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**Datasheet for the ancillary decision
of 3 March 2023**

Case Number: T 0695/18 - 3.5.03

Application Number: 11865564.6

Publication Number: 2763480

IPC: H04W68/00, H04L5/00, H04W24/10

Language of the proceedings: EN

Title of invention:

Method for notifying interference measurement reference information, method and device for measuring interference

Applicant:

ZTE Corporation

Headword:

Withdrawal of the withdrawal of the appeal/ZTE

Relevant legal provisions:

EPC Art. 112a(2)(d), 112a(5), 164(2)
EPC R. 36(1), 104(b), 108(3), 139
RPBA 2020 Art. 20(1)
Vienna Convention on the Law of Treaties (1969) Art. 31(1)

Keyword:

Correction of withdrawal of appeal - (no): Rule 139 EPC not applicable to non-pending appeal cases
Pendency of application after withdrawal of appeal - (no)
Divergence from an interpretation of the EPC in earlier decisions of any Board - (yes): different interpretation of Rule 139 EPC

Decisions cited:

G 0007/91, G 0008/91, G 0008/93, G 0001/09, G 0001/12,
R 0003/22, J 0019/82, J 0010/87, J 0042/92, J 0004/03,
J 0019/03, J 0023/13, J 0002/15, J 0007/19, T 0085/84,
T 0824/00, T 0309/03, T 1244/08, T 0379/10, T 0610/11,
T 0574/17, T 2148/18, T 0433/21

Catchword:

1. "Proceedings" to be re-opened under Article 112a(5) EPC following an allowable petition are limited to rectifying the defect found according to the review decision. The present proceedings as re-opened by the Enlarged Board in R 3/22 are thus not the appeal proceedings, but "ancillary proceedings" with the limited purpose to decide on the request for correction of the withdrawal of the appeal (see point 2 of the Reasons).
2. Rule 139 EPC is applicable only if proceedings before the EPO for some other purpose are pending when the request for correction is received by the EPO. The request for correction is inadmissible if received when no such proceedings are pending (see point 3 of the Reasons).
3. A patent application subject to the examining division's refusal, which is in turn subject to an appeal that has been withdrawn, is not "pending" within the meaning of Rule 36(1) EPC (see point 4 of the Reasons).



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Case Number: T 0695/18 - 3.5.03

A N C I L L A R Y D E C I S I O N
of Technical Board of Appeal 3.5.03
of 3 March 2023

Former appellant:
(Former applicant)

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Object of the decision:

**Request for correction of the withdrawal of the
appeal dated 28 September 2021 relating to the
European patent application No. 11865564.6.**

Composition of the Board:

Chair

K. Bengi-Akyürek

Members:

C. AlMBERG

K. SchENKEL

Summary of Facts and Submissions

Examination proceedings

- I. On 30 December 2011, the then applicant filed European patent application No. EP11865564 ("the application"), which was later refused by the examining division.

Appeal proceedings

- II. On 28 September 2021, after having lodged the notice of appeal and the statement of grounds of appeal against the refusal, and having received the Board's negative preliminary opinion on the merits of the appeal case, the then applicant/appellant (henceforth "the party") filed a letter that, in relevant part, reads:

"We herewith respectfully inform the Boards of Appeal that the Applicant herewith withdraws the appeal. A partial refund of the appeal fee is requested."

- III. Later on the same day, the registrar, on the Board's behalf:
- dispatched and filed a notice of cancellation of the oral proceedings to which it had previously summoned (dated 1 October 2021, EPO Form 3017);
 - internally circulated and filed an order for final treatment stating that the appeal proceedings had been closed without a decision on the merits, with "28.09.21" coded as the date of statistical recording ("STATI"), and that the appeal fee was to be partially reimbursed (EPO Form 3312);

- internally returned the file to the first instance stating that the (then) applicant had withdrawn the appeal, and that the appeal fee had been partially reimbursed (EPO Form 3311).

IV. Still on 28 September 2021, the party acknowledged its receipt of EPO Form 3017.

V. The next day, i.e. 29 September 2021, the party filed another letter which, in relevant part, reads:

"We refer to our previous communication filed via online filing on 28 September 2021 and herewith withdraw the request to withdraw the appeal.

The request was based on erroneous interpretation of the instructions given by the applicant, which intention merely was not attend the oral proceedings."

VI. Still on 29 September 2021, the registrar, on the Board's behalf, issued and filed the form "Closure of the procedure in respect of [the application]" (EPO Form 2058).

VII. On 1 October 2021, the registrar, on the Board's behalf, issued a communication informing the party of the closure of the appeal proceedings following the party's withdrawal of the appeal on 28 September 2021, with an additional message that reads (EPO Form 3324):

"The Board has instructed the Registrar to notify all concerned that the appeal proceedings are accordingly closed without a substantive decision.

The appeal fee will be reimbursed pursuant to Rule 103(4) (a), (5) EPC."

