rights which would arise out of his European patent application to lapse, and this was to be done at a time when further costs would have been incurred. In the circumstances, the previous representative had acted by mistake and consequently, in this case, on the basis of Article 125 EPC, paragraphs 120 and 121 of the German Civil Code would be applicable.

VII. By a communication dated 10 November 1986, the Rapporteur of the Legal Board of Appeal indicated that in his opinion, the letter of 28 December 1984 contained a notice of withdrawal; the subsequent behaviour of the appellant, i.e. his lack of reaction to the acknowledgement of withdrawal of the European patent application, dated 29 January 1985, implied that he agreed to withdrawal.

The Rapporteur indicated also that a notice of withdrawal is generally binding on the applicant and that Article 125 EPC could not be applied in this case; for these reasons the appeal would be unlikely to succeed.

VIII. In a letter dated 9 February 1987, the appellant's present representative contested the views of the Rapporteur, enlarging upon the reasons already offered to support the Statement of Grounds and he asked for oral proceedings. In a further letter dated 5 March 1987, the representative asserted that the appellant did not decide to withdraw the European application, but instructed his previous representative just to let it become abandoned by not taking further actions incurring expense.

IX. By letter dated 29 April 1987, the Registrar, pursuant to Rule 71(1) EPC, issued a summons to oral proceedings, but the appellant, on 3 June 1987, informed the Board of Appeal of his intention to withdraw his request for oral proceedings and they were accordingly cancelled.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. In practice, in the operation of the European patent system, there is a recognised difference between passive abandonment of a European patent application and active withdrawal of it. Each case in which there is a dispute as to the applicant's intention has to be considered on its own facts.
3. It is, therefore, first necessary to consider the letter received by the EPO on 31 December 1984, in which the EPO was informed that the appellant had "lost interest" in the application and had "decided to abandon it".

This statement must be interpreted in the context of the letter as a whole and of the surrounding circumstances.

In the second sentence of the letter, the appellant's representative expressly requested the EPO "not to take any further step" and to send confirmation that the case would be withdrawn.

This was followed by a request for reimbursement of the granting and printing fees.

4. In spite of the fact that the letter spoke both of abandonment and withdrawal, the general tenor of the letter supports the conclusion that withdrawal was wanted. The Legal Board of Appeal, therefore, finds that the letter was correctly interpreted by the Formalities Section.

Furthermore, in the circumstances of the present case, the point of time had been reached at which passive abandonment was no longer possible: if the application was not withdrawn it had either to be granted or refused. Therefore, the Formalities Section had no reason to think that "abandonment" was wanted, and every reason to think that withdrawal should be immediately confirmed, as asked and as was done.

5. Moreover, the appellant's representative did not react to communications informing him that no refunds of the grant and printing fees were possible and acknowledging withdrawal of the European patent application. It is clear that, so far as the representative was concerned, he though his intentions had been correctly understood.

6. Furthermore, it cannot fairly be said that the withdrawal of the patent application was in any way conditional on reimbursement of the fees which had been paid. The text of the letter does not allow such an interpretation: "I kindly ask you to let me know also if it is possible to get any reimbursement ...".
7. Thus, the present case is entirely different from the case decided on by the Legal Board of Appeal on 25 March 1981, J 11/1980, OJ EPO 5/1981, page 141, which had to consider the question of whether an application was unconditionally withdrawn or not, because the condition for withdrawal imposed by the applicant was not satisfied. In that case, the appellant did clearly indicate that he wished to withdraw his application on the not uncommon condition that the contents of the application remained undisclosed to the public.
8. For the foregoing reasons, the Board cannot agree to the submissions of the appellant's new representative that the letter dated 28 December 1984, was unclear, conditional and confusing and, therefore, was no basis for considering the application as withdrawn. In the judgement of the Board, there was an effective withdrawal.
9. The question now to be considered is whether the effective withdrawal of a European patent application can be retracted on the ground that the withdrawal was made by mistake. According to Legal Advice No. 8/80, OJ 1981, page 6, a valid notice of withdrawal which has been received at the EPO is binding on the applicant.

According to paragraph 2 of the Legal Advice, the EPO attaches various direct, legal consequences to a notice of withdrawal by the applicant and for an orderly grant

procedure it is necessary that the legal effects resulting from a valid notice of withdrawal cannot be subject to uncertainty as would be caused by allowing retraction of a validly expressed and notified intention.

10. In paragraph (7) of the Statement of Grounds of the appeal it is asserted that "The applicant always wanted to maintain the European patent. He had only intended to allow the national patents which arise out of the European patent to lapse and this was to be done at a time when further costs would have been incurred. The applicant informed his former representative of this intention." At a late stage in the appeal proceedings, namely in March 1987, after issue of a communication by the Board, the appellant's present representative for the first time quoted verbatim from the actual instructions given to the previous representative by letter dated 30 October 1984. These instructions were "not to take further actions involving expenses".

It may be that the representative concerned wrongly interpreted the instructions given as instructions to save money and to obtain, if possible, a refund of fees already paid, even if this could necessitate withdrawal. However, in the opinion of the Board, in the public interest, it must be too late to ask for retraction of a letter of withdrawal once withdrawal of the European patent application has been notified to the public in the European Patent Bulletin.

11. Finally, in view of the arguments put forward based on German law, it must be pointed out that Article 125 EPC provides that in the absence of procedural provisions in the EPC, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States (emphasis added). The nature of such principles, relating to the right to be heard, the binding nature of decisions and the like, is well known.

The submissions advanced in the Statement of Grounds of Appeal and in the supplement dated 12 January 1987, that the former representative was mistaken as to the scope of the content of his declaration and that the provisions of the German Civil Code should be applied, are not supported by the provisions of Article 125 EPC, which only refer to the principles of procedural law generally recognised in the Contracting States and not to the specific rules of civil law of any one State as to the matter of mistake in expressing an intention or any other question of substantive law.

Order

For these reasons, it is decided that

the appeal against the decision of the head of the Formalities Section, dated 28 November 1985, is dismissed.

The Registrar

The Chairman