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**D E C I S I O N**  
**of 10 March 1997**

**Case Number:** J 0029/94 - 3.1.1

**Application Number:** 93201692.6

**Publication Number:** 0588391

**IPC:** A47L 7/00

**Language of the proceedings:** EN

**Title of invention:**

Industrial machine for dust removal, washing and drying of car mats

**Applicant:**

González García, Luis Emilio

**Opponent:**

-

**Headword:**

Deemed withdrawal/GONZALEZ GARCIA

**Relevant legal provisions:**

EPC Art. 110, 121, 122

**Keyword:**

"Further processing' and re-establishment of rights

(no) - request out of time"

"Deemed withdrawal of the application (yes)"

**Decisions cited:**

G 0005/88, G 0010/92, J 0005/81, J 0007/82, J 0003/87,

J 0012/92, T 0111/92

**Headnote:**

Deemed withdrawal of the application pursuant to Article 110(3) EPC applies in the case of a failure to reply to a communication pursuant to Article 110(2) EPC in ex parte appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request.



Case Number: J 0029/94 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 10 March 1997

**Appellant:** González García, Luis Emilio  
Quintanal, 6  
E-39200 Reinosa (Cantabria) ES

**Representative:** Ungria Lopez, Javier  
Avenida Ramon y Cajal, 78  
E-28043 Madrid (ES)

**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 20 July 1994 refusing a request for correction in European patent application No. 93 201 692.6.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** R. E. Teschemacher  
S. C. Perryman

## Summary of Facts and Submissions

- I. European patent application No. 93 201 692.6 was filed on 11 June 1993 claiming priority of 12 June 1992. Four states were designated in Section 33 of the request for grant form.
- II. In a letter dated 14 October 1993, it was requested that Italy be added as a Contracting State on the basis of Rule 88 EPC. The Receiving Section issued a decision dated 20 July 1994 rejecting this request and two further related requests. The reason given was that the requirements for a correction under Rule 88 EPC were not fulfilled and that there was no legal basis for a late payment of the designation fee.
- III. The Applicant appealed against this decision, pursuing the request for correction. In a communication dated 8 June 1995, stating expressly that it was made pursuant to Article 110(2) EPC, the Appellant was informed that the correction seemed to be contrary to the case law according to which the omission to pay a designation fee cannot be corrected on the basis of Rule 88, first sentence, EPC. He was invited to file his observations on the communication within a period of two months. On the Appellant's request this period was extended by two months. Since no reply was received, the Appellant was informed in a communication dated 20 December 1995 that the application was deemed to be withdrawn under Article 110(3) EPC.
- IV. In a fax received on 1 March 1996, the Appellant requested further processing according to Article 121 EPC. At the same time he paid the relevant fee and replied to the communication pursuant to Article 110(2)

EPC, requesting that the correction of the designation be allowed, and in the alternative that the application be prosecuted without the designation of Italy.

V. In a further communication, dated 21 March 1996, the Appellant was informed that it was to be envisaged that the request for further processing would be treated as inadmissible, since it had been received out of time. In his observations received on 1 July 1996, the Appellant requested restitutio in integrum in respect of the time limit for requesting further processing. He submitted that the request for re-establishment was filed within the time limit under Article 122(2) EPC because the cause of non-compliance with the time limit had not been removed until the end of the extended time limit for filing observations. Alternatively, he submitted that he could still withdraw the appeal with the effect that the decision under appeal would become final and the application could proceed for the designated states except Italy.

VI. In a third communication, dated 22 July 1996, the Appellant was informed that the time limit in Article 122(2) EPC was an unextendable time limit under the Convention and that a withdrawal of the appeal could not remove the legal effect which had arisen under Article 110(3) EPC. In his observations the Appellant additionally relied on decision T 111/92, dated 3 August 1992 (not published), arguing that the loss of the application was not an appropriate sanction for a procedural omission caused by a mistake in calculating the ten-day period in Rule 78(3) EPC. Furthermore, he alleged that the course of action taken by the Board created legitimate expectations that the requests for further processing and re-establishment of rights could still be accepted.

He requested that the decision under appeal be set aside, and

- he be re-established into the period for requesting further processing of the application, and that Italy be added to the designated Contracting States by way of correction
  - main request,
  
- the application be treated as still pending and that the Board permit withdrawal of the appeal so that the application can be further processed without the designation of Italy
  - first auxiliary request,
  
- the request for further processing be held admissible on the basis of the principle of legitimate expectations
  - second auxiliary request,
  
- a separate appealable decision be given on any of the preceding requests and the loss of rights be suspended until a final decision on this request is given
  - third auxiliary request,
  
- an interlocutory decision be given providing the provisional findings of the Board and that oral proceedings be held before a final negative decision is given
  - fourth auxiliary request.

VII. With the summons to the oral proceedings, the Appellant was informed that his reference to decision T 111/92 (above) seemed not to be of relevance to this case since the considerations referred to related to the question whether an admissible request for restitutio in integrum should be allowed whereas in the present

case such a request had not been filed within the time limit prescribed in Article 122(2) EPC. Furthermore, a copy of the Minutes of the Proceedings of Main Committee I of the Munich Diplomatic Conference for the Setting up of a European System for the Grant of Patents, relating to the discussion of Article 110(3) EPC (Doc. M/PR/I, points 471-507), was sent to the Appellant shortly before the oral proceedings.

VIII. In the oral proceedings, held on 10 March 1997, the Appellant concentrated on the question whether or not Article 110(3) EPC was applicable to this case.

He argued that the loss of the application under this provision could arise only if the refusal of the application had been at issue in first instance. In the present case, the Receiving Section had only noted a loss of rights in respect of the designation of Italy. The subsequent decision did not concern the application as a whole. In his view, this procedure is different from the procedure before the Examining Division where the request to grant the patent in a form which is not allowed entails the refusal of the application. If the application as a whole was not the subject of the decision at first instance, the loss of the whole application as the legal consequence of a procedural negligence in appeal proceedings would be an inappropriate sanction.

IX. In addition, the Appellant submitted that the communication dated 8 June 1995 was not a communication under Article 110(2) EPC. As to the substance of the letter, the Appellant was only informed of a preliminary opinion of the Board. A reply was neither necessary nor asked for. The German version of the cover page (Form 3206) showed clearly that there was no obligation for the Appellant to reply since the wording "Sie werden gebeten ..." would merely be understood as

giving the Appellant an opportunity to comment if he wished to do so, and not as requiring a response in any event.

X. In addition to his previous written requests, the Appellant requested

- to refer to the Enlarged Board of Appeal the following questions in order to ensure a uniform application of the law in respect of an important point of law, prior to coming to any decision that the application was deemed to be withdrawn:

1. Is Article 110(3) EPC to be applied also on appeals from decisions of eg the Receiving Section, which do not relate to the application itself but to a side question, ie whether a Contracting State has been designated or not?

2. Does EPO Form 3206 qualify as an invitation in the sense of Article 110 EPC, if only accompanied by a mere statement of the Appeal Board, and with the German wording "Sie werden **gebeten** ..." instead of the term "Sie werden **aufgefordert** ..." as mentioned in the German version of Article 110(3) and Article 96 EPC and as also employed in EPO Form 2001?

- fifth auxiliary request.

### Reasons for the Decision

1. The Appellant's failure to reply in due time to the communication pursuant to Article 110(2) EPC had the legal consequence that the application was deemed to be withdrawn (Article 110(3) EPC).

1.1 The Board cannot agree with the Appellant's position that the letter dated 8 June 1995 was not a communication under Article 110(2). Neither the communication's substance nor its form gives rise to any doubts in this respect.

1.1.1 The communication was clearly indicated in the language of the proceedings as "Communication pursuant to Article 110(2) EPC" in bold type in the heading of the cover page. In addition, the wording of the invitation addressed to the Appellant in the cover page corresponds verbatim to the wording of Article 110(2) EPC. This form leaves no room for any misunderstanding by the recipient. The Appellant's reference to the German wording "Sie werden gebeten ..." does not help his case. It is true that this wording differs from the wording in Article 110(2) EPC (... "fordert auf" ...). Nevertheless, the indication as "Mitteilung nach Artikel 110(2)" makes it clear also in this language, which is not the language of the proceedings, that the communication is merely using a more polite wording than the provision of the EPC.

1.1.2 The Board agrees with the Appellant that the communication did not require a reply to any specific question. This is, however, not unusual for a communication. Communications from the EPO may ask the party to remedy a deficiency or may ask for specific information. However, they also serve to give a party an opportunity to reconsider its case or to argue against the preliminary opinion expressed by the Board. At any rate, communications are necessary under Article 113(1) EPC to make sure that a later decision is only based on grounds or evidence on which the party concerned has had an opportunity to comment. If an applicant, having taken note of a communication under Article 110(2) EPC, is no longer interested in



pursuing the application, he may simply abstain from commenting. This has the effect that the application is deemed withdrawn without the need to give a decision. If the applicant does not want to reply in substance but wants to pursue the application he may ask for a decision on the file as it stands.