VIII. By letter of 5 October 2021, the party referred to the submission made in the letter of 29 September 2021 as a "request of correction", and observed that this request was filed before any confirmation from the Board of the termination of the appeal proceedings was made public. The party further argued that the representative had misinterpreted the written instructions from the client before, erroneously or mistakenly and against the client's intentions, withdrawing the appeal by letter of 28 September 2021. These instructions read:

"The client would like to abandon the captioned application and allow it to go lapsed. Please stop your works."

IX. Still on 5 October 2021, the registrar, on the Board's behalf, issued a communication referring to appeal case T 695/18 and the letter of 29 September 2021, and informed the party as follows:

"Following the appellant's withdrawal of the appeal requested with the submission dated 28 September, the appeal proceedings before Board 3.5.03 has been terminated. Consequently, this Board is no longer competent to deal with that case."

X. With letter of 15 November 2021, the party referred to the Board's communications of 1 and 5 October 2021, and requested a reasoned decision "according to Rule 112 EPC or any other applicable provision".

XI. The Board did not issue any decision.

Review proceedings

XII. By letter of 30 November 2021, the party filed a petition for review under Article 112a EPC directed against the refusal of the Board to consider its submissions dated 29 September and 5 October 2021. It argued that the Board had violated its right to be heard, and had omitted to decide on a request relevant to the existence of the appeal. The party requested that the Board's decision be set aside, that the proceedings before the Board be re-opened, and that the petition fee be reimbursed.

XIII. In its decision of 22 November 2022 in the corresponding review case R 3/22, the Enlarged Board found the petition admissible and allowable. The communication of 5 October 2021 was interpreted as a decision in which the Board had implicitly decided on the appeal without deciding on the request for correction. The Enlarged Board observed that according to the case law (with reference to the Case Law of the Boards of Appeal, 10th ed. 2022, henceforth "CLBA", V.A.7.3.7), the success of such a request could not be ruled out *a priori*, and if the request was successful, a decision on the merits would have been possible.

The Board's refusal to decide on this request was seen as a fundamental procedural defect under Article 112a(2)(d) and Rule 104(b) EPC. As a result, the Enlarged Board set aside the decision, re-opened the proceedings before the Board and reimbursed the petition fee. Whether the refusal also violated the party's right to be heard was left open.

Re-opened proceedings before the Board

Written proceedings

- XIV. In reaction to the Enlarged Board's decision, the Board summoned the party to oral proceedings.
- XV. On 4 January 2023, the Board issued a communication under Article 15(1) RPBA 2020 (henceforth "the preliminary opinion"). The gist of the Board's preliminary opinion was its view that Rule 139 EPC was not applicable in the absence of a pending appeal case. The Board concluded that the request for correction was likely to be refused, with the effect that the appeal proceedings were terminated on 28 September 2021 without a decision on the merits of the appeal case, and that the appeal case (and the underlying application) was no longer pending on 29 September 2021.
- XVI. No written response was filed to the Board's negative preliminary opinion on the request for correction.

Oral proceedings

- XVII. At oral proceedings held before the Board on 3 March 2023, the party argued essentially as follows.

On an introductory note, the party made the following remarks:

- At this stage of the proceedings, it is not time to argue the case on the merits. It is now merely about correcting a mistake. Humans make mistakes. The mistake to withdraw the appeal was made by its representatives, not by the party itself.

- Since the withdrawal of the appeal, two European divisional applications relating to the application have been filed, one on 1 October 2021 (i.e. No. EP21200454), the other on 2 March 2023 (i.e. No. EP23159586).

On the applicability of Rule 139 EPC, the party made the following submissions:

- Rule 139 EPC applies to the withdrawal of an appeal, both in principle, and in the present case. There is no reason to believe otherwise. On the contrary, this is clear from the provision itself and from the case law.
- The present mistake does not concern the description, claims or drawings. Thus, the second sentence of Rule 139 EPC is not applicable. But it shows, in contrast, how broad the scope of the applicable first sentence is.
- The first sentence addresses any mistake in any document filed with the EPO. Therefore, it has no restrictions. This makes sense as it is impossible to foresee every mistake.
- There are examples in the case law specifically of a correction of a withdrawal of an appeal, e.g. T 2148/18 and T 610/11. The circumstances of the present case are very similar to those of T 2148/18. Moreover, "appeals" are expressly mentioned in G 1/12 (Reasons 35) showing that Rule 139 EPC is applicable. The phrase "an error of expression in a declaration" mentioned in the latter case (Reasons 34) refers to the declaration's content and, thus, implies no

restriction. Together, T 2148/18 and G 1/12 are the legal basis for the present case.

- In the case law, there are also examples of corrections of similar procedural acts, such as the withdrawal of a designation of a contracting state, or an application. The effect of a withdrawal of the application is, at least insofar as it concerns the pendency of the application, exactly the same as a withdrawal of the appeal.
- With the statement that the success of the correction request could not be ruled out *a priori*, the Enlarged Board itself implied that Rule 139 EPC is applicable.
- In fact, all of the established case law points in the same direction, i.e. that Rule 139 EPC is indeed applicable.
- Considering also that all the safeguards needed have been established in the case law, it would only be fair to apply Rule 139 EPC to the present case.
- T 2148/18 was decided in December 2021. This shows that the case law is still up to date, and still applicable.
- Decision J 42/92 cited by the Board (cf. the preliminary opinion, point 31) is limited in scope. It relates to post-grant amendments, i.e. something else.

