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D E C I S I O N
of 26 September 2005

Case Number: J 0012/03 - 3.1.01

Application Number: 98924847.1

Publication Number: 1014988

IPC: A61K 31/505

Language of the proceedings: EN

Title of invention:
Treatment of hepatic cirrhosis

Applicant:
Hadasit Medical Research Services & Development Co. Ltd.

Opponent:
-

Headword:
Retraction of withdrawal/HADASIT

Relevant legal provisions:
EPC Art. 127, 129
EPC R. 88

Keyword:
"Correction (retraction) of withdrawal of an application (no) "
"Breach of legitimate expectations (no) "

Decisions cited:
J 0015/86, J 0010/87, J 0015/92, J 0004/97, J 0029/97

Catchword:
-



Case Number: J 0012/03 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 26 September 2005

Appellant:

HADASIT MEDICAL RESEARCH SERVICES &
DEVELOPMENT CO., LTD.
Kiryat Hadassah
IL-Jerusalem 91120, et al (IL)

Representative:

Vuillermoz, Bruno
Cabinet Laurent & Charras B.P. 32 20
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F-69134 Ecully Cedex (FR)

Decision under appeal:

Decision of the Receiving Section of the EPO,
posted 7 November 2002 refusing the request to
retract the withdrawal of the application.

Composition of the Board:

Chairman: J.-C. Saisset

Members: H. Preglau

M. Günzel

Summary of Facts and Submissions

- I. European patent application No.9892484.1 was filed as a PCT application on 22 February 1999.

On 16 May 2002, during the examination procedure the EPO received a fax of the applicants' representative dated 17 May 2002 with the following content:

"... We hereby inform you that the above-mentioned European patent application is to be abandoned. Therefore we request the refund of the examination fee."

- II. By communication dated 11 June 2002 the Receiving Section requested the applicants to submit within one month a document that reproduced the content of the fax of 16 May 2002, complying further with the Implementing Regulations to the EPC and being properly signed. In case of non-compliance in due time, the fax should be deemed not to have been received.
- III. On 17 June 2002 the applicants' representative sent the original of the fax and repeated that he was waiting for the refund of the examination fee.
- IV. In response the Receiving Section informed the applicants by letter dated 12 July 2002 that due to the withdrawal of the application the proceedings were terminated with effect from 16 May 2002 and that the examination fee, the search fee and the renewal fee for the fifth year would be refunded.

V. On 22 July 2002 the applicants' representative sent a fax, stating that the withdrawal was filed erroneously. All that the applicants had wanted was that the renewal fee was not paid by the representative, but in another route. This had not been immediately clear from the instructions received by the representative. The fax was accompanied by a copy of a reminder of the representative to the applicants concerning the falling due of the fifth renewal fee which was resent by the applicant having crossed the box "Do not pay this annual fee".

The representative further submitted that he had interpreted this as being the wish to abandon the application. But in reality the applicants had only wanted to modify the modalities of payment. The representative therefore requested the further prosecution of the application.

VI. The Receiving Section interpreted this request as being a request for correction of an error under Rule 88 EPC and informed the appellants, that with respect to the case-law of the Boards of Appeal the following conditions had to be fulfilled so that Rule 88 EPC might be applicable:

- i. at the time when the applicant applied for the retraction of the withdrawal the public was not officially informed of the withdrawal of the application,
- ii. the erroneous withdrawal was due to an excusable oversight,
- iii. there was no undue delay in seeking retraction,

iv. there was adequate protection for third parties if the correction was allowed.

VII. The Receiving Section was willing to accept that the withdrawal was the consequence of an excusable oversight but could nevertheless not accept the correction as the request was filed after the public had already been informed about the withdrawal and thus conditions i, iii and iv were not fulfilled.

VIII. On request of the applicants the Receiving Section issued an appealable decision dated 7 November 2002. In the reasons it is stated inter alia that the withdrawal was received by the EPO on 16 May 2002 by facsimile with the written confirmation being received on 17 June 2002 and that the withdrawal had been published in the European Patent Bulletin on 24 July 2002, but the information was incorporated in the Register of European Patents at least as from 31 May 2002.

