

Publication in the Official Journal Yes / No

File Number: T 677/90 - 3.3.1

Application No.: 84 308 973.1

Publication No.: 0 154 092

Title of invention: Process for the preparation of 2,4-Dihydroxybenzophenonen

Classification: C07C 49/83

DECISION
of 17 May 1991

Proprietor of the patent: GAF Corporation

Opponent: BASF AG

Headword:

EPC Article 111(1)

Keyword: "Patent revoked as consequence of Patentee stating "Patentee does not wish to maintain the Patent"

Headnote



Case Number : T 677/90 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal
of 17 May 1991

Appellant :
(Opponent)

BASF AG, Ludwigshafen
-Patentabteilung-C6-Carl-Bosch-Str. 38
D-6700 Ludwigshafen

Representative :

Respondent :
(Proprietor of the patent)

GAF Corporation
1361 Alps Road
Wayne, NJ 07470
US

Representative :

Ford, Michael Frederick
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Great Britain

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 11 July 1990 rejecting the
opposition filed against European patent
No. 0 154 092 pursuant to Article 102(2) EPC.

Composition of the Board :

Chairman : K. Jahn
Members : J. Jonk
C. Holtz

Summary of Facts and Submissions

- I. In a decision dated 11 July 1990 the Opposition Division rejected the Opposition filed against European patent No. 0 154 092 granted upon the subject-matter of European patent application No. 84 308 973.1.
- II. The Appellant (Opponent) appealed against the decision and filed a Statement of Grounds in which he requested that the patent be revoked.
- III. In a letter dated 19 April 1991 the representative of the patent proprietor stated i.a. "The patentees have decided for commercial reasons that they do not wish to maintain this European patent", adding that they would not file any submission nor defend the appeal. In a second letter dated 8 May 1991 (upon enquiry from the Registry of the Boards of Appeal) the representative stated i.a. "In order to deal with the matter in an expeditious manner, the patentees will not object if the Appeal Board sees fit to revoke the Patent without further consideration".

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. Regarding the possibilities and/or limitations for patentees wishing to waive their patent rights ab initio, i.e. to ensure that no rights remain, not even for the period from the filing of the application to the grant of the patent, or to the date when the revocation took effect,

the development within the EPO of a principle has undergone several separate stages, taking into account various issues of importance as they arose.

At an early stage in the history of the EPO it was established that a patent has to be revoked, if the patentee states in opposition procedures that he no longer approves the text in which the patent was granted (Legal Advice No. 11/82, OJ EPO 1982, 57 and T 73/84, OJ EPO 1985, 241). This has been confirmed by various later decisions, i.a. T 186/84, OJ EPO 1986, 79).

T 186/84 took a further step in developing principles regarding revocation at the request of the proprietor. The Board of Appeal in that decision held that a request for revocation was in substance the same as stating disapproval of the text of the patent as granted. This caused any substantive examination of the grounds for opposition to become superfluous as well as impossible, since there was no longer any valid text of the patent.

Another aspect of this issue was addressed in T 237/86, OJ EPO 1988, 261, i.e. the question of how to ensure that the intention of the proprietor is correctly interpreted by the EPO so as not to lead to revocation against his will. The decision held that a statement saying "we herewith abandon the above patent" was equivalent to a request for revocation. A statement to the effect that the subject application was "withdrawn" was in T 264/84 interpreted as meaning that the patentee no longer wished his patent to be maintained and thus as a request for revocation. The same interpretation was given to the same wording by another Board in T 415/87 of 27 June 1988 (not published). The principle which thus far had emerged was confirmed in T 459/88, OJ EPO 1990, 425 where this Board noted that

there could scarcely be any more cogent reason for revoking a patent, since it cannot be in the public interest to maintain a patent against its proprietor's will, furthermore both parties to the proceedings had agreed to the revocation.

It is fair to conclude, then, that 1) revocation on request by the proprietor was established routine procedure and 2) that no matter the wording of such a request, if it could be interpreted as a clear request for revocation, the EPO would act accordingly.

3. The issue to be solved in the present case is, whether or not the intention of the proprietors is clearly expressed in a way to leave no doubt that he wants his patent revoked. In this regard the Board would like to observe that, given the first letter, there seems to be no doubt, since the patentees have used the formula accepted in earlier cases, i.e. the patentees "do not wish to maintain this European patent". Further, this was confirmed by the statement in the second letter that the patentees would not object to revocation without any further consideration.

All in all, given the express intention that the patentees do not wish their patent to be maintained, which was not retracted by the second letter, the Board finds that the statement taken together have to be construed as meaning that the Respondent agrees that the patent be revoked (cf. decision T 92/88 of 19 July 1991, not published).

4. The Board can, therefore, in the exercise of its power under Article 111(1) EPC decide to revoke the European patent (see Decision T 237/86, OJ EPO 1988, 261).


Order

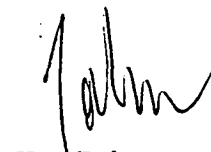
For these reasons, it is decided that:

The decision of the Opposition Division dated 11 July 1990 is set aside and European patent No. 0 154 092 is revoked.

The Registrar:

The Chairman:


E. Görgmayer


K. Jahn