On the allowability of the request for correction, the party made the following submissions:

- The immediate termination of the appeal proceedings upon the EPO's receipt of the withdrawal of the appeal on 28 September 2021 is not contested. However, this withdrawal can and should be corrected.

- The preconditions for granting a request for correction of a withdrawal of an appeal were set out in J 10/87, and subsequently reiterated in J 19/03 and T 2148/18. They are settled case law. The present case fulfils all those preconditions.

- Similar to T 2148/18, the letter requesting correction was filed very shortly after the withdrawal: already on the next day. This means not only that the public was not yet officially notified of the withdrawal and, reasonably, that third parties had not yet been affected, let alone taken any action. The party's immediate reaction also shows that the withdrawal was unintentional. Its true intention was to stop the work related to the application, to file a divisional application, and not to attend the oral proceedings before the Board.

On the pendency of the application, the party made the following submissions:

- In the absence of a final decision, a patent application is pending, and the applicant's substantive rights continue to exist. One such right is to file a divisional application under Rule 36(1) EPC.

- When the second divisional application was filed on the day preceding the oral proceedings before the

Board, the application was pending. For no final decision had yet been taken (J 23/13, Reasons 4, 8.2 and 8.3).

- The Enlarged Board in R 3/22 found that the present request for correction could be successful and, if so, that a decision on the merits was possible (Reasons 4). Thus, there were potential substantive rights associated with the application. The Board's own preliminary opinion appears to confirm the same thing (points 2 and 27).
- Since something positive could have come out of the application, it must have entailed rights, and must therefore have been in a state of pendency.
- More precisely, the state of the application has gone through a cycle: the application was pending until the appeal was withdrawn; the withdrawal of the appeal ended that pendency; from the filing of the request for correction or, at the latest, from the Enlarged Board's re-opening of the proceedings before the Board, the application regained the pendency it still enjoys.
- In sum, at the time of the oral proceedings before the Board, there was no final decision taken yet to put the substance of the application to rest.

XVIII. The party's final requests made at the oral proceedings before the Board were that

- the request for correction of the withdrawal of the appeal be granted (**main request**);
- in case the main request is refused, the pendency of the application as of the day of the oral

proceedings before the Board be clarified
(**auxiliary request**).

XIX. At the end of those oral proceedings, the chair announced the Board's decision.

Reasons for the Decision

1. Competency of the Board

With the Enlarged Board's decision to re-open the proceedings before this Board, the Board became competent to treat the request for correction under Rule 139 EPC. This follows from the Board's understanding of the EPC as explained below.

2. Nature and scope of the present proceedings

2.1 It was Article 112a(5) EPC that put an obligation on the Enlarged Board to re-open proceedings before this Board.

2.2 The first question to answer is how this provision is to be interpreted and, consequently, how the present order of the Enlarged Board is to be understood. For this purpose, the Board *de facto* applies the Vienna Convention on the Law of Treaties of 1969 ("VCLT", the reference to which is elaborated in point 3.2.1 below).

2.3 Article 112a(5) EPC lays down that, if the petition is allowable, the Enlarged Board shall set aside the decision and shall re-open "proceedings" before the Boards of Appeal in accordance with the Implementing Regulations.

- 2.4 Importantly, the term does not read "the proceedings", let alone "the appeal proceedings". It leaves open what "proceedings" are to be re-opened before the Boards.
- 2.5 Under Rule 108(3) EPC, the Enlarged Board's obligation is re-addressed: in the event of an allowable petition, the reviewed decision is to be set aside and the proceedings are to be re-opened before the responsible Board. The use of the definite article in "the proceedings" appears to be no more than a reference back to "proceedings" in Article 112a(5) EPC, whichever those proceedings are. A similar interpretation can be made of "The proceedings" stated in the Enlarged Board's order (second sentence) in R 3/22.
- 2.6 If this reading of "the proceedings" in Rule 108(3) EPC is wrong, and if there is a conflict between this provision and Article 112a(5) EPC, the open terms of the latter will still prevail (Article 164(2) EPC).
- 2.7 Thus, there is nothing textual in the EPC to suggest that the proceedings re-opened by the Enlarged Board in the present case are the appeal proceedings. If the appeal proceedings were intended, those proceedings and thus the application would be pending again. That would also make no sense from a contextual point of view. If the proceedings re-opened by the Enlarged Board were the appeal proceedings, the request for correction would in itself, unforeseeable by third parties and irrespective of its merits, automatically have opened the possibility of filing divisional applications (Rule 36(1) EPC). However, that would be unrealistic and unsuitable (as would be the case if provisional protection were reinstated according to the same logic, cf. Article 67(4) EPC).

