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**Datasheet for the decision
of 21 January 2021**

Case Number: J 0005/19 - 3.1.01

Application Number: 15750584.3

Publication Number: 3195675

IPC: H04W72/04

Language of the proceedings: EN

Title of invention:

DEVICE-TO-DEVICE (D2D) PRE-EMPTION AND ACCESS CONTROL

Applicant:

Interdigital Patent Holdings, Inc.

Headword:

Relevant legal provisions:

EPC R. 139

Keyword:

Correction of error - (yes)
Withdrawal of the application

Decisions cited:

J 0004/03, J 0010/87, J 0002/15, G 0001/12, J 0008/19

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

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Case Number: J 0005/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 21 January 2021

Appellant: Interdigital Patent Holdings, Inc.
(Applicant) 200 Bellevue Parkway, Suite 300
Wilmington, DE 19809 (US)

Representative: AWA Sweden AB
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Decision under appeal: **Decision of the Examining Division of
14 December 2018 rejecting the request for
retraction of the withdrawal of the application
under Rule 139 EPC**

Composition of the Board:

Chairman W. Sekretaruk
Members: R. Romandini
B. Müller

Summary of Facts and Submissions

- I. European patent application No. 15750584.3 (hereinafter: the application) was filed as PCT Application No. PCT/US2015/044088 on 6 August 2015. It entered the regional phase before the EPO on 20 February 2017. The examining division issued a first communication pursuant to Article 94(3) EPC dated 10 November 2017, in which the applicant (now appellant) was invited to file observations on a number of substantive matters. Following a request by the applicant, the period for replying to the Article 94(3) communication was extended by 2 months. However, despite the extension, the appellant did not reply to the communication. Instead, with a letter dated 3 May 2019, the appellant withdrew the application and requested that the fees be refunded. A divisional application was filed on 8 May 2018 (No. 18171252). Both the withdrawal of the parent application and the filing of the divisional application were mentioned on the same date, namely on 11 May 2018, in the case file of the parent application. The European Patent Register (hereinafter: "the register") reported the filing of the divisional application without indicating the date on which it was filed.
- II. In a letter dated 14 May 2018 the examining division confirmed that the withdrawal had been received and that 50% of the examination fee was to be refunded pursuant to Article 11(b) of the Rules relating to Fees. A further communication issued on 16 May 2018 confirmed the 50% refund of the examination fee. Finally, in a communication pursuant to Rule 112(1) EPC dated 22 May 2018, the applicant was informed that the above-referenced divisional application would not be

treated as such because the designated parent application had been withdrawn.

- III. On 29 May 2018 the appellant's representative filed a request to "retract" the withdrawal of the application under Rule 139 EPC. It argued that the application was withdrawn due to a mistake. Its true intention had been to file a divisional application first and to withdraw the application afterwards; however, the order of these steps had been mixed up.
- IV. With the decision of 14 December 2018 the examining division rejected the request. The reason given was that, according to the case law of the boards of appeal, a withdrawal could not be retracted once it had been entered into the register. The examining division also noted that, after a withdrawal had been published, third parties could practice the invention. Whether a third party could be discouraged from doing so because a divisional application might have been validly filed was not considered relevant.
- V. On 7 February 2019 the appellant filed the appeal. It requested that the examining division's decision be set aside and that the application be remitted to the department of first instance with the instruction to allow the request of 29 May 2018 to retract the withdrawal of the application and to continue the examination of the patent application.
- VI. The statement setting out the grounds of appeal was filed on 12 April 2019. The reasons underlying the appeal are as follows:

(i) According to the case law of the boards of appeal it was not possible to retract the withdrawal of an

application once third parties had been informed of it by way of publication in the Bulletin or in the register, unless the retraction reached the addressee either at the same time as or before said publication, or unless there was reason to suspect that the withdrawal was made in error.

(ii) In this case the information concerning the withdrawal was available to third parties at the same time as the information concerning the existence of a divisional application. Consequently, at no point in time could a third party have concluded that the subject-matter of the application had been abandoned.

(iii) If a third party had suspected that the application had been withdrawn before the divisional application was filed, the same person would have had reason to suspect that the withdrawal was erroneous.

(iv) For these reasons, allowing the withdrawal to be corrected would not affect the legitimate interests of the public.

VII. The board set out its preliminary opinion on the appeal in a communication dated 19 June 2020.

VIII. Following this communication, with a letter dated 3 December 2020, the applicant filed evidence of which the purpose was to demonstrate the original intention of the applicant. This evidence consisted of a copy of emails exchanged between the US agent representing the applicant and the European representative(s). The last of these emails sent by the US agent contained two requests from the applicant. The first was to file a divisional application for the subject application within the deadline for filing a response to the

communication sent pursuant to Article 94(3) EPC ("please proceed to file a divisional for the subject application by the May 10, 2018 deadline").

IX. The second request was to abandon or withdraw the parent application. The relevant part reads as follows:

"Please be advised the client does not intend to further prosecute the subject application. Please take whatever action is needed in this case to leave the client in the best position under Japanese patent law (e.g. take no further action, express abandonment, etc.)".

The appellant observed in this regard that it was apparent from the context and the recipients of the email concerned that the reference to "Japanese patent law" was in error. The reference shall be read as being to "European patent law".

