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**Datasheet for the decision
of 3 May 2022**

Case Number: T 1882/19 - 3.4.02

Application Number: 08075808.9

Publication Number: 2045599

IPC: G01N27/74, G01N33/543

Language of the proceedings: EN

Title of invention:

Ultra-sensitive magnetoreduction measurement system and method
for determining the concentration of epitope-biomolecules

Applicant:

MagQu Co., Ltd.

Relevant legal provisions:

EPC Art. 106(1)

EPC R. 103

Keyword:

Reopening of the appeal proceedings after abandonment of the
application (no)

Request to issue an appealable decision by the board (no)

Decisions cited:

J 0006/86, J 0004/03, J 0019/03, J 0007/06, J 0001/11,
J 0006/13, T 2434/09



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Case Number: T 1882/19 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 3 May 2022

Appellant: MagQu Co., Ltd.
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Representative: Arth, Hans-Lothar
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 January 2019
refusing European patent application No.
08075808.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman B. Müller
Members: F. J. Narganes-Quijano
C. Kallinger

Summary of Facts and Submissions

I. The applicant lodged an appeal against the decision of the examining division refusing European patent application No. 08075808.9. In its decision the examining division held that none of the requests then on file complied with the requirements of Articles 56 and 123(2) EPC.

With the statement setting out the grounds of appeal the appellant requested that the decision under appeal be set aside and a patent be granted on the basis of the claims of one of the requests submitted with the statement of grounds of appeal.

II. In reply to the summons to oral proceedings dated 20 July 2021, the applicant, by a letter dated 8 October 2021, submitted a statement reading as follows:

"Herewith the EPO is informed that the Applicant has decided to abandon this patent application."

III. Subsequently, the official communication dated 18 October 2021 set forth that the application was withdrawn by letter dated and received on 8 October 2021. The applicant was informed that the board had instructed the Registrar to notify all concerned that the appeal proceedings were closed without a substantive decision, and that the appeal fee would be reimbursed pursuant to Rule 103(4) (a) EPC.

IV. By a letter dated 2 November 2021 the applicant submitted a statement reading as follows:

"Herewith the EPO is informed that the Applicant has revoked his intention to abandon the [...] application. After considering this long lasting case again, the Applicant has decided to proceed with the present application and the appeal [...]. Thus, it is requested to resume this case and the appeal and to debit the reimbursed amount [...]".

- V. In the communication of the Registry dated 18 November 2021 the applicant was informed as follows:

"It is noted that, by letter dated 8 October 2021, the applicant filed a clear and unconditional statement according to which the application was abandoned, and the applicant was then informed with the official communication dated 18 October 2021 that the application was withdrawn and the appeal proceedings closed. In addition, the public was informed of the withdrawal of the application by the corresponding entry in the European Patent Register.

The board considers that in these circumstances the declaration to abandon the application made on 8 October 2021 cannot be retracted, and that the subsequent statement of the applicant in the letter dated 2 November 2021 according to which they revoked the intention to abandon the application has no legal effect."

- VI. By a letter dated 29 November 2021 the applicant requested as a main request that the appeal proceedings be reopened and, as an auxiliary request, that an appealable decision be issued.
- VII. In a communication dated 3 February 2022 the board presented a preliminary assessment of the requests

formulated by the applicant in its letter dated 29 November 2021.

VIII. By a letter dated 11 March 2022 the applicant submitted claims according to a main request and auxiliary requests 1 to 8 and maintained the requests formulated in the letter dated 29 November 2021.

IX. The arguments of the applicant in support of its request to re-open the appeal proceedings filed in its letters of 29 November 2021 and 11 March 2022 are essentially the following:

With the letter dated 8 October 2021 the EPO was informed that the applicant had decided to abandon the application, and the EPO treated this letter as a withdrawal of the application. However, the applicant had definitively not withdrawn the application. The oral proceedings were cancelled, the appeal proceedings were closed without a substantive decision, and the appeal fee was refunded in part by the board of its own volition, but the applicant had never "requested" the withdrawal of the application and the partial reimbursement of the appeal fee.