- 2.8 Of course, a deserted patent application (cf. point 3 below) cannot, like a hidden root or a dormant seed, form new shoots in the form of divisional applications whenever a correction request, however baseless, is filed.
- 2.9 In their preliminary opinion issued on 1 March 2023 in case T 433/21, the competent Board questioned such automation as well as the negation of the effect of *res judicata*. Instead, they viewed the Enlarged Board's order in R 3/22 as one that opened "ancillary proceedings" for the establishment of whether the request for correction is allowable: if the request were found allowable, the appeal proceedings would continue; if not, the appeal proceedings would be regarded as terminated as of the date when the withdrawal of the appeal took effect (see in particular points 7 and 15 to 21 of that preliminary opinion).
- This Board shares that view on the nature of the re-opened proceedings. This position is in no way inconsistent with the view expressed by the Enlarged Board (and earlier by this Board) that a decision on the merits would have been possible if the request had been successful (cf. R 3/22, Reasons 4, page 5; the preliminary opinion, point 2).
- 2.10 In addition, proceedings re-opened under Article 112a(5) EPC are finite in scope. In case T 379/10, such proceedings were considered to be limited to rectifying the defect identified in the review decision (cf. decision of 21 September 2015, Headnote; CLBA, V.B.3.13.1).
- 2.11 Thus, the ordinary meaning of "proceedings" in Article 112a(5) EPC is to be construed narrowly, and

the order of the Enlarged Board in R 3/22 is to be understood as one for the opening of ancillary proceedings before the Board. In the present case, the limited purpose of the proceedings is a decision on the request for correction of the withdrawal of the appeal.

2.12 The auxiliary request on file relates to the legal consequences of a refusal of the main request. It thus falls within the scope of said purpose and the present proceedings.

3. **Main request - Applicability of Rule 139 EPC**

3.1 ***Points of departure***

3.1.1 Before any assessment of the allowability of the present request for correction, it should be determined whether Rule 139 EPC is at all applicable.

3.1.2 At the outset, the Board notes that the withdrawal of an appeal constitutes a unilateral procedural declaration that requires no consent of the Board, i.e. it is at the discretion of the appellant (cf. J 19/82, Headnote).

3.1.3 According to the jurisprudence of the Enlarged Board of Appeal, when the sole appellant withdraws the appeal, appeal proceedings are terminated, in *ex parte* and *inter partes* proceedings alike, insofar as the substantive issues settled by the contested decision at first instance are concerned (cf. G 8/91, Headnote). As a related example in *inter partes* proceedings, the filing by an opponent, who is the sole appellant, of a statement withdrawing its opposition, immediately and automatically terminates the appeal proceedings, irrespective of whether the patent proprietor agrees to

termination of those proceedings and even if in the Board of Appeal's view the requirements under the EPC for maintaining the patent are not satisfied (cf. G 8/93, Headnote; see also T 1244/08, Reasons 4 regarding a withdrawal of the appeal).

- 3.1.4 The party's submission of 28 September 2021 was indisputably an unambiguous and unconditional withdrawal of its appeal (see points II and XVII, page 8 above).
- 3.1.5 On the same day, immediately and automatically upon the EPO's receipt of the party's submission, the withdrawal had thus the legal effects of terminating the appeal proceedings as to the substantive issues settled by the refusal of the application, and of rendering the matters subject to that decision *res judicata*, i.e. finally settled (cf. G 7/91, Reasons 12; T 1244/08, Reasons 4; T 85/84, Reasons 1). Hence, the appeal proceedings ended on 28 September 2021.
- 3.1.6 Therefore, when the party's letters of 29 September and 5 October 2021 were filed, the appeal proceedings were no longer pending. This state of affairs is undisputed.
- 3.1.7 The second question to answer is whether Rule 139 EPC is applicable in the absence of pending proceedings.

3.2 ***Ordinary meaning of the terms***

- 3.2.1 To answer this question, Rule 139 EPC needs to be properly construed. The settled way to interpret the provisions of the EPC is to apply the guidance provided by the VCLT (see CLBA, III.H.1).

Pursuant to Article 31(1) VCLT,

"[a] treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose."

3.2.2 The Board sets out to follow this guidance.

(a) ***Textual observations***

3.2.3 The treaty text before us, Rule 139 EPC, reads:

"Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction."

3.2.4 At first sight, the wording of the first sentence may give the impression that Rule 139 EPC is applicable almost without limit ("*in any document filed with the [EPO]*"), as argued by the party (see point XVII, page 6 above). As if documents about anything would be eligible, even those having no factual connection whatsoever to pending proceedings relating to a patent application or a patent (cf. Articles 1 and 4(3) EPC), if only filed with the EPO and erroneous.

3.2.5 But the wording of the second sentence ("*However*"; "*such*") connects the provisions of the two sentences, with the second being a special instance of the general rule of the first and adding an obviousness criterion for parts, not of anything but of the patent application or patent, which are of more serious

consequence to the interests concerned (in view of e.g. Articles 123(2) and 100(c) EPC).

