

Internal distribution code:

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

**Datasheet for the decision
of 30 October 2009**

Case Number: T 1673/07 - 3.5.03

Application Number: 00125574.4

Publication Number: 1104147

IPC: H04M 1/2745

Language of the proceedings: EN

Title of invention:

Telephone set having removable storage medium

Applicant:

KYOCERA CORPORATION

Headword:

Withdrawal of Designation/KYOCERA

Relevant legal provisions:

-

Relevant legal provisions (EPC 1973):

EPC R. 51(4), 87, 88

Keyword:

"Validity of withdrawal of designation (yes)"

"Retraction of an erroneous notice of withdrawal (no)"

Decisions cited:

J 0015/86, J 0011/87, J 0027/94, J 0025/03

Catchword:

-



Case Number: T 1673/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 30 October 2009

Appellant:

KYOCERA CORPORATION
6, Takedatobadono-cho, Fushimi-ku
Kyoto-shi
Kyoto 612-8501 (JP)

Representative:

Bohnenberger, Johannes
Meissner, Bolte & Partner
Postfach 86 06 24
D-81633 München (DE)

Decision under appeal:

Decisions of the Examining Division of the
European Patent Office concerning European
patent application No. 00125574.4 - posted on
12 February and 19 April 2007.

Composition of the Board:

Chairman: A. S. Clelland
Members: R. Menapace
M.-B. Tardo-Dino
A. Madenach
F. van der Voort

Summary of Facts and Submissions

I. The appeal lies against the following decisions of the Examining division in the matter of the European patent application no. 00125574.4:

(i) Interlocutory decision dated 12 February 2007 refusing the applicant's (appellant's) request for confirmation, that the communication of 12 December 2005 confirming withdrawal of the designation of Germany ("DE") and France ("FR") was issued in error.

(ii) Decision dated 19 April 2007 to grant the European patent No. 1104147 pursuant to Article 97(2) EPC with Italy ("IT") as the sole designated Contracting State.

II. The relevant file history underlying these two decisions can be summarized as follows:

(i) In the course of the examination proceedings the designated contracting states were restricted to DE, FR and IT. In response to a communication of the Examining Division, stating that claims on file were allowable for IT, the applicant filed separate claims for FR and DE. Subsequently, in a letter dated 5 April 2005, the applicant's (appellant's) representative wrote to the Office:

"Further to our communication today concerning the above-captioned application, please be informed that Applicant requests that Germany and France be entirely removed from the present application.

Accordingly, Applicant requests the Examiner to expedite the issuance of the communication under Rule 51(4) EPC for the above-captioned application for Italy."

- (ii) With reference to that letter the Formalities Officer in charge responded in a brief communication dated 12 April 2005 as follows:

I hereby confirm that designated states Germany (DE) and France (FR) have been withdrawn from the above mentioned patent application. Italy (IT) is the sole remaining designated state.

- (iii) On 10 June 2005 the communication under Rule 51(4) EPC 1973 indicating IT as the sole designated state was issued. The applicant's approval ("*... we would like to confirm that the applicant approves the documents intended for grant.... We herewith request that the Decision to Grant be issued*") was received on 11 October 2005.

- (iv) By letter of 29 December 2005 - after a divisional application had been filed on 20 September 2005, in which DE and FR were designated - the applicant's representative requested confirmation that the communication of 12 April 2005 confirming withdrawal of the designations of DE and FR (see point ii, above) was issued in error and that the divisional application had been correctly filed. In support of that request it was submitted in essence, that in a telephone consultation with the Primary Examiner on 5 April 2005 the Examiner insisted on the removal of DE and FR before the

allowable claims for IT could proceed, thereby forcing the applicant to confirm "removal". After fairly lengthy discussion with the Examiner on the telephone on numerous occasions, it was understood that the applicant wished to maintain the rights for DE and FR and that "removal" did not prejudice those rights. Accordingly, the applicant had still been under the impression that he would be able to obtain a single patent with two sets of claims.

- (v) Thereafter, the Examining Division, which had been enlarged by the addition of a legally qualified member, issued the two decisions under appeal (see point I.(i) and (ii), above).

III. The notice of appeal was filed and the required fee was paid on 4 June 2007. In the grounds for the appeal filed on 2 August 2007 it was, in particular, argued further that

- in view of the possibility under Rule 87 EPC [1973] and the decision J 27/94, the Examining Division should have contacted the applicant directly, if it had had any doubt as to his true intentions as regards the designation of DE and FR in the pending application.
- during the telephone conversation on 5 April 2005 the [Primary] Examiner was made aware of the applicant's intention to file a divisional application for all three Contracting States in question, and not just for IT, and the relevant statements in the representative's letter sent on

the same day directly to the Examiner had to be understood accordingly.

- in any event, as the letter dated 5 April 2005, when read out of context, did not sufficiently recite the applicant's true intentions for the continuing examination, its clarification in accordance with the letter of 29 December 2009 should be allowed under Rule 88 EPC 1973.

IV. In response to a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal, the appellant stressed that the letter of 5 April 2005 had to be read in conjunction with the applicant's previous letter of 25 February 2005 and the conversations with the Examiner which led the representative to believe that the removal of the DE and FR designations was a necessary course of action in order to allow for the first claim set to be pursued for IT only, whilst also maintaining a second set of claims for DE and FR. It was also clear that on 5 April 2005 the appellant had not yet filed a divisional application for DE and FR; otherwise this aspect would not have been discussed with the Examiner on that day. The (previous) representative's letter of the same day only concerned the claims being pursued under the IT designation in order to allow the examiner to proceed with the claims for IT. It was never the representative's, nor the applicant's, intention to delete the designations for all states but IT, rather it was intended to pursue two claim sets.

V. During the oral proceedings, which took place on 30 October 2009 and ended with the announcement of the decision on the appeal, the appellant's representative made it clear that it was not contended that the (former) representative had been misled in any way by the Office, but that an obvious misunderstanding had occurred. In fact, the removal of the designations had been declared only in the interest of streamlining the procedure by allowing the Examiner to close the case on the first set of claims (for IT) and to proceed on the second set of claims (for DE and FR). This should have been appreciated by the Office, and in the mindset of the then representative one could read the Formalities Officer's brief communication of 12 April 2005 accordingly.

VI. The appellant's final requests were that

- the interlocutory decision dated 12 February 2007 be set aside and that France and Germany remain designated states with Italy;
- the decision to grant the patent be set aside.

Reasons for the Decision

1. The Board is satisfied that all requirements for the admissibility of the appeal have been fulfilled.
2. A valid notice of withdrawal which has been received at the EPO is binding on the applicant. It should only be accepted without question if it is completely unqualified and unambiguous (see J 11/87, OJ 1981,141

in respect of a request for withdrawal of a European patent application). Where there is even the slightest doubt as to the applicant's actual intent such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirm that such has been the true intent.

3. The requests in the letter dated 5 April 2005, namely that "*Germany and France be entirely removed from the present application*" and that "*the issuance of the communication under Rule 51(4) EPC for the above-captioned application for Italy*" are clear and unambiguous. They leave no room for interpretation, either in view of the wording or in the given procedural context: Also where use was made of the possibility of having different sets of claims under Rule 87 EPC 1973, first alternative, the grant procedure continued to be a single one for the application concerned, so that only one communication under Rule 51(4) EPC 1973 and one single decision to grant were issued. Given this, it was a not uncommon course of action by applicants to withdraw the designation of states which gave rise to contentious prior art issues pursuant to Article 54(3) EPC 1973 in order to obtain a swift grant for the other designated states.
4. Even if the Office, for whatever reason, had or should have had any doubt as to whether the applicant really wished to abandon the designations in question, any such doubt would have been removed by the subsequent events, in that the applicant did not react to the communication dated 12 April 2005 in which the Office explicitly informed the applicant of its understanding

that the letter of 5 April 2005 constituted a notice of withdrawal; rather, following the communication under Rule 51(4) EPC 1973 which again explicitly indicated IT as the sole Contracting State, an unqualified approval of the documents intended for grant was given and grant itself was requested (see point II. (iii), above) - again an unambiguous and also plausible procedural declaration consistent with the earlier withdrawals of the designations of DE and FR.

5. The appellant further argued that it should be allowed under Rule 88 EPC 1973 (which corresponds to Rule 139 EPC 2000) to resile from the withdrawal of the designations, since it had been made under an erroneous assumption. However, according to the established case law of the Boards of Appeal, one precondition for such a retraction is that the relevant request is made before the withdrawal has been officially notified to the public (see e.g. decisions J 15/86, OJ EPO 1988,417 and J 25/03, OJ EPO 2006, 395). This is in the interest of legal certainty and balancing the interests of the applicant and of third parties, in particular in being able to rely on information officially published, and is an objective criterion which applies irrespective of the true intentions or mindset of the person who made the relevant statement. In the present case the withdrawal was published in the European Patent Bulletin 21/2005 of 25 May 2005, i.e. about half a year before the validity of the withdrawal of DE and FR was contested for the first time by letter of 29 December 2005.
6. In conclusion, the withdrawal of the designation of DE and FR was valid and cannot be retracted.

Order

For the above reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

D. Magliano

A. Clelland