Even if admitting that the publication of the withdrawal took place too early (not waiting for the confirmation copy of the facsimile) the information about the withdrawal of the European patent application would still be expected to appear in the Register of European Patents shortly after the receipt of the confirmation copy on 17 June 2002.

However the retraction of the withdrawal was only received on 22 July 2002 which meant that for nearly one month the public was led to believe that the European patent application No 98924847.1 no longer existed. Furthermore, on-line inspection of the file by third parties between the appearance of the applicants'

confirmation of the withdrawal and its retraction could not be excluded, thus confirming to those parties the information that the application was finally withdrawn.

- IX. Against this decision the present appeal was lodged on 6 January 2003 together with the statement of grounds of appeal. Besides the appeal fee also examination fee, search fee and renewal fee were paid the same day.
- X. The appellants repeated their arguments already brought forward before the Receiving Section. They further submitted that the official publication, i.e. the publication in the European Patent Bulletin, took place only two days after the filing of the request for retraction of the withdrawal so that it was not certain that the public was officially notified of the withdrawal.

He also requested refund of the appeal fee in case the decision of the first instance was reversed.

- XI. In a communication accompanying the summons to oral proceedings the Board informed the appellants about its provisional opinion, particularly that it was not inclined to deviate from the jurisprudence of the Board with respect to the lateness of a requested retraction of a withdrawal pursuant to Rule 88 EPC after the withdrawal had already been published.
- XII. During the oral proceedings the representative of the appellants repeated his written argumentation and placed again emphasis on the fact that the Receiving Section did not wonder why a withdrawal was announced whereas three days earlier the renewal fee had been

paid. He would have expected that the Receiving Section would have tried to find out what was really intended.

- XIII. The representative also referred to decision J 15/86 (OJ EPO 1988, 417) which in substance should be applicable to the case in suit as there had also been a dispute of the appellant's real intention within the meaning of the said decision.

At least as "a matter of mutual confidence" the Receiving Section should have asked for the real intentions of the applicant.

Reasons for the Decision

1. The appeal is admissible.
2. In the view of the Board, the meaning and the circumstances of the appellants' letter dated 17 May 2002 are directly comparable to the situation dealt with in decision J 15/86, points 3 and 4 of the reasons.

The wording "We hereby inform you that the above-mentioned European patent application is to be abandoned. Therefore we request the refund of this fee. We would be grateful if you could confirm us the refund of this fee." expresses the unconditional will to let the application drop. It says not only that the application should be abandoned it also requests the refund of the examination fee, which request confirms the statement of the abandonment of the application.

Thus, in the judgement of the Board the letter dated 17 May 2002 constituted an effective withdrawal of the application.

3. As a general rule it has to be stated that a withdrawal of a European patent application is binding on the applicant (see also Legal Advice from the European Patent Office No. 8/80, OJ EPO 1981, 6). Nevertheless the Boards of Appeal have also allowed corrections of erroneously filed withdrawals by applying Rule 88 EPC under very particular circumstances, i.e. to the extent that the several preconditions mentioned in the decision of the Receiving Section were fulfilled, those preconditions having been formulated over the years in the jurisprudence of the Boards of Appeal (see decisions J 10/87, OJ EPO 1989, 323, J 4/97 of 9 July 1997 not published in the OJ).
4. Whereas it was accepted in the proceedings before the first instance that the withdrawal was filed due to an excusable oversight, the other preconditions mentioned under point VI i, iii and iv were found not to be met.
5. In its argumentation the Receiving Section only concentrated on the fact that the retraction of the withdrawal was filed only after the withdrawal had already been registered in the Register of the European Patent Office. It did not give a reasoning concerning the questions of possible undue delay or an adequate protection which seemed unnecessary in the light of the fact that the filing of the retraction of the withdrawal of the application doubtless took place after the entry into the Register.