3.2.6 If the conditions for correction are met, the text puts the EPO under a duty to exercise discretion ("*may be corrected on request*"), i.e. to carry out work such as assessing and deciding on the request for correction and giving reasons for that decision (Rules 102(e) and (g), 104(b) and 111(2) EPC). Quite striking is the absence of more developed conditions such as a duty for those requesting correction to pay a corresponding fee.

3.2.7 These textual observations do not in themselves provide a clear picture of the scope of Rule 139 EPC. On the one hand, the language of the first sentence is open. On the other hand, its linkage to the content of the application or patent mentioned in the second sentence, and the lack of further conditions, are each indicative of some limitations. The interpretation is therefore a matter to be explored both more broadly and more deeply.

(b) ***Systematic and teleological observations***

3.2.8 The Board's first reflection is that remedies with the rare capacity to revive EPO proceedings, either in full (cf. re-establishment of rights), or in part (cf. petition for review) are only available upon payment of the prescribed fee (Articles 112a and 122; Rules 104 to 110 and 136 EPC). In stark contrast to this is the absence of a fee requirement in Rule 139 EPC.

3.2.9 Moreover, and more importantly, these extraordinary remedies endowed with resurrection powers are subject to clear and codified time limits and other precisely limited circumstances and conditions that ensure legal

certainty for all stakeholders (see Rule 136(1) and Article 112a(4) EPC; cf. T 824/00, Reasons 6). These stakeholders are not few: other than the applicant(s) for or proprietor(s) of a patent, they include any other parties to the proceedings, e.g. the opponent(s) or intervener(s), but also competitors and partners outside the proceedings, the public, the EPO itself, any national courts or the Unified Patent Court as concerned, etc.

- 3.2.10 Conversely, Rule 139 EPC is merely a stand-alone provision ranked as an Implementing Regulation of the EPC. Legal certainty, as protected by the safeguards expressed in, or derived from Articles of the EPC governing re-establishment of rights and petition for review, corresponds, also from a systematic point of view, to a higher interest. It takes precedence over the subordinate value of Rule 139 EPC and its role relating to the "true" as opposed to the "ostensible" party intention (cf. Article 164(2) EPC; T 824/00, Reasons 6; T 309/03, Reasons 2.5 and 2.6).
- 3.2.11 The jurisprudence on correction of a withdrawal of the appeal under Rule 139 EPC is noticeably scarce. In the CLBA section (V.A.7.3.7) cited by the Enlarged Board in R 3/22 (cf. Reasons 4, page 5), only two such cases appear: in case T 2148/18, all listed conditions were deemed to be met and the correction was eventually allowed, whereas in case T 610/11, the correction was refused for want of an "error".
- 3.2.12 According to T 2148/18, the first precondition for such correction is that "the public had not been officially notified" of the withdrawal subject to the request for correction (Reasons 2.2.3, second paragraph). The cited basis for this precondition, and the other three

listed, was J 10/87, which, however, dealt with the correction of the withdrawal not of an appeal but of the designation of a Contracting State.

- 3.2.13 In case J 10/87, in turn, no clear basis was cited, merely three restrictive earlier cases from which that Board distinguished its own case, as it felt (Reasons 12), and was of the opinion (Reasons 13), that under Rule 88 EPC 1973 [Rule 139 EPC] a correction of a withdrawal of a designation might be allowable if four listed requirements were met. It noted that the EPO was not obliged to keep a record when a file was inspected. This entailed an unavoidable risk that a third party having inspected the file might start to use the invention relying on the withdrawal. Mainly therefore, that Board put first on its list of requirements that the EPO had not officially notified the public of the withdrawal (Reasons 10 to 13).
- 3.2.14 With reference to said requirement (re-phrased and labelled "precondition"), the Board in case T 2148/18 noted that, at most, the letter of withdrawal had been available for file inspection only very shortly before the correction letter was also available, which was filed later the same day. It was not verifiable whether a third party had inspected the file history and taken note of the erroneous withdrawal but not of the correction letter. The Board considered the probability of that scenario and found it to be minimal (Reasons 2.2.3). Here it suffices to note that, in T 2148/18, when the first precondition is addressed, in fact it is not the official notification of the public that is discussed, at least not directly. Instead, it is the effect of the presence of the withdrawal in a file open to inspection: a test apparently considered

in J 10/87 but rejected (Reasons 10 and 11).

3.2.15 In case T 610/11, it was held, simply by analogy with jurisprudence related to an attempted correction by cancellation of the filing of a notice of appeal (T 309/03), or a correction of the withdrawal of an application (J 19/03), that Rule 139 EPC was also applicable to the withdrawal of an appeal (Reasons 3).

3.2.16 Thus, if jurisprudence on correction of a withdrawal, not of an appeal, but of a patent application, were to be considered, already the condition just discussed, i.e. about potential or factual third-party awareness, would vary further. For instance, J 19/03 proposes "a more complete list" encompassing a total of, at least, seven criteria or prerequisites (Reasons 7, items a to g) of which the corresponding third one (i.e. item c) reads:

"whether the public had been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied [...]".