1.1.3 It should be added that the Appellant has never alleged that he was actually misled by the communication or that he believed that a reaction was not necessary.

1.2 Nor can the Board share the Appellant's view that deemed withdrawal under Article 110(3) is an inappropriate sanction if a decision of the Receiving Section concerning the validity of a designation is under appeal.

1.2.1 Since the Board is bound by the Convention the Board could consider a deviation from the clear wording of a provision of the Convention only if the provision is in breach of a higher legal principle or is purely arbitrary (G 10/92, OJ EPO 1994, 633, Reasons 9). The Appellant did not contest that Article 110(3), on the basis of its plain wording, is applicable to this case.

A higher principle, requiring a deviation from this provision, could be that the application was not pending before the Board and could, therefore, not be deemed withdrawn in appeal proceedings. In respect of this question, the principle of unity of the application and of the patent in the proceedings (see Article 118 EPC) has to be kept in mind. According to this principle, a decision on the application can only be taken on the application as a whole. If the territorial scope for which the patent is to be granted is contested and this question becomes the

subject of an appeal, the suspensive effect of the appeal (Article 106(1), second sentence, EPC) affects the application as a whole. In consequence of the appeal in this case the first instance lost its competence for the further prosecution of the application for all Contracting States. The first instance would not have been entitled to proceed with the application and to grant the patent for all the other Contracting States except Italy because this would have violated the principle of unity of the application in the proceedings. Furthermore, the EPO is limited to considering the requests of the Applicant (Article 113(2) EPC) and is not entitled to grant a patent deviating from these requests. This applies not only to the text of the patent but to all details which determine the legal effects of the patent. These comprise in particular the Contracting States for which the patent is to be granted (see Article 64(1) EPC). Hence, the appeal did not leave a part of the application pending in the first instance, and deemed withdrawal is not a legal consequence outside the scope of these appeal proceedings.

- 1.2.2 The Appellant's submission that the loss of the application is an inappropriate sanction in this case does not convince the Board.
- 1.2.2.1 In different situations the EPC specifies deemed withdrawal as the consequence resulting from an omission by the applicant in prosecuting the application. This unquestionably serves the interest of a streamlined procedure. The omissions may concern substantive questions (eg objections to patentability) or formal questions (eg payment of fees, formal requirements concerning the presentation of the application). The common factor is that a requirement for the grant of the patent in its requested form or for the continuation of the procedure as a whole has

not been fulfilled. Deemed withdrawal is, however, not foreseen for all situations in which the applicant does not perform a prescribed act or respond to an office action. Whereas the failure to reply to a communication from the Examining Division results in the deemed withdrawal of the application (Article 96(3) EPC), a failure to respond to a communication from the Receiving Section normally does not. Rather the application has to be refused by the Receiving Section on the basis of the deficiency objected to in the communication (Article 91(3), first half-sentence, EPC; for exceptions see eg Article 91(5) EPC).

- 1.2.2.2 For ex parte appeal proceedings the legislator has chosen to provide in Article 110(3) EPC the same mechanism as for the proceedings before the Examining Division. Hence, the deemed withdrawal of the application is specifically provided for all ex parte appeal proceedings even though it was not applicable in the proceedings before the Receiving Section. Nor does Article 110(3) EPC make a distinction in respect of the kind of decision under appeal. In the present case, this has the consequence that deemed withdrawal can arise in appeal proceedings, even though the continuance of the application in some other form was envisaged in the contested decision.
- 1.2.2.3 This legal situation is not due to the fact that the legislator has overlooked procedural situations such as the present one. It becomes clear from the legislative history that, when drafting Article 110(3) EPC, it was not intended to make a difference between different types of decisions of the Receiving Section or the Examining Division. According to Article 109(3) (now Article 110(3) EPC) of the draft presented to the Munich Diplomatic Conference (Conference Doc. M/1), Article 95(3) of the draft (now Article 96(3) EPC) was

to be applied *mutatis mutandis*. The meaning of this draft provision was understood differently by the delegations. Whereas the Austrian delegation took the provision to mean that only the appeal, and not the whole application, would be deemed withdrawn, it was the understanding of the Netherlands delegation that the legal consequence was the withdrawal of the application (Minutes of Main Committee I, above, points 472 and 474). Taking account of the ensuing discussion in Main Committee I, the Drafting Committee submitted the following proposal (Minutes, above, point 499):

- "If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn."

