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Aktenzeichen / Case Number / N<sup>o</sup> du recours : J 10/87

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 83 105 582.7

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 100 832

Bezeichnung der Erfindung: Brazing method and alloy for bismuth steel

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : B 23 K 35130

### ENTSCHEIDUNG / DECISION

vom / of / du 11 February 1988

Anmelder / Applicant / Demandeur : Inland Steel Company

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Retraction of withdrawal/INLAND STEEL

EPÜ / EPC / CBE Rule 88 EPC

Kennwort / Keyword / Mot clé : Retraction of withdrawal of the designation of a Contracting State

#### Leitsatz / Headnote / Sommaire

A request for retraction of a withdrawal of the designation of a Contracting State filed after publication of the patent application is allowable under Rule 88 EPC in appropriate circumstances, in particular if

- (a) the public has not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal is applied for;
- (b) the requested correction does not result in a substantial delay of the proceedings; and
- (c) the EPO is satisfied that the interests of third parties who may possibly have taken notice of the withdrawal by inspection of the file are adequately protected.

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number, : J 10/87

**D E C I S I O N**  
of the Legal Board of Appeal  
of 11 February 1988

**Appellant :** Inland Steel Company  
30 West Monroe Street  
Chicago  
Illinois 60603  
U.S.A.

**Representative :** Leach, John Nigel  
Forrester & Boehmert  
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**Decision under appeal :** Decision of the Formalities Officer,  
Directorate General 2 of the European  
Patent Office, dated 27 October 1986.

**Composition of the Board :**

**Chairman :** P. Ford

**Members :** R. Schulte

G.D. Paterson

## Summary of Facts and Submissions

- I. European patent application No. 83 105 582.7 was filed on behalf of the Appellant on 7 June 1983. In the request for grant of the European patent eight States were designated, inter alia the United Kingdom. With the filing of the patent application, the designation fee for the United Kingdom was paid.
- II. The application was published on 22 February 1984 in European Patent Bulletin No. 1984/08 under the publication No. 0100832.
- III. On 29 November 1985 the European Patent Office gave notice pursuant to Rule 51(4) and (5) EPC of its intention to grant a European patent. In acknowledging the notice, the Appellant's representative filed, with letter dated 17 December 1985, translations of the claims into French and German and paid the grant and printing fees.
- IV. By a letter dated 16 December 1985 and received on 23 December 1985 the representative of the Applicant stated that the European Patent Office should note "that the Applicants do not wish to pursue the British designation of this application and hence request that the British designation is irretrievably withdrawn".
- V. On 3 March 1986 the representative sent a telex stating that the letter of 16 December 1985 was filed without the knowledge or authority of the Applicants due to an administrative error. It was requested that the letter of 16 December 1985 should be ignored and that the application should proceed to grant with all States designated, including the United Kingdom. The error had been noted during a check to see that the formalities

relating to perfection of grant had been complied with by the due date. The requested ignoring of the letter should be allowable under Rule 88 EPC. According to statutory declarations executed by three persons working in the Appellant's representative's firm, it is usual practice in their firm to withdraw the British designation of the European patent application when the domestic British patent is granted, but in the present case the American Applicants had no domestic British patent. The representative did not receive any instructions that the British designation was to be withdrawn. The secretary prepared the letter of 16 December 1985 without having been instructed to do so and the representative signed it by mistake, arising from human error.

- VI. On 27 October 1986 the Formalities Officer issued the contested decision refusing the request for cancellation of the withdrawal of the designation of the United Kingdom, on the grounds that the erroneous withdrawal of the designation of the United Kingdom took place after the publication of the application, so that the public had access to the file. The re-introduction of the United Kingdom would jeopardise the legal certainty on information obtainable from the European Patent Office.
- VII. The Appellant's representative filed an appeal against that decision, requesting that the cancellation of the request for withdrawal of the designation of the United Kingdom is granted.

