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**Datasheet for the decision
of 8 September 2016**

Case Number: T 0610/11 - 3.4.01

Application Number: 06117047.8

Publication Number: 1748422

IPC: G10L15/18

Language of the proceedings: EN

Title of invention:

Methods and systems for natural language understanding using human knowledge and collected data

Applicant:

AT&T Corp.

Headword:

Retraction of withdrawal of the appeal - (no)

Relevant legal provisions:

EPC R. 139

Keyword:

Correction of error - (no)

Decisions cited:

J 0008/80, J 0006/91, J 0019/03, T 0309/03, T 0445/08

Catchword:



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Case Number: T 0610/11 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 8 September 2016

Appellant: AT&T Corp.
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New York, NY 10013-2412 (US)

Representative: Asquith, Julian Peter
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 8 October 2010 refusing European patent application No. 06117047.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman G. Assi
Members: P. Fontenay
C. Schmidt

Summary of Facts and Submissions

- I. The European patent application No 06117047.8 was refused by the decision of the European Patent Office (EPO) dated 8 October 2010.
- II. On 8 December 2010, the appellant (applicant) filed a notice of appeal and payed the prescribed fee on the same date.
- III. With a letter dated 18 February 2011, the appellant filed the grounds of appeal, submitted sets of claims according to a main request and auxiliary requests 1 to 6 and requested oral proceedings.
- IV. With a communication dated 31 March 2016, the Board issued a summons to oral proceedings to be held on 8 July 2016.
- V. With a letter dated 21 April 2016, the appellant's representative withdrew the appeal by stating *"We herewith withdraw our Appeal of the Decision to refuse the above application. We will not attend the oral proceedings of 8 July 2016."*
- VI. On 4 May 2016, the Board canceled the oral proceedings.
- VII. With a letter dated 2 June 2016, the appellant's representative submitted that the withdrawal of the appeal was due to an error and requested correction of that error. In particular, the appellant's representative stated *"I have become aware that our instruction to withdraw this appeal were in error. I request correction of that error under Rule 139 EPC, or otherwise, so that this application and appeal are re-instated."*

VIII. With a further letter dated 8 June 2016, the appellant's representative explained that the appellant's patent developer, i.e. the person responsible for making a decision whether or not to continue with the application, had decided to incur no further costs on the application. Therefore, the application status had been changed to "*inactive*". Moreover, the appellant's representative had been instructed not to attend the scheduled oral proceedings and to withdraw the application. These instructions, however, were due to an internal miscommunication within the appellant's company which resulted in that the withdrawal of the appeal had been made in error. The patent developer had indeed been unaware of the fact that the application on file was part of a potential transaction and thus should have been maintained.

IX. Finally, the appellant requested correction of the error under Rule 139 EPC considering that:

- Rule 139 EPC concerned errors in any document filed with the EPO,
- the withdrawal of the appeal was an error, and
- the retraction of the withdrawal had been requested before the withdrawal was published in the EPO Register.

Reasons for the Decision

1. The request to retract the withdrawal of the appeal under Rule 139 EPC is not well-founded for the following reasons.

2. Rule 139 EPC (first sentence) stipulates that *"Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request"*.

It is noted that the first sentence of Rule 139 EPC is identical to the first sentence of Rule 88 EPC 1973. Thus, the jurisprudence of the boards of appeal, evolved from Rule 88 EPC 1973, also applies to Rule 139 EPC.

3. According to decision T 309/03 (OJ 2004, 91), the *"enumeration and the heading of the provision (Correction of errors in documents filed with the European Patent Office) make clear that the provision deals with cases in which an error of expression in a declaration has occurred or a mistake in a document is the consequence of an error"* (point 2.1 of the Reasons).

Furthermore, according to decision J 19/03 (point 3 of the Reasons), *"According to the established jurisprudence of the Boards of Appeal which refers to documents relating to the preparation of the European Patent Convention (J 8/80, point 3 of the reasons , OJ EPO 1980, 293; J 4/82 point 3 of the reasons, OJ 1982, 385) Rule 88 EPC also applies to corrections of procedural acts if they are submitted by a document as i.e. a request for correction of designation of a State, of a claimed priority or as in the present case of the withdrawal of an application (cf. J 4/97, point 4 of the reasons)"*.

Thus, by analogy, Rule 139 EPC would also apply to the correction of a procedural declaration to withdraw an appeal.

4. Nevertheless, in the present case, the Board comes to the conclusion that the declaration submitted by the appellant's representative to withdraw the appeal cannot be considered to contain an error to be corrected under Rule 139 EPC.
- 4.1 According to the appellant's submissions, the representative did not make any error when declaring the withdrawal of the appeal. Rather, the appellant gave instructions to the representative, which, as it turned out later, did not represent its true intention. In other words, an error occurred during the process of deciding how the appellant should deal with the application.
- 4.2 In the case underlying decision J 19/03, the professional representative submitted a procedural declarations on behalf of its client without having received explicit instructions to do so. As a matter of fact, the representative misinterpreted a notice he had received from a company in charge of the payment of annuity fees. The Legal Board of Appeal in its decision of 11 March 2005 found that *"under Rule 88, first sentence EPC it is not sufficient to prove that a divergence has occurred between the true intention of the applicant and the declaration filed by its representative; rather it is additionally required that this divergence was caused by an error of the person who was competent to make the decision on the procedural act before the EPO. Therefore, as a rule, in cases where the party is represented by a professional representative the error pursuant to Rule 88 EPC must be an error of the representative in expressing his own intentions"*. (cf. J 19/03, point 12 of the reasons).