The statement in the letter dated 8 October 2021 was not in error, was actually not a withdrawal of the application, and could not be considered as a clear and unconditional "request to withdraw" the application. The intention of the applicant was to inform the EPO that the applicant requested a decision on patentability. The statement in the mentioned letter was, however, wrongly interpreted by the board as the withdrawal of the application, and not as an expression of the applicant's intention to passively allow the application to lapse and not to continue "fighting" for

the application so that a decision on appeal could be made and the applicant would obtain a substantive decision on patentability. Legally, a withdrawal and a refusal were different actions, and the applicant had, in view of the cooperation with a third party, an interest in receiving a decision on patentability of the application, even if the decision was to refuse the application. In addition, even if the request in the letter dated 8 October 2021 left room for interpretation, it could not unambiguously be interpreted as a "request" for withdrawal of the application. Indicative of the applicant's intention was also the fact that the reimbursement of the appeal fee was not requested and that the applicant paid the 14th renewal fee (on 26 October 2021).

Therefore, a "revival" of the application was to be fully considered, together with a reopening of the appeal proceedings so that a decision on patentability could be made by the board on the basis of the requests submitted with the letter dated 11 March 2022.

Reasons for the Decision

1. *Main request*
- 1.1 The board holds that, by letter dated 8 October 2021, the applicant filed a clear and unconditional statement according to which the application was abandoned (*cf.* Nr. II above). That the mentioned statement reflected the true intention of the applicant at that time is confirmed by the statement of the applicant in its letter dated 2 November 2021 that "the Applicant has

revoked his intention to abandon the [...] application" (cf. point IV above), and by the subsequent statement in its letter dated 29 November 2021 (page 2, fourth paragraph) that the statement of abandonment of the application "was not in error by the Applicant or its representative".

1.2 This interpretation of the applicant's statement cannot be called into question by the applicant's submissions. In its letters dated 29 November 2021 and 11 March 2022 the applicant submitted that with the statement in the letter dated 8 October 2021 it had decided "to abandon" the application, but it had "definitively not withdrawn the application", and that the appeal proceedings were closed by the board of its own volition without making and providing a decision. More particularly, the applicant submitted that it had "never requested to withdraw the patent application", that the intention with the statement of abandonment of the application was to only inform the board that the applicant decided not to continue "fighting" for the application so that a substantive decision on patentability could be issued, and that even if the mentioned statement left room for interpretation, it could not unambiguously be interpreted as a "request" for withdrawal of the application. The statement was therefore wrongly interpreted by the board when it treated it as a "withdrawal of the application".

1.3 In respect of these submissions the board notes that the statement in the letter dated 8 October 2021 filed in reply to the summons to oral proceedings was confined to the sentence: "Herewith the EPO is informed that the Applicant has decided to abandon this patent application." This sole sentence does not contain any

limitation or condition, nor are there any other circumstances suggesting any limitation or condition.

- 1.4 The applicant's failure to request a partial reimbursement of the appeal fee and the payment of the 14th renewal fee do not constitute such circumstances.

The board notes, first, that when the board instructed the Registry to notify the applicant that the appeal proceedings were closed, the board also ordered the partial reimbursement of the appeal fee pursuant to Rule 103(4)(a) EPC. A reimbursement of the appeal fee under Rule 103 EPC does not require a request from a party to the appeal proceedings and can be - and in the present case was - ordered by the board of its own motion. For these reasons, the applicant's submission that it had "never requested reimbursement or partial reimbursement of the appeal fee" does not have any influence on the interpretation of the statement of abandonment of 8 October 2021.

Second, against the backdrop of that statement of abandonment and the board's communication dated, and received by the applicant on, 18 October 2021 setting forth that the application was withdrawn on 8 October 2021, the payment of the 14th renewal fee on 26 October 2021 cannot have an impact on the interpretation of the statement of abandonment.

As a consequence, the board does not see any reason for not considering the statement of abandonment of the application as an unqualified and unambiguous notice of withdrawal of the application. Against this backdrop, the applicant's distinction between abandonment and withdrawal of the application to the effect that, with the abandonment of the application, for which the

applicant had decided to no longer "fight", the applicant requested a decision on patentability and expected the board to issue a substantive decision relating to the patentability of the requests on file at the time of the abandonment of the application cannot be accepted.

It is also noted that the applicant's submissions in its letters of 29 November 2021 and 11 March 2022 that the board had misconstrued the statement of abandonment of the application as a withdrawal of the application are at variance with the content of the letter dated 2 November 2021 according to which the applicant "revoked his intention to abandon" the application and "had decided to proceed" with the application. These statements consequently reflect a change of the applicant's intention on how to treat the application rather than a submission contesting the way the board had construed the applicant's statement in the letter dated 8 October 2021. This change of intention has no impact on the legal effect of the statement of abandonment in the letter of 8 October 2021; see point 1.8 below.