However, the same listed item c offers an open-ended alternative: "or whether the interest of the public was safeguarded even after this notification". Furthermore, in J 2/15, the key factor was "publication in the European Patent Register" (Reasons 17), whereas in J 7/19 it was publication "in the European Patent Bulletin" (Reasons 7).

3.2.17 In practice, consulting the European Patent Register, inspecting the files, and reading the European Patent Bulletin are not the only ways for stakeholders to learn about matters of a withdrawal of the appeal. Considering the circles of EPO officials aware of a

withdrawal of the appeal already at an early stage (cf. point III above), it cannot be excluded that other stakeholders (cf. point 3.2.9 above) learn about it before it is entered into the European Patent Register. It is commonplace that parties to proceedings and third parties contact administrative staff such as registrars to query about the state of the file.

- 3.2.18 The question must then be asked whether the evaluation of evidence of factual third-party awareness is a suitable method for safeguarding legal certainty (cf. T 2148/18, Reasons 2.2.3, last two paragraphs) and, if so, whether the reaction times of different registrars, as affected by their workload, holidays, etc., should be weighed in.
- 3.2.19 As already mentioned, besides the condition concerning potential or factual third-party awareness, further conditions are listed in the jurisprudence. Many of these comprise subjective requisites like: "due to an *excusable* oversight"; "would not delay the proceedings *substantially*" and "the interests of third parties [...] were *adequately* protected" (cf. T 2148/18, Reasons 2.2.3; J 10/87, Reasons 13; emphasis added). Subjective requisites reduce predictability. This is all the more true when they are listed cumulatively.
- 3.2.20 If, again, jurisprudence concerning the correction of a withdrawal of the application were taken into account, the catalogue of criteria or prerequisites used in J 19/03 would be illustrative of the resulting unpredictability, including the difficulty for third parties to rely on a withdrawal. More than just listing a great number of criteria or prerequisites partly inconsistent with other catalogues of criteria, a reservation is made that the listed prerequisites "are

not exhaustive". Moreover, an instruction is given that "the balance of interest has to be determined in each case on the basis of its own facts". Concerning two of the criteria, the Board in J 19/03 admitted that it had to consider them "although these requirements are not mentioned in Rule 88 [Rule 139], first sentence EPC at all" (Reasons 7, item f).

- 3.2.21 Common to the mentioned jurisprudence is the concern for the protection of the value of legal certainty. But the smorgasbord of lists and conditions is neither convincingly founded nor easy to apply. Predicting an outcome is even more difficult.
- 3.2.22 From a systematic and teleological point of view, the changing jurisprudential conditions, the legal bases of which are not clear, seem inadequate to properly protect legal certainty - a value rightly described as "fundamental" and "superordinate" in the jurisprudence of the Boards of Appeal (T 824/00, Headnote I; T 309/03, Reasons 2.5).
- 3.2.23 The issue of withdrawal of a withdrawal of the appeal is existential in an *ex parte* case (or an *inter partes* case if the patentee is the sole appellant). Substantively speaking, it is about life or death of the file. The appropriate way to protect the high value of legal certainty on a matter of such gravity, had it been intended, would have been to define precisely, by legislation, the limited circumstances and conditions, presumably including time limits and a fee requirement, under which the "true" intention of the party may exceptionally take precedence (cf. Articles 112a and 122, Rules 104 to 110 and 136 EPC; T 824/00, Reasons 6).

- 3.2.24 This is certainly not the case with Rule 139 EPC.
- 3.2.25 A further systematic and teleological reflection concerns the juxtaposition of the appellant's withdrawal of the appeal in writing, as opposed to orally. Either way, the proceedings are immediately terminated, and the interests of stakeholders are, or should be, equally affected regardless of the format of the declaration. Still, were Rule 139 EPC applicable, the question would have to be asked why the procedural declaration of withdrawing the appeal would be treated more leniently if nailed down in a document and filed in writing than if made orally. From a wider legal perspective that would seem inconsistent, if not inverted.
- 3.2.26 The quite elaborated preconditions listed also run the inevitable risk of soon becoming irrelevant, e.g. by not adequately responding to the technological, administrative and organisational developments, such as digitalisation, within the EPO and in society at large.
- 3.2.27 Measured against this series of systematic and teleological concerns, the party's argument that the open wording of Rule 139 EPC makes sense as it is impossible to foresee every mistake weighs light.
- 3.2.28 By the same token, any identity between the effects of a withdrawal of the appeal and of the application, as asserted by the party, would not persuade the Board. For the purposes of these proceedings, it can thus be left open to what extent such effects correspond.
- 3.2.29 More compelling than these arguments is the finding in the early jurisprudence of the Boards of Appeal that the placing of Rule 139 EPC, then Rule 88 EPC 1973,

only in the Implementing Regulations "*raises the presumption that it is a merely ancillary provision which can only be applied while proceedings are pending for some other purpose before the [EPO], and that Rule 88 does not confer original jurisdiction on the [EPO] to make corrections at any time*" (see J 42/92, Reasons 4).

- 3.2.30 J 42/92 deals with the attempt by the patentee to use the instrument of correction to amend the text of a granted patent. The present Board admits that this is something else than what is now discussed, as noted by the party. However, the third-party interests at risk are similar. This makes relevant the view taken in J 42/92 on Rule 139 EPC that not only its applicability but also the Board's jurisdiction, i.e. its competence (cf. points IX and 1 above), ends when the pendency of the underlying proceedings ends (Reasons 10).
- 3.2.31 As far as this Board is aware, however, such basic concerns about the pendency of proceedings in respect of the correction of a withdrawal of the appeal (or the application or a designation for that matter) are unprecedented.
- 3.2.32 The Board's view on the applicability of Rule 139 EPC is also not prejudiced by the conclusions of G 1/12, on the contrary. In an *obiter dictum*, the Enlarged Board (Reasons 34 and 35) made the following remarks (Board's underlining):

"Rule 139, first sentence, EPC allows the correction of 'linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office'. This list and the rule's heading ('Correction of errors in documents

filed with the European Patent Office') make clear that the rule 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.

Since it applies to any document filed with the EPO, the Enlarged Board of Appeal sees no reason why it should not apply to appeals."

- 3.2.33 By the use of the word "cases" in the first quoted paragraph, and by the context in which that remark was made, namely a case in which the notice of appeal had been filed with erroneous name and address details, it appears that the remark presupposes the existence of a *pending* case, i.e. of pending proceedings. At the very least, such an interpretation cannot be excluded.
- 3.2.34 The party's view that the Enlarged Board's remark that Rule 139, first sentence, EPC deals with cases in which "an error of expression in a declaration" ("fehlerhafte Ausdrucksweise in einer Erklärung"; "faute d'expression dans une déclaration") has occurred is a reference to content is not persuasive. Already the language, i.e. "expression", suggests that the error relates to *how* the content was conveyed, not to the *content* itself. This makes all the more sense, given the appearance that said remark bundles and interprets the editorial-sounding terms "linguistic errors" and "errors by transcription". It follows that this remark seems to limit the scope of the first sentence, as to "declarations", to *how* their content was conveyed.
- 3.2.35 Moreover, the word "appeals" used in the last quoted paragraph should, in its context, reasonably be understood as "notices of appeal". In any event, the

party's reading of "appeals" so broadly as to cover the very specific and consequential act of a withdrawal of the appeal seems unrealistic.

- 3.2.36 In any event, as an *obiter dictum* answer to a referral question that in the end was superfluous, the remark cannot be expected to have undergone the same level of analysis and scrutiny as a statement forming part of the *ratio decidendi* (see e.g. T 574/17, Reasons 2.3.7 and 2.3.8).
- 3.2.37 To sum up, and respond to, the party's remaining arguments: neither of the two cases, i.e. T 2148/18 and G 1/12, invoked to support the applicability of Rule 139 EPC is thus a convincing basis. The Board is also not bound by the substance, not even indirectly, of the Enlarged Board's view, citing CLBA, section V.A.7.3.7, that the success of the request for correction could not be ruled out *a priori* (cf. Article 112a and Rules 104 to 110 EPC and Article 21 RPBA 2020 *e contrario*; see CLBA, V.B.3.4.3, second paragraph).
- 3.2.38 Moreover, as laid out above, the "safeguards" offered in T 2148/18 do not assure this Board. Nor do the varying safeguards appearing in other decisions "point[ing] in the same direction" (which in any event do not relate to the withdrawal of the appeal). Given all the other stakeholders, the Board also does not agree that it would "only be fair" to apply Rule 139 EPC.
- 3.2.39 Due to the inapplicability of Rule 139 EPC as such, it is irrelevant which sentence(s) would be the pertinent one(s); whether the present circumstances and those of T 2148/18 are similar; how recent T 2148/18 is; whether

a mistake was made and, if so, whose fault it was. Likewise, it is immaterial when the letter requesting correction was sent; whether third parties were actually affected; and what the party's "true" intention might have been.

3.2.40 For all these reasons, the ordinary meaning to be given to the terms of Rule 139 EPC, in their context and in the light of the EPC's object and purpose, when interpreted in good faith in view of the interests of all stakeholders concerned, includes the implicit, limiting condition that a linguistic error, an error of transcription or a mistake in a document filed with the EPO may only be corrected, if proceedings before the EPO for some other purpose are pending when the request for correction is received by the EPO.

3.3 ***Ordinary meaning of Rule 139 EPC applied to this case***

3.3.1 The Enlarged Board understood the request for correction as having been filed only with the letter of 5 October 2021 (R 3/22, point VII). The Board agrees. But even if the Board were to share the party's view expressed in said letter (page 1, second paragraph), that "[t]he request of correction was promptly filed on 29 September 2021 [...]", this would not make any difference. Because either way, and this is undisputed (cf. point 3.1.6 above), the appeal proceedings were then no longer pending.

