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D E C I S I O N
of 9 July 1997

Case Number: J 0004/97 - 3.1.1

Application Number: 92309736.4

Publication Number: 0593829

Language of the proceedings: EN

Title of invention:
Toner and developer compositions with compatibilizer

Applicant:
XEROX CORPORATION

Opponent:
-

Headword:
Retraction of withdrawal/XEROX

Relevant legal provisions:
EPC Art. 117
EPC R. 88

Keyword:
"Withdrawal of patent application"
"Retraction of withdrawal"
"Correction of errors in documents"

Decisions cited:
J 0012/80, J 0015/86, J 0010/87, T 0482/89

Catchword:
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Boards of Appeal

Chambres de recours

Case Number: J 0004/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 July 1997

Appellant: XEROX CORPORATION
Xerox Square
Rochester
New York 14644 (US)

Representative: Pike, Christopher Gerard
Rank Xerox Ltd., Patent Department
Parkway
Marlow, Buckinghamshire SL7 1YL (GB)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 3 December 1996
rejecting the request to cancel the withdrawal of
European patent application No. 92 309 736.4.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. Schachenmann
A. Lindqvist

Summary of Facts and Submissions

- I. On 30 May 1996 the Examining Division of the European Patent Office issued a first communication pursuant to Article 96(2) EPC in connection with European patent application No. 92 309 736.4. The claims on file were objected to due to lack of novelty and lack of clarity. The applicants were invited to correct the deficiencies within a period of four months.
- II. By letter dated 3 September 1996 and filed on 9 September 1996 the applicants (appellants) informed the EPO of a change of representative and asked for a corresponding update of the records of the EPO. The letter ended with the statement: "I hereby request that the above application be withdrawn". It was signed by the new representative, an employee of the applicants, whose name appears on the list of professional representatives.
- III. On 12 September 1996 the applicants informed the EPO by telephone and by facsimile letter that their request for withdrawal was erroneously made and should be cancelled.
- IV. In a communication dated 27 September 1996 the EPO notified the applicants that the withdrawal had come into force on receipt of the notice of withdrawal which, according to the Legal Advice 8/80 (OJ EPO 1981, 6), was binding upon them. Only in exceptional circumstances as set out in the decision J 10/87 (OJ EPO 1989, 323) a withdrawal made by error could be corrected. On the other hand, a change of mind or a change of decision by the applicants would not justify such correction. The applicants' request could not,

therefore, be granted. Finally, the EPO drew the applicants' attention to the fact that they could apply for an appealable decision within two months after notification of the communication.

- V. By letter filed on 5 November 1996 the applicants formally applied for such a decision without, however, putting forward any argument or evidence in support of their case.
- VI. On 6 November 1996 a notification was published in the European Patent Bulletin No 45/1996 according to which the application referred to above was withdrawn on 9 September 1996.
- VII. By decision dated 3 December 1996 the Examining Division refused the applicants' request to cancel the notice of withdrawal. In the reasons for the decision it was pointed out that the applicants had never produced any evidence in support of their allegation that the withdrawal of the application was erroneously made.
- VIII. The present appeal lies from that decision, the notice and the grounds of appeal having been filed on 24 January 1997.

In their grounds of appeal the appellants referred to the decision J 10/87 arguing that, in the circumstances of the present case, retraction of the withdrawal should be allowed for the same reasons. In particular, the withdrawal was clearly erroneous since it resulted from a confusion between two cases having similar reference numbers. The mistake was of a type which, according to the established case law, should be deemed to be excusable. It was due to this confusion that the US patent attorney informed the European representative that the application in question was "not ... of

commercial interest at this time" (although it was on a list of important patent cases). Contrary to the expectations of the US patent attorney, the information mentioned above was understood as an instruction to withdraw the patent application. However, immediately upon receipt of a copy of the withdrawal letter to the EPO, the US patent attorney realized the error, so that the withdrawal could be retracted already three days after the filing of the notice of withdrawal, i.e. a long time before the public was officially notified thereof. In support of their arguments the appellants submitted a Statutory Declaration signed by the European representative confirming the facts referred to above.

Accordingly, the appellants requested that the retraction of the withdrawal should be allowed. They further requested that examination of their patent application be continued.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and with Rule 1(1) and 64(b) EPC and is therefore admissible.

2. The appellants do not contest that the letter dated 3 September 1996 contained a clear statement requesting withdrawal of their patent application. It is also uncontested that such withdrawal is in principle binding (see Legal Advice by the EPO No. 8/80, OJ EPO 1981, 6). However, the appellants argue that the request for withdrawal was made in error and should be cancelled for this reason.

The issue to be considered is therefore whether or not the appellants' letter dated 3 September 1996 can be corrected under Rule 88 EPC to the effect that their request for withdrawal of the patent application is cancelled.

3. In the proceedings before the first instance this issue was considered on the basis of the jurisprudence of the Boards of Appeal, in particular decision J 10/87 (OJ EPO 1989, 323). Accordingly, the Examining Division acknowledged that in exceptional cases a withdrawal by error could be corrected pursuant to Rule 88 EPC. However, it rejected the appellants' request on the ground that no evidence was produced to the effect that the withdrawal was indeed made in error.
4. The Board has no cause to deviate from the decision referred to above allowing, in appropriate circumstances, retraction of a withdrawal of a designation of a Contracting State. In the Board's view the legal considerations contained in that decision equally apply to the withdrawal of a patent application as a whole. Thus, it remains to be examined whether, in the circumstances of the present case, the conditions for allowing the retraction of a withdrawal detailed in that decision are complied with. In particular, it has to be ascertained that the withdrawal was due to an excusable error and that the retraction of the withdrawal did not adversely affect the public interest or the interest of third parties.
5. Together with the grounds of appeal the appellants filed a detailed statement of facts in the form of a Statutory Declaration made by the European representative under the United Kingdom law. This Declaration can be considered as a sworn statement in

writing within the meaning of Article 117(1)(g) EPC. However, as the Convention does not contain any indication of the probative value of such a document the principle of free evaluation of evidence applies (see T 482/89, OJ EPO 1992, 646).

In the circumstances of the present case, the Board sees no reason to question the accuracy of the statements made in the name of the appellants or contained in the representative's Statutory Declaration showing that the withdrawal was due to an excusable error. The fact alone that the withdrawal was retracted already after three days is a strong indication that it had indeed been made in error. As the appellants credibly submitted the error resulted from a confusion between two similar reference numbers assigned by the appellants to their patent applications. In the Board's opinion this mistake can be considered as an excusable oversight.

6. As concerns the public interest, the relevant criterion developed by the jurisprudence of the Boards of Appeal is that the public has not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal is applied for (J 10/87, supra; J 15/86, OJ EPO 1988, 417).

In the circumstances of the present case, the withdrawal was retracted on 12 September 1996, i.e. before the corresponding entry was made in the Register of European Patents on 18 September 1996 and more than 6 weeks before the withdrawal was officially notified to the public in the European Patent Bulletin on 6 November 1996. Thus, at the time the general public

was informed of the withdrawal, the public part of the file clearly showed that a request for the cancellation of the withdrawal had been filed thereby warning third parties of relying on the information published by the EPO.

7. Finally, it has to be considered whether the interest of third parties who may possibly have taken notice of the withdrawal by inspection of the file are adequately protected.

The notice of withdrawal was filed on 9 September 1996 and the facsimile letter cancelling the withdrawal arrived at the Office on 12 September 1996. However, it appears that the notice of withdrawal was not incorporated into the file until 11 September 1996, i.e. one day before the facsimile letter arrived at the EPO. Although it cannot be completely excluded that a third party inspecting the file on that very day might have relied on the notice of withdrawal, the Board is satisfied that in such a very unlikely case the third party could be protected if a national court applied Article 122(6) EPC *mutatis mutandis* (see decisions J 10/87, *supra*, point 11; J 12/80, OJ EPO 1981, 143).

8. The Board therefore comes to the conclusion that in the circumstances of the present case the conditions developed by the jurisprudence of the Boards of Appeal for allowing the correction of a document containing an erroneous notice of withdrawal are complied with.

Order

For these reasons it is decided that:

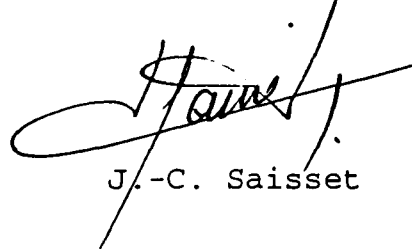
1. The decision under appeal is set aside.
2. Correction of the letter dated 3 September 1996 is ordered so that the withdrawal of the European patent application No. 92 309 736.4 is cancelled.
3. The case is remitted to the Examining Division for further prosecution.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

B.Sch.

1850.D

A. Lgt