

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

Aktenzeichen / Case Number / N° du recours : J 7/87

Anmeldenummer / Filing No / N° de la demande : 83 103 133.1

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 092 073

Bezeichnung der Erfindung: Magnesium salt

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : C 07 J 51/00

ENTSCHEIDUNG / DECISION

vom / of / du 28 October 1987

Anmelder / Applicant / Demandeur : Schwarz Italia S.p.A.

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Abandonment/Schwarz Italia

EPO/EPC/CBE Article 97(4)

Kennwort / Keyword / Mot clé : "Withdrawal of patent application" - "language used" - "need for clarification"

Leitsatz / Headnote / Sommaire

Effective withdrawal of a European patent application does not depend on whether the applicant has used the term "withdrawal". The language used must be interpreted having regard to the surrounding circumstances from which it must be clear that the applicant really wants immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

**Europäisches
Patentamt**

Beschwerdekammern

**European Patent
Office**

Boards of Appeal

**Office européen
des brevets**

Chambres de recours



Case Number : J 7/87

**D E C I S I O N
of the Legal Board of Appeal
of 28 October 1987**

Appellant : Schwarz Italia S.p.A.
Via Emilia 99
I 20075 S. GRATO-LOCI (Milano)

Representative : Aimi, Luciano
c/o Società Italiana Brevetti S.p.A.
Via Canducci 8
I-20123 Milano

Decision under appeal : Decision of the Head of Formalities Section of
Directorate General 2 of the European Patent
Office dated 14 October 1986.

Composition of the Board :

Chairman : P. Ford
Members : O. Bossung
F. Benussi

Summary of Facts and Submissions

- I. On 29 March 1983, the appellants filed a European patent application. In the course of examination, only minor editorial amendments were required to be made to the application and on 20 January 1986 a decision to grant the patent was sent to the representative of the appellants who was at that time recorded by the EPO as acting for them. Mention of the grant of the patent was published in European Patent Bulletin No. 1986/1, dated 26 February 1986 and the European patent specification (No. 0 092 073) was published simultaneously.

- II. The appellants had already decided in June 1985 to entrust all their patent and trade mark work to a different representative: the original representative knew nothing about this and in January 1986 he sent a reminder to the appellants that the fourth renewal fee would fall due at the end of March 1986. To this reminder he received a letter from the appellants dated 28 January 1986, the material part of which (in the appellants' present representative's translation) read: "We are returning to you the expiry notice of the patent in re, as we have acted otherwise. We ask you in addition to remove it from your watching service." At the same time, the appellants instructed their present representative to pay the renewal fee.

- III. The appellants' previous representative reacted to the letter of 28 January 1986 by writing to the EPO on 6 February 1986 "we advise you that our client has decided to abandon the case in re." This letter was received by the EPO on 12 February 1986. On 10 March 1986, by telephone, and on the following day by (duly confirmed) telex, the previous representative requested the EPO to ignore his letter.

- IV. By letter dated 17 March 1986 the appellants' present representative sought repayment of the fourth annual renewal fee on the ground that it was not due to the EPO. The Office replied, stating that the withdrawal of the European patent application by the previous representative had been effective and that the withdrawal of the application could not be corrected. In a detailed letter dated 11 June 1986, the appellants' present representative explained the history of the matter and requested correction of the letter of 6 February 1986 under Rule 88 EPC.
- V. By the decision under appeal, dated 14 October 1986, the Head of Formalities Section of Directorate General 2 refused the request for the notice of withdrawal (sic) to be retracted. It was held that the European patent application had been validly withdrawn: an express statement of desire to end the procedure was sufficient and was binding on an applicant. It was accepted that there had been a mistake within the meaning of Rule 88 EPC but the public interest required that correction could not be allowed: cf. the Decisions J 14/82 (OJ EPO 1983, 121), J 12/80 (OJ EPO 1981, 143) and in particular J 15/85 (to be published).
- VI. On 2 July 1986 the change of representative was duly recorded and on 16 September 1986 a change of name of the appellants (without change of corporate identity) was also duly recorded.
- VII. The appellant filed the present appeal on 15 December 1986 and paid the appeal fee. The Statement of Grounds of Appeal filed on 6 February 1987 sought to distinguish passive abandonment from active withdrawal. The EPO must take care not to regard a simple letter informing it of an intention to abandon a case as irrevocable withdrawal especially when

the application had successfully passed through all stages of examination and all fees had been paid. Before considering an application as withdrawn in such circumstances, the EPO ought to seek clarification of the applicant's intentions. Otherwise it would be desirable to regard as a withdrawal only cases in which a precise and set phrase was employed.

VIII. The appellants requested that the decision under appeal should be set aside.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106-108 and Rule 64 EPC. It is, therefore, admissible.
2. The Office received a letter containing the words "We advise you that our Client has decided to abandon the case in re" after it had decided to grant the European patent but before publication of the mention of the grant. The first question to be considered concerns the correct interpretation of this letter, in which the word "withdraw", which is a term used in the language of the EPC, was not employed.
3. It is, of course, not necessary that the word "withdraw" be used in order to bring about an effectual withdrawal of a European patent application (cf. Decision J 06/86 of 28 January 1987, to be published). It is sufficient but necessary that the intention to withdraw the application immediately and unconditionally can be clearly deduced from all the circumstances.
4. However, in view of the fact that passive abandonments of European patent applications outnumber active withdrawals - so the Board is informed - by a ratio of three to one and in view of the difficulties inherent in attempting to

correct an erroneous communication of withdrawal (as indicated in the decision under appeal) and in view of possible ambiguity in the use of the word "abandon" and its synonyms, it is incumbent upon the Office to be cautious before interpreting a communication from an applicant or his representative as a withdrawal.

5. In the present case, the disputed letter from the appellants' previous representative could fairly be interpreted as mere information that the appellant no longer intended to pay the fourth renewal fee. It could perhaps be supposed that express withdrawal was being sought but there is no indication of a desire to prevent mention of the grant from being published.
6. In the judgement of the Board, the disputed letter could not without confirmation properly be regarded as a withdrawal. As indicated above, it is not necessary that the expression "withdraw" be used in order to effect a withdrawal. Whatever language is used, however, it must be clear from all the circumstances that the applicant really wants immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

In the present case, the statements made in the file by both the appellants' representatives show that the appellants' previous representative did not have any intention of withdrawing the patent application or the slightest reason for doing so.

7. Refund of the appeal fee appears equitable, within the meaning of Rule 67 EPC, because a simple request for confirmation of the appellants' intention could have avoided all the difficulties that have ensued and the failure to make it must be regarded as a substantial procedural violation.

Order

For these reasons it is ordered that:

1. The Decision of the Head of the Formalities Section of Directorate General 2 dated 14 October 1986 is set aside.
2. It is declared that European patent application No. 83 103 133.1 (publication No. 0 092 073) has never been withdrawn.
3. The fee for appeal is to be reimbursed.

The Registrar


J. Rückerl

The Chairman


P. Ford

