

Publication in the Official Journal ~~Yes~~ / No

File Number: T 823/90 - 3.2.4

Application No.: 85 202 087.4

Publication No.: 0 188 843

Title of invention: Device for applying a closing strip and a cassette therefor

Classification: B65B 67/06

D E C I S I O N
of 10 December 1991

Applicant: Novem Trading international B.V.

Opponent: Henkel Nederland B.V.

Headword:

EPC

Keyword: "Formalities Officer no longer responsible on the date the decision was taken (cf. section 1)";
"the Proprietor is entitled to modify a request before a decision is taken (cf. section 3)";
"a decision should take into consideration all requests made before the decision is taken (cf. section 1)"

Headnote



Case Number : T 823/90 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 10 December 1991

Appellant :
(Proprietor of the patent)

Novem Trading International B.V.
Beursplein 37
NL - 3011 AA Rotterdam (NL)

Representative :

Schumann, Bernard Herman Johan
OCTROOIBUREAU ARNOLD & SIEDSMA
Sweelinckplein 1
NL - 2517 GK The Hague (NL)

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dispatched on 23 July 1990 revoking
European patent No. 0 188 843 pursuant to
Article 102(1) EPC.

Composition of the Board :

Chairman : C.A.J. Andries
Members : M.G. Hatherly
J.C.M. De Preter

Summary of Facts and Submissions

- I. The mention of the grant of the patent No. 0 188 843 in respect of European patent application No. 85 202 087.4 filed on 16 December 1985 was published on 26 April 1989.
- II. Notice of opposition was filed by Henkel Nederland B.V. on 25 January 1990. On 2 March 1990 a copy of this notice was communicated to the Representative of the Proprietor of the patent with a request to file observations within a period of four months.
- III. With letter dated 21 June 1990 the Representative wrote to the European Patent Office at its branch at The Hague as follows:

"The patentee requested me to inform you about the disapproval of the text in which the patent was granted and that an amended text will not be submitted. A revocation of the patent is requested."

This letter was received by the Office at The Hague on 21 June 1990 and transmitted to the Office in Munich where it arrived on 27 June 1990. On 25 June 1990, the Representative wrote to the Office in Munich by facsimile (the letter of confirmation being received on 26 June 1990) that, contrary to his letter of 21 June 1990, the Patentee had meanwhile decided to continue with the European patent and the Representative requested that the content of his letter of 21 June 1990 be ignored. He added that a reply to the communication of 2 March 1990 would be duly filed.

The Representative stated in his letter of 29 June 1990 that negotiations were taking place between the Patentee and the Opponent and requested an extension of time limit

by two months as insufficient information was available for drafting a full response to the notice of opposition.

- IV. On 23 July 1990 the Formalities Officer revoked the patent on the following grounds:

"The proprietor of the patent has himself requested that the European patent be revoked. This request is to be treated as a statement that he no longer approves the text in which the patent was granted. There is therefore no text agreed or submitted by him as stipulated in Art. 113(2) EPC in which the European patent may be maintained within the meaning of Art. 102(3) EPC."

- V. The Proprietor of the patent (Appellant) thereafter filed a notice of appeal on 24 September 1990 and paid the prescribed fee at the same time. In the Statement of Grounds filed on 22 November 1990 it was requested that the decision of the Opposition Division be set aside and that the case be remitted to the Division for continuation of the proceedings.

In this Statement the Appellant put forward that in an early stage of the opposition proceedings the Patentee's and Opponent's attorneys were in the process of negotiating an amicable settlement and that in June 1990 a misunderstanding arose between Mr A.G. Dirkzwager, acting for the Patentee, and the Representative.

Mr A.G. Dirkzwager instructed the Representative in a manner which he, Mr Dirkzwager, took to be to the effect that, in view of the promising outlook for a settlement in the opposition dispute, no costs should be made for the prosecution of the opposition proceedings and no answer to the notice of opposition should be filed. The Representative, however, understood the instructions to be to the effect that the action in defence of the patent

should be discontinued. This misunderstanding led the Representative to write to the EPO as he did in the letter of 21 June 1990. The Representative sent a copy of his letter of 21 June 1990 to Mr Dirkzwager, who became aware of a possible mistake on the following day; he immediately contacted the Representative and instructed him to rectify any possible misunderstanding to which the letter of 21 June 1990 might have given rise. Further, the Appellant referred to an affidavit of Mr Dirkzwager of 16 November 1990 and explained that the appeal was based on two grounds:

- (1) The Opposition Division misconstrued the letter of 21 June 1990 in taking it to mean that the Patentee wished that the patent be revoked. The two messages were transmitted in such a manner that the Patentee was entitled to expect the second message would reach the Opposition Division before the first message, or at the outside that both messages would be received simultaneously. Therefore the Opposition Division was obviously incorrect in interpreting the message of 21 June as an unequivocal motion for revocation. Even if the Opposition Division was entitled to view the messages as consecutive motions on the part of the Patentee, then it was not entitled to accept the message of 21 June as an unambiguous and unqualified motion for revocation; where the earlier statement was such as to raise serious doubts as to the actual intentions of the Patentee, the message immediately following it was particularly pertinent to the interpretation of the earlier statement.

- (2) The Opposition Division did not correctly apply the EPC Rules relevant to the withdrawal of notices given in the examination and opposition proceedings before the EPO in (implicitly) disregarding the request

contained in the facsimile of 25 June 1990. So it gave an incorrect application of the Rules defining the latitude which a Patentee has at his disposal for correcting erroneous requests made on his behalf.

The Appellant continued that in this aspect of the case, guidance may be obtained from decision J 10/87, OJ EPO 1989, 323 according to which even a fully unambiguous statement revoking a patent's applicability for a Contracting State may be taken back under Rule 88 under certain conditions, which conditions are fulfilled in the present case.

- VI. By letter of 8 October 1990 the Representative of the (sole) Opponent stated that the opposition was withdrawn.

Reasons for the Decision

1. In the Notice of 15 June 1984 (OJ EPO 1984, 319) of the Vice-President of Directorate-General 2 of the EPO concerning the entrustment to formalities officers of certain duties normally the responsibility of the Opposition Divisions, it is provided under point 23 (not revised or amended by the Notice of 1 February 1989) that the following shall be entrusted to formalities officers:

"Revocation of a European patent during opposition proceedings in accordance with Legal Advice No. 11/82, where the patent proprietor states he no longer approves the text in which the patent was granted and does not submit an amended text or where the proprietor requests that the patent be revoked"

The Formalities Officer, therefore, is responsible in a case where such a request from the Proprietor of the

patent is the sole request on the date the decision is taken. In the present case, however, the situation on the date of the impugned decision was completely different. Indeed on that date a second request had been brought forward by the Proprietor of the patent; with a facsimile dated 25 June 1990 he had requested the content of his first letter be ignored, which implied the withdrawal of his first request.

The Board therefore considers that in the present case, after the arrival of the second request, the Formalities Officer was no longer responsible for the new situation.

Additionally, at the moment the Formalities Officer took the impugned decision, a clear request (the second one) from the patent Proprietor was present in the file, so that the impugned decision had to take also this request into consideration. Thus, the impugned decision to revoke the patent should at least have mentioned the second request and have given grounds for its rejection. Ignoring this clear request, present on the date the decision was made, has to be considered as a substantial procedural violation made by the EPO.

2. Although the letter of 21 June 1990 (first request) was received by the EPO in The Hague and did not reach the EPO in Munich until 27 June 1990, it has to be considered as validly received by the EPO on 21 June 1990. This clear and unqualified letter did not raise any doubts about the actual intentions of the patent Proprietor; a revocation of the patent was unequivocally requested.
3. However - contrary to a surrender of a patent (which can be made for national patent offices) - a request for revocation of a patent, for the reason that the patent

Proprietor no longer approves the text in which the patent was granted, does not bind him and has no immediate effect. It is only by a decision of an Opposition Division (Article 102(1) EPC) or a Board of Appeal (Article 111(1) EPC) that a patent can be revoked. Therefore, if the patent Proprietor withdraws his request for revocation in due time before a decision is taken - as happened in the present case, where the request was promptly withdrawn - an Opposition Division is not entitled to ignore this withdrawal, particularly when - as in the present case - there is no abuse of procedural law (cf. decision T 123/85, OJ EPO 1989, 336, particularly sections 3.1.1 and 3.1.2).

Thus, on the date that the impugned decision was taken, i.e. 23 July 1990, the text of the patent had been approved by the patent Proprietor since 25 June 1990 (second request) and there was no longer any reason to take the letter of 21 June 1990 (first request) into account and to decide to revoke the patent.

4. Under these circumstances it is not even necessary to examine if a request under Rule 88 is allowable, all the more because such a request was not made in the facsimile of 25 June 1990.
5. Due to the procedural violations mentioned in section 1 above, it is equitable to reimburse the appeal fee.

Order

For these reasons, it is decided that:


1. The contested decision is set aside.
2. The case is remitted to the Opposition Division for continuation of the proceedings.
3. The reimbursement of the appeal fee is ordered.

The Registrar:



N. Maslin

The Chairman:



C. Andries