In this decision it was explicitly left open whether or not a procedural act performed by a professional representative on behalf of his client before the EPO could be corrected under Rule 88 EPC 1973 (respectively Rule 139 EPC) when the representative - as in the current case - had acted on a specific but erroneously given instruction of his client (cf. J 19/03 loc. cit.).

On the other hand, in other decisions, it was stated that *"for the purposes of Rule 88 EPC a mistake may be said to exist in a document filed with the EPO if the document does not express the true intention of the person on whose behalf it was filed"* (cf. T 445/08, point 5 of the Reasons; J 6/91, point 2.2(1) of the reasons, OJ 1994. 349).

This sentence could be taken as a statement that the true intention of a represented party is decisive, i.e. declarations made before the EPO not in line with true intentions of the party could be corrected under Rule 139 EPC.

However, the decisions quoted above base upon said decision J 08/80 (OJ 1980, 293). The case underlying this decision was characterized by the fact that the applicant gave a specific instruction to its European representative to file an application for five member states including Germany. In spite of this instruction, the representative failed to file the application for Germany. Thus, in said case an error occurred in the sphere of the representative and not in that of the applicant.

Furthermore, none of the decisions quoted above deals with a situation where an explicit instruction given to

a representative has been correctly executed by way of a procedural declaration which later on turns out not to be in line with the party's true intentions.

In summary, the cited decisions do not directly give a hint at whether an incorrect instruction given by a party to its representative may justify a correction of a corresponding procedural declaration by the representative before the EPO.

- 4.3 However, in the view of the Board, it can be derived from general procedural principles as defined by the boards of appeal that, in cases where a professional representative acts before the EPO, under Rule 139 EPC only errors or mistakes can be corrected which occurred in the sphere of said representative.
- 4.4 According to said decision J 19/03 (point 5 of the Reasons), *"It is further obvious that corrections of procedural acts having an ab initio effect have a potentially serious impact on an application, in particular if they relate to its territorial extent or to whether the application is pending at all, and raise serious concerns as to legal certainty not only for the applicants vis-à-vis the EPO but also for the public. Therefore, the jurisprudence of the Boards of Appeal took as a starting point that, as a general rule, an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. J 11/87, points 3.3 and 3.6 of the reasons, OJ EPO 1988, 367; J 27/94, point 8 of the reasons, OJ EPO 1995, 831) and is not allowed to reverse these acts so that they can be considered as never filed (J 10/87, point 12 of the reasons, OJ 1989, 323; J 4/97, point 2 of the reasons)"*.

In the view of the Board, therefore, the correction of a substantial procedural act such as the withdrawal of an appeal must remain an exception.

- 4.5 Furthermore, it is common ground that the decision about which procedural act should be performed before the EPO falls into the core responsibility of the authorised representative, which, according to Article 134(1) EPC, may not be delegated to other persons.

In this respect, decision J 19/03 (point 13 of the Reasons), already mentioned above, states that *"The case law concerning the requirement of due care pursuant to Article 122(1) EPC already decided that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally (cf. J 33/90, reasons point 3.3). This interpretation can be concluded from the principle laid down in Article 134(1) EPC stipulating that the representation of applicants before the EPO is accorded only to "professional representatives". The same concept applies to the question whether or not an error pursuant to Rule 88, first sentence EPC occurred. If the representative relied on the capacity and the experience of the person in charge he cannot claim that he acted erroneously in the sense of Rule 88, first sentence EPC"*.

- 4.6 In view of the foregoing, it can be concluded that in cases where a professional representative acts on behalf of an appellant, an error or mistake in a procedural declaration before the boards of appeal can be corrected under Rule 139 EPC only if this error or mistake has been made by the representative himself.

In the present case, it is not so. By declaring the withdrawal of the appeal with letter dated 21 April 2016, the appellant's representative followed the explicitly expressed instructions of the appellant. Indeed, according to the submissions of the appellant, the responsible person within the organisation of the appellant, i.e. the patent developer, clearly decided to incur no further costs on the case and finally gave the order to withdraw the application. Thus, the representative was neither in error by filing the letter dated 21 April 2016 nor had any reasons to believe that the withdrawal of the appeal could possibly not be in line with the appellant's true intention.

5. In the light of these findings, it is not decisive whether or not the withdrawal of the appeal had already been published at the point of time when the appellant discovered its mistake and filed the request for correction. This issue may thus be left open.

Order

For these reasons it is decided that:

The request to retract the withdrawal of the appeal is refused.

The Registrar:

The Chairman:



I. Aperribay

G. Assi

Decision electronically authenticated