- 1.5 A notice of abandonment of the application constitutes a procedural act that triggers legal effects from the date of its reception (in particular, in the present case, the immediate and automatic termination of the appeal proceedings). These effects come into being without any decision made by the board. In particular, contrary to the applicant's submissions, such a notice does not constitute a "request" that the board may allow or not.

- 1.6 The above conclusions are in line with the findings in the decision in case J 6/86 (OJ EPO 1988, 124) where it

was held (in point 4 of the reasons, emphasis added) that

Even if it can be accepted that abandonment is simply taking no action and thus allowing the application to fail by failure to take the necessary procedural steps, nevertheless when, as in the present case, the wish to abandon the application is manifested and communicated to the EPO in writing **without any limitation or condition**, this action may rightly be considered as a completely unqualified and unambiguous notice of **withdrawal**. Even if the formulation does not contain the word "withdrawal", the intent of the applicant has been clearly expressed by his duly authorized representative and is thus **irrevocable**.

1.7 The appeal exclusively concerned the refusal of the application by the examining division on substantive grounds (cf. Nr. I above) and, in these circumstances, i.e. in the absence of any other pending issue in the appeal proceedings (see decision T 2434/09, points 3 to 9), the abandonment constituting a withdrawal of the application leads to the appeal being disposed of and, therefore, to the appeal proceedings being closed. The board agrees with the applicant's submission that a withdrawal and a refusal of the application are legally different actions and may have different consequences for the applicant. However, the withdrawal of the application deprived the present appeal of its purpose and precluded the board from issuing a decision on the merits of the case, and the further submissions of the applicant relating to the interest of the applicant in receiving a decision on the substantive issues of the case, even if the decision were to refuse the application, are therefore not pertinent.

1.8 As regards the statement of the applicant in its letter dated 2 November 2021 that "the Applicant has revoked his intention to abandon the [...] application", the board notes that according to the established case law

an applicant is bound by its procedural acts notified to the EPO provided that the procedural act is - as it is the case here - unambiguous and unconditional and - with the possible exception of statements submitted erroneously (Rule 139 EPC) - the applicant is not allowed to reverse these acts so that they can be considered as never filed (see, for instance, decision J 19/03, point 5 of the reasons, and the decisions cited therein). Therefore, the subsequent revocation of the intention to abandon the application and the requested retraction from the applicant's procedural act dated 8 October 2021 do not have any legal effect.

It is also observed that, prior to the submission of the letter dated 2 November 2021, the public was informed of the withdrawal of the application on 8 October 2021 by the corresponding entry in the European Patent Register. According to numerous decisions of the boards of appeal a correction under Rule 139 EPC of an erroneous or unintentional procedural act implying the withdrawal of an application depends, among other criteria, on the absence of an official notification to the public of the withdrawal (see, for instance, decisions J 4/03 (points 8 to 17), J 19/03 (*supra*, points 3 to 7), J 7/06 (points 3 to 7), J 1/11 (points 3 to 12 of the reasons), J 6/13 (points 3 to 8 of the reasons, and decisions cited therein). What would be applicable in the case of a request for correction of a procedural act under Rule 139 EPC applies the more so to a (non-erroneous) procedural act followed by a retraction from the same due to a change of mind of the applicant (see decision J 19/03, *supra*, point 9 of the reasons).

1.9 The board interprets the applicant's request to reopen the appeal proceedings so that a decision on

patentability can be issued by the board as a request for the grant of a European patent. In view of the above considerations according to which the European patent application was abandoned and thereby withdrawn and hence is no longer pending, the applicant's request has no object and therefore is not allowable. Consequently, the claims of the main and the auxiliary requests filed with the letter dated 11 March 2022 cannot be considered.

2. *Auxiliary request*

According to Article 106(1) EPC ("Decisions subject to appeal"), first sentence, "[a]n appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division.". The decisions of the board of appeal are not specified in this article. In addition, there is no express legal basis in the EPC for lodging an appeal against decisions of the boards of appeal or for the present board to issue an "appealable decision". In these circumstances, the board is in a position to deliver a decision addressing the applicant's main and auxiliary requests, but not a decision subject to appeal according to the applicant's auxiliary request.

For these reasons, the board cannot accede to the auxiliary request of the applicant that the board issue an appealable decision.

Order

For these reasons it is decided that:

The request for reopening of the appeal proceedings and grant of a European patent is refused.

The Registrar:

The Chairman:



L. Gabor

B. Müller

Decision electronically authenticated