This text was already identical to the present text of Article 110(3) EPC, except that the proviso concerning decisions of the Legal Division did not yet appear. After discussion, the Committee agreed with the Austrian delegation that the deemed withdrawal should not arise in appeals against decisions of the Legal Division (concerning transfers of rights). Although the Chairman had earlier summarised the Committee's view that the provision should be restricted to appeals in the proceedings for grant which related to the application (Minutes, above, point 498), the Austrian delegation received no majority support for their proposal to specify in the provision that the appeal had to be "against a decision of the Receiving Section or the Examining Division in the proceedings for grant" (Minutes, above, point 501). Other delegations took the view that it would be exceedingly difficult to draft paragraph 3 so as to cover all appeals against decisions in the proceedings for grant, and to exclude appeals against other decisions. In view of the applicant's right to request further

processing of an application deemed to be withdrawn, no need was seen for a detailed enumeration of the appeals to which paragraph 3 would not apply (Minutes, above, point 503). Therefore, only the proviso concerning decisions of the Legal Division was added and for the rest the draft remained unchanged. The text of the provision as it now stands was approved by all delegations but one (Minutes, above, point 507).

- 1.2.2.4 Furthermore, deemed withdrawal cannot be considered an arbitrary provision. The decision under appeal concerned the designation of Italy, hence the territorial scope of the patent to be granted. The validity of a designation is part of the grant procedure since the decision to grant has to identify the states for which the patent is granted. The legislator treated the lack of a reply to a communication in appeal proceedings as a failure to prosecute the application, which failure justified deemed withdrawal being the consequence. Since the appeal proceedings concerning an interlocutory decision under Article 106(3) EPC serve the purpose of settling a question relevant to the further grant procedure, the Board cannot regard the purpose behind the provision as arbitrary, even in a case such as the present one, particularly considering the fact that the same means of redress are available as in proceedings before the Examining Division, of which means of redress the Appellant could have made appropriate use (see below, points 2 and 3).

There might be situations where the appeal is concerned with a question which is quite separate from the grant procedure (eg the refund of a fee), in which the above reasons would not apply. Since the Board is not faced with such a case this problem needs no further discussion here.

2. The Appellant had the opportunity to have the deemed withdrawal under Article 110(3) EPC rescinded by a valid request for further processing (Article 121(1) EPC).

According to Article 121(2) EPC such request is to be filed within two months of the date on which the communication that the application is deemed to be withdrawn was notified. In the present case the communication was posted on 20 December 1995 and notified by registered letter with advice of delivery. According to Rule 78(3) EPC the notification was deemed to be delivered on 30 December 1995. Therefore, the time limit of two months expired on 29 February 1996 (Rule 83(4) EPC). Hence, the request for further processing received on 1 March 1996 was not filed in due time and is inadmissible.

3. Even after the failure to observe the time limit for requesting further processing, the Appellant was in a position to avoid the final loss of the application if the omission had occurred despite all due care having been taken since re-establishment of rights under Article 122 EPC was still available (J 12/92, not published, cited in Case Law of the Boards of Appeal of the EPO, 2nd ed., 1996, p. 211). A request for re-establishment has to be filed within two months from the removal of the cause of non-compliance with the time limit for requesting further processing (Article 122(2), first sentence, EPC). The Appellant was fixed with knowledge that his request for further processing was out of time at the latest when he actually received the communication from the EPO dated 21 March 1996 (J 7/82, OJ EPO 1982, 391, Reasons 3 and 4). Assuming, in favour of the Appellant, that he did not receive the communication before the tenth day following its posting (Rule 78(3)

EPC), this latest date is 31 March 1996. The Appellant should have been in a position to complete the omitted act within two months of that date. The request for re-establishment received on 1 July 1996 was, therefore, out of time.

4. The Appellant has invoked the principle of protection of legitimate expectations in order to justify his omission to request further processing and re-establishment of rights in due time. This principle, which is generally accepted within the jurisprudence of the Boards of Appeal (G 5/88, OJ EPO 1991, 137, Reasons 3.2), is to the effect that an applicant should not suffer a disadvantage as a result of having relied on a misleading communication from the EPO (J 3/87, OJ EPO 1989, 3). The Appellant has, however, not shown that the omission to take appropriate action was the consequence of any information from the EPO.