6. As already pointed out in the preliminary remarks accompanying the summons to oral proceedings in the present decision the Board follows the permanent jurisprudence of the Boards of Appeal which only apply Rule 88 EPC in a very narrow framework to corrections concerning the retraction of a withdrawal of a European patent application. Therefore **all** (emphasis added) the repeatedly cited preconditions would have to be fulfilled for the Board being able to allow the retraction of withdrawal of a European patent application.
7. The crucial point in the case under consideration is the question whether there has been official information of the public by the time the retraction of the withdrawal was filed. It is undisputed that the retraction of the withdrawal was filed only after the withdrawal had been entered in the Register of European Patents but two days before the publication of the entry in the European Patent Bulletin. What has to be considered therefore is if there might be a difference in the value or effects as to the information to the public by an entry in the Register of European Patents and the publication of those data in the European Patent Bulletin or, in other words, whether the entry in the Register of European Patents has the same official information value as the publication of those entries in the European Patent Bulletin.

The Board shares the opinion expressed in decisions J 14/04 of 17 March 2005 (not published in the OJ) and J 25/03 of 27 April 2005 (not yet published in the OJ). In J 14/04 it is stated, that all important information concerning European patent applications is registered

first in the Register of European Patents, which thus takes precedence over the European Patent Bulletin, since the European Patent Bulletin contains the entries in the Register of European Patents (cf. point 7, forelast paragraph of the Reasons). In J 25/03 it is stated that an entry of a withdrawal of a patent application in the Register of European Patents amounts to its notification to the public as well as a publication in the European Patent Bulletin (cf. point 9 of the Reasons, at the end) and further that a request for retraction of a letter of withdrawal of a patent application is no longer possible if the withdrawal has been mentioned in the European Register of Patents at the time the retraction is applied for if, in the circumstances of the case, even after a file inspection there would not have been any reason for a third party to suspect, at the time of the official notification to the public, that the withdrawal could be erroneous and later retracted (cf. points 10 and 11 of the Reasons).

These decisions make clear that data in the Register and in the Bulletin have to be the same, have same value as to their credibility and have the same legal status as a source of official information. Both are means for the public to get the information needed to know the current status of an application or a patent. Therefore it is the position of the Board that the cited decisions have rightly decided that after publication of the withdrawal, be it in the European Patent Bulletin or in the Register of European Patents, the interest of the public to being able to rely on the information conveyed by these means including file

inspection, has to prevail over the individual interest of the applicant.

8. The appellants based their argumentation also on the criteria of protection of their legitimate expectations. In their view the Receiving Section violated this principle when accepting the withdrawal of the application as such without considering the fact that the fifth renewal fee was paid on 4 of May 2002, that is three days prior to the withdrawal. It could have been expected that the Receiving Section would immediately have become aware of the erroneous character of the withdrawal which could have been easily clarified by a short call to the appellants' representative. As the Receiving Section had not investigated the true intention of the applicants, the appellants argued, it had offended the principle of mutual confidence between the EPO and applicants.
9. In decision J 15/92 of 25 May 1993 (not published in the OJ) the Legal Board held that in the case of a request whose true nature was uncertain the EPO should clarify the matter by asking the party. However, as already mentioned under point 2 the fax containing the withdrawal of the European patent application did not cause any doubts as to the will of the applicant. As this text was clear and concise there was no need for the EPO for any investigations whatsoever.

The person dealing with the declaration of abandonment is not the same as the one responsible for controlling the payment of fees and can therefore not see any link between the two actions. But even if the same person would manage both, a decision to give up an application

despite recent payment of a renewal fee is not illogical or unrealistic. The decision to abandon the application can be influenced by many different circumstances. It can e.g. have become necessary to avoid conflicts with other competitors. Moreover, renewal fees are very often paid by tax firms independently of a new factual scenario which requires immediate actions such as the giving up a patent application.

10. Consequently, as there was no inconsistency, the EPO was under no obligation to question the withdrawal of the application and there was also no violation of the principle of the protection of legitimate expectations.
11. The Board therefore comes to the conclusion that at least one of the preconditions established by the jurisprudence of the Legal Board of Appeal to grant the correction of an error under Rule 88 EPC was not fulfilled and the appeal could thus not be successful.

Under these circumstances there was no need to deal with the question as to whether or not further preconditions for the allowability of corrections under Rule 88 EPC were fulfilled in the case under appeal.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset