BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [X] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen
(D) [ ] No distribution

D E C I S I O N
of 24 March 2003

Case Number: T 0824/00 - 3.5.2

Application Number: 88400267.6

Publication Number: 0281444

IPC: H01B 12/00

Language of the proceedings: EN

Title of invention:
Process for manufacturing a superconducting wire of compound oxide-type ceramic

Patentee:
SUMITOMO ELECTRIC INDUSTRIES LIMITED

Opponent:
I. VACUUMSCHMELZE GMBH, Hanau
II. Siemens AG

Headword:
Retraction of withdrawal of request/SUMITOMO

Relevant legal provisions:
EPC Art. 107, 113(2)
EPC R. 65(1), 88

Keyword:
"Withdrawal of all requests before the opposition division"
"Retraction of withdrawal on appeal by way of Rule 88 EPC correction - (not allowed; appeal inadmissible)"

Decisions cited:
J 0010/87, J 0006/91, J 0016/91, J 0010/93, J 0004/97, J 0003/01

Headnote:

I. A request under Rule 88 EPC for correction of a document filed at the EPO, the effect of which correction would be materially to breach principles representing the fundamental value of legal procedural certainty, should not normally be allowed. One such principle is that a competent first instance department of the EPO is empowered under Article 113(2) EPC to take a decision which terminates the first instance procedure on the basis of the ostensible final requests of the parties; a second such principle is that a party is not to be regarded as adversely affected within the meaning of Article 107 EPC by such a decision which grants his final request. (Reasons 6).

II. The statement in J 10/87 (OJ EPO 1989, 323) at point 12 of the reasons: "Legal certainty demands that the EPO can rely on statements of the parties in proceedings" pinpoints the precise procedural stage at which certainty prevails over intention and Rule 88 EPC reaches the limit of its applicability, viz when a party statement is relied on in a formal juridical act. (Reasons 8).

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0824/00 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 24 March 2003

Appellant: (Proprietor of the patent)
SUMITOMO ELECTRIC INDUSTRIES LIMITED
No. 15, Kitahama 5-chome
Higashi-ku
Osaka-shi
Osaka 541 (JP)

Representative:
Hirsch, Marc-Roger
Cabinet Hirsch
34 rue de Bassano
F-75008 Paris (FR)

Respondent: (Opponent I)
VACUUMSCHMELZE GMBH, Hanau
-Bereich Verträge und Patente-
Grüner Weg 37
Postfach 2253
D-63412 Hanau (DE)

Representative:
Schmuckermaier, Bernhard
PAe Westphal, Mussgnug & Partner
Mozartstrasse 8
D-80336 München (DE)

(Opponent II)
Siemens AG
Postfach 22 16 34
D-80506 München (DE)

Representative:
-

Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 29 May 2000 revoking European patent No. 0 281 444 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

I. This is an appeal against the revocation of European patent 281 444 by a decision of the opposition division posted 29 May 2000.

II. The reason given for the revocation was that by a letter dated 13 April 2000 the proprietor had withdrawn all requests so that there was no text agreed by the proprietor on the basis of which the patent could be maintained.

III. This is the second time that the opposed patent has come before Technical Board of Appeal 3.5.2. The first occasion was after the opposition division had issued its decision, posted 29 April 1996, proposing to maintain the patent in amended form in accordance with the proprietor's main request filed in oral proceedings on 22 March 1996. In its decision T 503/96, the board (in a composition different to that of the present board) remitted the case to the opposition division for further prosecution.

IV. In the present appeal, the appellant proprietor requests correction under Rule 88 EPC of the letter of 13 April 2000, namely that that letter be disregarded; and that the decision under appeal be set aside and that the case be remitted to the opposition division for further prosecution.

The respondent opponents request that the request for correction under Rule 88 EPC be refused and the appeal be dismissed.

V. Oral proceedings were held before the board on

28 February 2003.

VI. The appellant proprietor argued essentially as follows:

Under the EPC, opposition proceedings commenced with the filing of the notice of opposition and, if an appeal was filed, lasted until a final decision had been issued by a board of appeal. The opposition division's decision merely closed the phase before the opposition division.