#### Reasons for the Decision

1. The appeal complies with Articles 106-108 and Rule 64 EPC and is, therefore, admissible.

2. In his letter dated 16 December 1985 the representative stated "that the Applicants do not wish to pursue the British designation of this application and hence request that the British designation is irretrievably withdrawn". The wording of this statement, especially the use of the words "irretrievably withdrawn", shows that, on the face of the letter, the clear intention was to put an immediate end to the European application insofar as the United Kingdom is concerned.

The Appellant has submitted that the designation of the United Kingdom was not finally withdrawn, because no letter had been issued by the EPO stating that the designation is or is deemed to be withdrawn. However, in the Board's view a letter of withdrawal takes immediate effect when it is filed, and does not require any confirmation by the EPO. The fact that it is the usual practice of the EPO to confirm the withdrawal by a letter of acknowledgement does not affect the legal situation.

3. It is the main argument of the Applicants that, under Rule 88 EPC, it should be possible for them to correct the withdrawal of the designation of the United Kingdom so that all the originally designated States, including the United Kingdom, could be maintained.
4. The impugned decision refused the request for cancellation of the withdrawal of the designation of the United Kingdom on the ground that, because the erroneous withdrawal took place after the publication of the application, to take the action requested would introduce legal uncertainty because the public had access to the file. According to the Decisions J 12/80 (OJ EPO 1981, page 143) and J 21/84 (OJ EPO 1986, page 75), a correction of a designation under Rule 88 EPC would be acceptable only before publication of the application.

5. In Decision J 12/80 this Board was of the opinion that a correction is allowable when it was requested before but granted after the publication of the application. In that case, the original designation of Spain was replaced by Switzerland, although the application had been published without the designation of Switzerland.
6. In Decision J 21/84 the application was published without the designation of France, and the request for correction was filed some months after the publication. In this case, the Board held that a mistake in a designation of a Contracting State may be corrected in accordance with Rule 88 EPC only if a request has been made for correction sufficiently early for a warning that correction has been applied for to be included in the publication of the application so that third parties can rely on the application as published.
7. In Decision J 15/86 of 9 October 1987 ("Withdrawal of application/Ausonia") the Board had to decide on a retraction of withdrawal of a patent application which had already been notified to the public in the European Patent Bulletin. The Board held that in the public interest it was too late to ask for a retraction of a letter of withdrawal once withdrawal of the European patent application had been notified to the public in the European Patent Bulletin.
8. The Board wishes to state clearly that the cited case law is sound, because the public interest in being able to rely on information officially published by the European Patent Office must rank higher than the interest of a patent applicant wanting his erroneous statement already notified to the public to be ignored. In these cases, legal certainty must prevail.

9. But the case now before the Board should be distinguished from the above mentioned cases. In this case, the application was officially published with all originally designated States, including the United Kingdom, whereas the withdrawal of the designation of the United Kingdom was not officially published by the European Patent Office.
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.
11. Correction of a withdrawal in a file which is open to public inspection has the unavoidable risk that a third person who has inspected the file may have started to use the invention relying on the withdrawal (in this case, of the designation of the United Kingdom). The Appellant has stated that he has been informed by the EPO that in fact no request to examine the file was made between the withdrawal of the designation by letter dated 16 December 1985 and the retraction of that withdrawal by telex on 3 March 1986. However, the EPO has no obligation to keep a record when a file is inspected. The Board cannot, therefore, be certain that there was no inspection of the file by a third person during the relevant period. The Appellant draws attention in this respect to Section 78(5) and (6) of the British Patents Act 1977, and suggests that this provision applies to any right which is lost and reinstated under the European Patent Convention.

The interpretation of this provision is a matter for the United Kingdom courts and not for this Board; however, it seems possible that on its proper interpretation this provision only applies in cases of re-establishment pursuant to Article 122 EPC, and not in cases of correction under Rule 88 EPC. Nevertheless, the interest of such a person to continue to use the invention might be protected by a national court by applying Article 122(6) EPC mutatis mutandis. By that means a third person would be sufficiently protected (cf. Decision J 12/80, paragraph 9, OJ 1981, page 143).