3.3.2 Rule 139 EPC is thus not applicable to the present request for correction of the withdrawal of the appeal. In line with the conclusion drawn in case T 1244/08, such a request is inadmissible (see Reasons 4, last paragraph: "... une requête postérieure tendant à la rétractation de cette déclaration et visant la

poursuite de la procédure de recours est irrecevable.";
emphasis added).

- 3.3.3 The board is certainly aware that the conclusions drawn in the present decision deviate from those of the two decisions relating to a withdrawal of the appeal referred to in the CLBA section cited by the Enlarged Board in R 3/22 (see point 3.2.11 above), and of the majority of the earlier decisions cited above relating to a withdrawal of the application, a designation, etc.

Pursuant to Article 20(1) RPBA 2020, if a Board deviates from an interpretation or explanation of the EPC given in an earlier decision of any Board, the grounds for this deviation shall be given, unless such grounds are in accordance with an earlier decision or opinion of the Enlarged Board of Appeal according to Article 112(1) EPC, and the President of the EPO shall be informed of the Board's decision. Although apparently in line with the cited decisions of the Enlarged Board under Article 112(1) EPC (see points 3.1.3 and 3.2.32 to 3.2.36 above), the grounds for the deviation are nonetheless set out above and the President of the EPO will be informed of this decision accordingly.

- 3.3.4 For the above reasons, the main request cannot be granted.

4. **Auxiliary request: Pendency of the application**

- 4.1 Since the main request is to be refused, the third question to answer is whether the application was "pending" within the meaning of Rule 36(1) EPC as of the day of the oral proceedings before the Board, i.e. on 3 March 2023. As noted, the party filed divisional

applications relating to the application on 1 October 2021 and 2 March 2023.

- 4.2 It should first be recalled that the EPO's receipt of the withdrawal of the appeal on 28 September 2021 had immediate substantive as well as procedural legal effects. Procedurally speaking, it terminated the appeal proceedings in respect of the substantive issues settled by the refusal of the application. In terms of substance, it rendered the matters subject to that decision *res judicata*, i.e. finally settled (cf. point 3.1.5 above).
- 4.3 Thus, already when the first divisional application was filed, the application was "dead" on the merits. There was nothing from which new shoots could form.
- 4.4 This is entirely different from the situations underlying G 1/09 and J 23/13, where the divisional applications were filed when there was still a possibility that the refusal of the earlier application would be reviewed within the appeal proceedings (cf. G 1/09, Headnote, Facts and Submissions, point II; J 23/13, Reasons 8.3).
- 4.5 The present request for correction under Rule 139 EPC was no self-fulfilling prophecy in the sense that it automatically entailed the re-opening of the appeal proceedings, and in these limited-purpose ancillary proceedings (cf. point 2 above), the request for correction is to be refused. The finality of the settlement on the merits brought about by the withdrawal thus remains. Moreover, since this finality was exclusively in the hands of the party (see point 3.1.2 above), no final decision was needed for

the legal effects to ensue.

4.6 From the ancillary nature and limited scope of these proceedings (cf. point 2 above), it further follows that potential substantive rights associated with the application would only arise if appeal proceedings were re-opened after a finding that Rule 139 EPC was applicable, then after another finding that the request for correction was allowable. This was not the case here.

4.7 Hence, there were no substantive rights, such as the right to file divisional applications under Rule 36(1) EPC deriving from the application in existence when the respective divisional applications were filed, and when, on the day after the second filing, the oral proceedings were held before the Board (cf. G 1/09, Reasons 3.2.3, 3.2.4 and 4.2.4; J 23/13, Reasons 8.2 and 8.3).

4.8 As a result, the application was no longer pending on 29 September 2021 and has not been since (i.e. the application was not pending on the dates when the related divisional applications were filed).

5. **Concluding remarks**

5.1 With regard to Rule 139 EPC, the then applicant/appellant's move to withdraw its appeal on 28 September 2021 was like crossing the Rubicon. There was no going back.

5.2 The Board concludes that, following the above reasoning, and contrary to the Enlarged Board's view set out in R 3/22 (see in particular Reasons 4), Rule 139 EPC is indeed to be understood as ruling out

a priori the success of a former applicant/appellant's request for correction by withdrawing its earlier unambiguous and unconditional withdrawal of the appeal.

- 5.3 A withdrawal of the appeal is an extremely serious procedural step calling for extreme caution (cf. J 4/03, Reasons 2; J 7/19, Reasons 7, regarding a withdrawal of the application). It seems therefore advisable that clients and representatives coordinate it carefully in advance.

Order

For these reasons it is decided that:

1. The request for correction of the withdrawal of the appeal is refused.
2. European patent application No. EP11865564 has not been pending since 29 September 2021.

The Registrar:

The Chair:



B. Brückner

K. Bengi-Akyürek

Decision electronically authenticated