The present appeal was filed in writing within two months after the date of notification of the decision appealed from and the fee for the appeal had been duly paid. Thus the appeal had been filed in accordance with the first two sentences of Article 108 EPC. A statement of grounds of appeal was filed in time in accordance with the third sentence of Article 108 EPC. Therefore the appeal must be presumed to be admissible until the board ruled otherwise. According to the second sentence of Article 106 EPC, the appeal had suspensive effect.

The appellant had been adversely affected by the decision under appeal. The letter of 13 April 2000 did not express the true intention of the proprietor. The withdrawal of all requests was an incorrect statement and therefore a correctable mistake had been made in the sense of decision J 6/91 (OJ EPO 1994, 349), point 3(1) of the reasons. A request under Rule 88 EPC for correction of the mistake was filed simultaneously with the grounds of appeal, with enclosures showing that the proprietor's true intention was not to abandon the patent entirely, but only for some of the designated states (see Enclosures 1, 2 and 6). Due to a misunderstanding in Japan, wrong instructions were sent

to the European representative (see Enclosure 3), who carried them out (see Enclosures 4 and 5). As shown on the "Rückschein", the European representative received the decision under appeal on 2 June 2000, not on 7 June 2000 as erroneously stated in the request for correction filed with the statement of grounds of appeal. He first became aware of the mistake on 6 June 2000 when he received the letter from his Japanese colleague (Enclosure 6).

The inconvenience caused to the opponents was regretted, but they were not entitled to rely on the finality of the opposition division's decision before the time limit for filing an appeal had expired. That decision had not been published so third parties would not be adversely affected by the requested correction, see decision J 4/97 of 9 July 1997 (not published in OJ EPO), points 6 and 7 of the reasons.

The present case concerned an appealable decision, which had been shown to have been based on incorrect facts, in contrast with the situation decided upon in J 3/01 of 17 June 2002 (not published in OJ EPO), which concerned a loss of a right excluded from re-establishment under Article 122(5) EPC. If the correction were allowed and the letter of 13 April 2000 were disregarded, that in itself would not void the opposition division's decision retrospectively, it would merely provide the reason for the board to set that decision aside without changing the past, as its effects had been suspended by the appeal.

The appeal and the request for correction under Rule 88 EPC had to be considered together by the board, by analogy with the situation in decision J 10/93 (OJ

EPO, 1997, 91) relating to simultaneous transfer and *restitutio in integrum*.

VII. The respondent opponents argued essentially as follows:

Even if a mistake had occurred - and the evidence on this did not meet the high standard that the established jurisprudence of the EPO Boards of Appeal required - granting the Rule 88 EPC request would be anomalous because it would effectively grant *restitutio in integrum* in a situation where it was not available under Article 122 EPC; cf J 16/91 (OJ EPO 1994, 28) at 3.3 " There can be no restitution of rights in relation to a decision." In the present case the proprietor was not adversely affected, so no admissible appeal was possible either. The decision of the opposition division could not be faulted and hence the board of appeal had no power to set it aside. Neither could Rule 88 EPC be applied to set aside a decision of the department of first instance. The proprietor had an opportunity to correct his mistake under Rule 88 EPC up to the moment when the opposition division issued the decision but not after that.

A third party inspecting the file would have been entitled to regard the decision as final since no party had been adversely affected. In fact the opponents were prepared to offer evidence that the firm Tritor, a potential user of the technology, had been informed by them that the patent had been definitively revoked. By the same token the opponents themselves in their capacity as members of the public were aware of the decision under appeal and the proprietor's letter of 13 April 2000 to the opposition division withdrawing all requests. They were entitled to conclude that there

were no possible grounds for appeal.

The appellant proprietor and requester had made use of the full two-month period for appeal before filing the Rule 88 EPC request for correction. This was not in accord with the standard of promptness required by the established jurisprudence of the EPO Boards of Appeal and had created an unnecessarily and unreasonably long period during which third parties were or could have been misled about the status of the patent. The fact that Rule 88 EPC made no provisions for protecting third parties in this situation showed that it was inapplicable.

In J 10/93, cited by the appellant proprietor, the appellant applicant was adversely affected by the decision made by the legal division which decision was therefore appealable. In the event the Legal Board of Appeal found that the legal division had made a mistake in law and therefore set the decision under appeal aside. In the present case there was no adverse effect and the opposition division had uncontestedly made no mistake; it had taken the only decision open to it under the EPC. Hence no admissible and well-founded appeal could be filed and the board had accordingly no power to set the decision under appeal aside.

Reasons for the Decision

1. The notice of appeal was filed and the fee for the appeal paid within two months after the date of notification of the decision appealed from. The statement of grounds of appeal and the request under Rule 88 EPC for correction of the mistake were filed at

the same time. There is no doubt that the appeal meets the requirements of Article 108 EPC.

2. However, in order to be admissible, the appeal must meet **all** the requirements mentioned in Rule 65(1) EPC, one of which is that the appellant was adversely affected by the decision under appeal, as prescribed by Article 107 EPC.

3. *Prima facie*, the appellant does not appear to be adversely affected by the decision under appeal. The proprietor's letter of 13 April 2000 to the opposition division stated: "The patentee in the present case has no more interest in the proceedings. We thus withdraw our request for oral proceedings as well as all other requests." The opposition division therefore did not refuse any existing request of any of the parties when it issued its decision revoking the patent, giving as the reason that with the letter of 13 April 2000 the proprietor had withdrawn all requests so that there was no text agreed by the proprietor on the basis of which the patent could be maintained. For the sake of completeness, it may be noted that the proprietor no longer agreed the text of the granted form of the patent, since, during the oral proceedings on 22 March 1996 his main request was for maintenance of the patent in amended form (cf point III above).

4. Although the appellant proprietor does not appear to be adversely affected by the decision under appeal, he contends that the letter of 13 April 2000 contains a mistake, namely the withdrawal of all requests, and that correction of the mistake should be allowed under the first sentence of Rule 88 EPC, that is, the letter should be disregarded as not representing the

proprietor's true intention. Then it could be seen that the appellant was adversely affected by the decision and the appeal would be admissible.

5. It follows that, in the circumstances of this case as set out above, the appeal is admissible if and only if the requested correction is allowable under Rule 88 EPC. Since, as far as the board is aware, this is the first time that a Rule 88 EPC request has come before a board of appeal in the same or closely comparable circumstances, it is necessary for the board to review and consider in some detail the applicable law and jurisprudence in relation to this determinative issue.

6. Rule 88 EPC acknowledges the legal procedural value of having regard to true as opposed to ostensible party intention in legal proceedings. The fact that the provision is framed as a discretionary power in a rule rather than an article is evidence that this value is seen as a subordinate value which should not prevail in a serious conflict with other values such as procedural certainty and economy as expressed by defined conventionary procedures, departmental powers and time limits. This is confirmed by the existence of Article 122 EPC which defines precise limited circumstances and conditions in which true party intention may exceptionally prevail over procedural certainty in relation to loss of rights resulting from non-observance of certain time limits - with specific exclusions listed in Article 122(5) EPC and third party protection laid down in Article 122(6) EPC. These systematic constructional considerations lead the board to the view that outside the institution of *restitutio in integrum* a request to substitute true for ostensible intention, eg by way of a Rule 88 EPC request for

correction of a document filed at the EPO, the effect of which correction would be materially to breach fundamental legal procedural principles representing the superordinate value of legal certainty, should not normally be allowed. One such legal procedural principle is that a competent first instance department of the EPO is empowered under Article 113(2) EPC to take a decision which terminates the first instance procedure on the basis of the ostensible final requests of the parties as determined by the department concerned with due care and diligence having regard to what has been duly submitted by the parties in person or by an authorised representative; a second such principle is that a party is not to be regarded as adversely affected within the meaning of Article 107 EPC by such a decision which grants his final request.

7. The substantial body of jurisprudence of the EPO Boards of Appeal in relation to Rule 88 EPC deals mostly with errors in designation of contracting states and priority data. This jurisprudence has considered the criteria for exercise of discretion in terms of balancing the interests of the parties concerned having regard to the period of time during which third parties may have been misled by erroneous data. This kind of quasi-quantitative balancing of interests appears to the board to be inadequate in relation to the issue of principle to be decided in this appeal. The period of time during which a third party might have been notionally misled as a result of a file inspection in the present case does not appear to the board to be a relevant measure in relation to the solemn legal value represented by the validity and procedural finality of a decision taken properly without any procedural violation - subjective or objective - on the basis of

all the facts before the opposition division. In this respect the board finds support in the remarks made in J 3/01 at point 7 of the reasons that "corrections.....may not be allowed with regard to other compelling principles of the Convention" and at point 10 that "Correction under Rule 88 EPC does not reverse the effect of decisions already taken on the basis of the uncorrected document and does not re-open a procedural phase already terminated or a time-limit already expired".

8. In support of his request the appellant relies on J 4/97 as a decision which allowed a correction under Rule 88 EPC to set aside the normally legally binding effect of a notice of withdrawal of a patent application received by the EPO. In that decision the Legal Board applied and extended the jurisprudence developed in J 10/87 (OJ EPO 1989, 323) - according to which Rule 88 EPC provides, in appropriate circumstances, a window of opportunity for retraction of an erroneous withdrawal of the designation of a contracting state, which window is closed by official public notification of the withdrawal of the designation by the EPO - to the retraction of the withdrawal of a patent application as a whole. The present board regards this line of jurisprudence as confirming that procedural legal certainty is a higher value than true party intention. Indeed J 10/87 asserts this explicitly at point 12 of the reasons: "Legal certainty demands that the EPO can rely on statements of the parties in proceedings" thereby pinpointing the precise procedural stage at which certainty prevails over intention and Rule 88 EPC reaches the limit of its applicability, viz when a party statement is relied on in a formal juridical act. J 4/97 followed J 10/87 in

finding that publication by the EPO in the Register of European Patents or in the European Patent Bulletin were the relevant formal juridical acts in relation to withdrawal of a patent application or a designation of a contracting state. In the judgement of the board the relevant formal juridical act in the present case was the posting of the decision of the opposition division.

9. In arguing that the board has the power to set aside the decision under appeal the appellant proprietor has sought to apply the analogy of a decision which has to be set aside as based on an objective substantial procedural violation, albeit without any fault on the part of the department of first instance, eg as a result of documents not reaching the deciding department by virtue of an administrative error occurring within the EPO. It is true that this analogy is at least a partial answer to the respondent opponent's argument based on third parties being misled by the result of a file inspection, because it makes the valid point that a properly advised third party would take into account the possibility of an apparently flawless decision being set aside as a result of an objective substantial procedural violation, of the kind referred to above, coming to light on appeal. The analogy is nonetheless not cogent because it ignores the asymmetry in the respective legal values concerned. The reason why a substantial procedural violation involving a fundamental deficiency can lead to a decision being set aside and indeed being voided *ab initio* is, of course, that in such a case a higher ranking value than that of true party intention is involved, viz natural justice or due process. The latter even outranks procedural certainty so long as proceedings exist to provide jurisdiction.

10. The board's reasoning above has proceeded assuming *arguendo* that the appellant proprietor has satisfied the high standard of proof of mistake applicable to Rule 88 EPC, first sentence, requests for correction. In view of the board's conclusion that the posting of the decision closed the window of opportunity for a correction pursuant to Rule 88 EPC no finding on the disputed question of proof of mistake is required.

11. Given that, in the light of the reasoning above, the appellant proprietor is bound by his ostensible intention expressed in the letter of 13 April 2000 on which the opposition division properly relied in taking the decision under appeal, he has to be considered as not adversely affected by the decision within the meaning of Article 107 EPC, first sentence, so that the appeal falls to be rejected as inadmissible pursuant to Rule 65(1) EPC.

Order

For these reasons it is decided that:

The request for correction is refused.

The appeal is rejected as inadmissible.

The Registrar: The Chairman:

D. Sauter W. J. L. Wheeler