12. In addition, it has to be taken into account that the requested correction to ignore the withdrawal of the designation of the United Kingdom is synonymous with a retraction of the withdrawal of the designation. Legal certainty demands that the European Patent Office can rely on statements of the parties in the proceedings. Otherwise the proceedings cannot be completed within a reasonable time. Therefore the Board feels that a requested correction which is synonymous with a retraction of a withdrawal should only be allowable with the proviso that restricted conditions are met.
  
13. In weighing up the interests of a third party and of the Applicant (see paragraph 11) and taking into account the requirement of a fair proceeding before the European Patent Office (see paragraph 12) the Board is of the opinion that under Rule 88 EPC a correction of a withdrawal of a designation which is synonymous with a total retraction of the withdrawal of the procedural act may be allowable if the following requirements are fulfilled:



- (i) at the time the retraction of the withdrawal is applied for the public has not been officially notified of the withdrawal by the EPO;
- (ii) the erroneous withdrawal of the designation of a Contracting State is due to an excusable oversight;
- (iii) there is no undue delay in seeking retraction;
- (iv) there is adequate protection of third persons if the correction is allowed.

14. The Board is satisfied that the requirements for a correction mentioned in paragraph 13 are met because:

- (i) the withdrawal of the designation of the United Kingdom was not published in the European Patent Bulletin. On the contrary, the European patent application was published on 22 February 1984 with all originally designated States, including the United Kingdom. The withdrawal of the designation of the United Kingdom was declared one year and ten months later by a letter dated 16 December 1985 which was placed on the file on 23 December 1985. Hence, a third party could only notice the valid withdrawal of the designation of the United Kingdom by inspection of the file between the time the 16 December 1985 letter was entered on the file and 3 March 1986 when the error was first drawn to the attention of the European Patent Office;
- (ii) the Board is satisfied that the erroneous withdrawal of the designation of the United Kingdom is due to an excusable oversight. The representatives of the Applicants confused two

applications, namely the application under appeal and a second case with the number 86 106 620.6, in both of which the grant formalities were being dealt with during the same time period. The letter withdrawing the designation of the United Kingdom, which was intended to be sent for application 82 106 620.6 was accidentally sent bearing the number 83 105 582.7. The error in both cases was noted at the same time. The request to withdraw the UK designation in the second case was refused by the European Patent Office because grant had taken effect from 17 January 1986. The confusion of the two applications was due to a mistake made by the secretary, who prepared the letter of 16 December 1985, without having been instructed to do so. Hence, the confusion of the two applications can be put down to a genuine and isolated human error;

- (iii) the request for retraction was made immediately when the representative became aware of the erroneous withdrawal. The situation was noticed on 3 March 1986 during a routine examination of the file. On the same day, the representative despatched a telex to the EPO requesting retraction of the withdrawal of the UK designation. A letter confirming the withdrawal of the designation, which could have informed the Appellant about his error earlier, was not sent by the EPO;
- (iv) in the opinion of the Board, there is no reasonable ground for holding that in the public interest the Appellant should be bound by his declaration of withdrawal of the designation. To the public in general the withdrawal was not known, because the EPO did not publish it in the European Patent Bulletin. Any individual persons who, having

inspected the file, relied on the declaration of withdrawal of the designation could be protected if a national court applied Article 122(6) EPC *mutatis mutandis* (see paragraph 11).

Furthermore, the concern of the EPO to carry out the proceedings within a reasonable time (see paragraph 12) is not prejudicially affected; the decision to allow the request for correction does not result in a substantial delay of the proceedings. Therefore, the Board is of the opinion that there is no obstacle to granting the requested correction in this case.

#### Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. Correction of the letter of 16 December 1985 is ordered so that the United Kingdom remains validly designated.

The Registrar:

The Chairman:

J. Ruckerl

P. Ford