- 4.1 In respect of the time limit for requesting further processing, he alleges that the Board's communication making him aware of the late request and the further communications and extensions of time limits gave the impression that the admissibility of the late request was still an open question. Otherwise, there would be no sense in the Board inviting him repeatedly to file observations by a stated time limit or granting extensions of time at his request.

This submission is based on a fundamental misunderstanding of the proceedings before the EPO. A communication in no way implies that a party's previous requests might still be allowable. Article 113(1) EPC provides that decisions may only be based on grounds or evidence on which the party concerned has had an opportunity to present its comments. Thus, it was necessary pursuant to

Article 113(1) EPC to inform the Appellant of the deficiency of the request for further processing and of the reasons why his further requests could not be allowed. Furthermore, the Appellant was entitled to have time limits extended under Rule 84 EPC, irrespective of the question of whether his case still seemed promising or not. The conduct of proceedings by the Board did not cause the failure to meet the time limit for requesting further processing which resulted in the loss of rights, since this failure occurred before the Appellant received the further communications from the Board.

- 4.2. In respect of the time limit for requesting re-establishment the Appellant argues similarly. In his view, the communication informing him of the late request for further processing gave an impression that the appeal proceedings were still pending and that any action necessary to revive the application could still be taken. It was submitted that the cause of non-compliance within the meaning of Article 122(2), first sentence, EPC was removed, at the earliest, at the end of the extended time limit for reply, ie on 5 June 1996. This is not so.

The reasons indicated in 4.1 apply here *mutatis mutandis*. The date of removal of the cause of non-compliance with the missed time limit is not fixed at the discretion of the EPO, but has to be assessed according to the facts of the case. According to these, the Appellant was in a position to complete the omitted act as soon as he had received the communication dated 21 March 1996 informing him of the omission (see above, point 3).



The extension of the time limit for filing observations could not be understood to mean that the time limit for requesting re-establishment was extended. The extension did not refer to such a request and the Appellant had not announced that he intended to file such a request. An Appellant using the services of an authorised representative must be deemed to know that only time limits determined by the EPO can be extended under Rule 84 EPC and that this does not include the time limits under Article 122 EPC relating to re-establishment. Whatever actual impression the Appellant or his representative was under, the grant of an extension did not occasion the failure to request re-establishment in due time, since the extension itself was not requested until 21.10 hrs on the last day of the time limit pursuant to Article 122(2), first sentence, EPC, ie on the last day on which the request for re-establishment could have been filed.

5. Nor can the Appellant's auxiliary request to allow the withdrawal of the appeal and to prosecute this application without the designation of Italy be allowed. Deemed withdrawal as the legal consequence of the failure to reply to a communication pursuant to Article 110(2) EPC is laid down in Article 110(3) EPC, and serves the purpose of avoiding inappropriate delays in the prosecution of applications (see above, 1.2.2). The deemed withdrawal took place in October 1995. The Appellant failed to take the steps provided by the Convention for having the deemed withdrawal rescinded. In these circumstances, it is not within the discretion of the Board to permit a retroactive withdrawal of the appeal in order to avoid a consequence intended by the Convention.

6. In respect of his requests to have two questions referred to the Enlarged Board of Appeal, the Appellant has been unable to indicate any case law inconsistent with the conclusions reached by this Board. Therefore, the Board sees no reason to refer the questions in order to ensure uniform application of the law. The Board has no doubt about the answers provided by the Convention to the questions put by the Appellant (for question 1 see Reasons 1.2, for question 2 see Reasons 1.1). Furthermore, the Board considers that cases in which an application is lost in this manner will occur only extremely infrequently, so that the numbers of those that might be negatively affected provides no reason for a referral. Hence, the referral is not justified, because no important point of law arises or needs to be clarified (J 5/81, OJ EPO 1982, 155).
  
7. With his third and fourth auxiliary requests, the Appellant asked for further intermediate action of the Board before a final decision is given. The Appellant was informed in several communications of the Board's preliminary views and had the opportunity to argue his case in every respect in writing and in oral proceedings. A further delay is, therefore, not justified.

**Order**

**For these reasons it is decided that:**

1. The Appellant's requests are rejected.
2. The application is deemed to be withdrawn.

The Registrar:



M. Beer

The Chairman:



J. C. Saisset

Te 75-77  
R.P.