X. With the same letter dated 3 December 2020 the applicant also submitted new requests to re-establish a situation which reflected its original true intention. At the oral proceedings before the board all of these requests were withdrawn and replaced with a sole request. The new request was that the decision under appeal be set aside and that the withdrawal of EP 15750584.3 be corrected such that it was made on a date between 9 and 20 May 2018.

Reasons for the Decision

1. *Admittance of the new evidence and requests*

1.1 In its communication the board noted that the original intention of the appellant was not immediately apparent from the evidence on file. The burden of proof lay with the appellant to demonstrate that the withdrawal was the consequence of a mistake and not a change of mind. The standard of proof was an enhanced one. Based on the evidence on file, this standard was not met in this case.

1.2 The evidence submitted with the letter dated 3 December 2020 was a response to these statements made by the board. It aimed to show that the original intention was to file a divisional application before the application was withdrawn. The same conclusion applied to the new request filed during the oral proceedings. It was a response to the objections raised at the oral proceedings that the requests on file would not have re-established a situation conforming to the intention of the applicant.

1.3 For these reasons, the board decided to admit both the evidence submitted before the oral proceedings and the new request put forward during the oral proceedings.

2. *Requirements for a correction of a withdrawal*

2.1 According to the case law of the boards of appeal it is possible to correct the withdrawal of an application under Rule 139 EPC. This is true even if the withdrawal has already been published in the register. However, this correction is only possible if it meets the following cumulative conditions:

- (a) the withdrawal did not reflect the true intention of the applicant (existence of a mistake within the meaning of Rule 139 EPC);
- (b) there was no undue delay in seeking its correction (J 04/03, point 9 of the Reasons; J 10/87, point 13 of the Reasons);
- (c) third parties who might have taken note of the withdrawal by inspection of the file would have had reason to suspect that the withdrawal was erroneous (see J 10/08, point 12 of the Reasons; J 2/15, point 13 of the Reasons; J 8/06, point 6 of the Reasons).

2.2 Some decisions by the board have required a further condition to be met, more specifically that the error was due to an excusable oversight (e.g. J 04/03, point 9 of the Reasons; see also J 10/87, point 13 of the Reasons). This board cannot adhere to this case law for the following reasons.

2.3 First, this requirement does not have textual support in the EPC. Rule 139 EPC does not specify the nature of the mistake which is eligible for a correction. This is in contrast to the language of Article 122(1) EPC, which requires an applicant or proprietor to have taken all due care for a right to be re-established (see also J 0008/19, point 2.4.4 (c) of the Reasons).

2.4 Second, the requirement is not supported in the case law of the Enlarged Board of Appeal (EBoA). In the only relevant decision on the matter (G 1/12, OJ EPO 2014, A114, point 37) the Enlarged Board indicated three conditions for a correction to be allowable:

- (a) the correction must introduce what was originally intended;
- (b) the error to be remedied may be an incorrect statement or an omission;
- (c) the request for correction must be filed without delay.

The EBoA decision does not mention excusability of the mistake as a relevant factor in applying Rule 139 EPC, nor does it suggest that the list set out above was not exhaustive.

2.5 Finally, it is true that the boards of appeal have developed a strict approach to requests for correcting the withdrawal of an application. However, protecting the expectations of third parties rather than sanctioning the applicant for its negligence is the primary consideration of this case law. Unlike some national legislation (see, for instance, Section 117A of the UK Patent Act 1977) as well as other provisions of the EPC, such as Article 122(5), the EPC does not provide for intervening rights where a correction is granted under Rule 139 EPC. For this reason, where the correction of a mistake may affect the expectations of third parties, as in the case of an erroneous withdrawal, the case law provides a safeguard: the mistake must be recognisable in order to be corrected. Where this is the case, there is no reason to protect third parties and penalise the applicant. European patent law does not provide a general grace period for filing a patent application after a disclosure; it relies on an all-encompassing notion of prior art and mandatory publication of all applications. A withdrawn application, if published, is prior art that can be quoted against the same applicant for both novelty and inventive step.

2.6 Allowing a correction where the mistake does not fulfil the "excusable" criterion applied in some case law would not significantly enlarge the scope for reversal of a withdrawal. The reasons for third parties to assume that a mistake occurred must result from the public file. Cases in which third parties could not rely on a published, clear and unconditional withdrawal will remain exceptional. This appeal, however, concerns one of them.

3. *Requirements for correction in this case*

3.1 In view of the evidence submitted in the appeal proceedings, i.e. the emails exchanged with the US agent representing the applicant (see points VIII and IX above), the board is convinced that the withdrawal did not reflect the true intention of the appellant. It follows from these emails that the appellant gave the instruction to file a divisional application and to withdraw the parent application.

3.2 In assessing whether the withdrawal was due to a mistake, only the intention of the applicant and not that of the European representative is relevant. The decision to withdraw the application indeed lies with the former and not the latter. Therefore, only the represented party's state of mind matters, and not that of the representative. Exceptions may apply where, from the evidence in the public file, it emerges that the client has given the professional representative the discretionary power to decide whether and what applications to pursue according to procedural contingencies. In that scenario the intention of the European representative may be the criterion for assessing whether or not there has been a mistake, but

in this case there is no evidence of such delegation; the decision to withdraw the parent application and to file a divisional application was made by the appellant (see point 3.1 above).

3.3 Next, the board is satisfied that the request was filed without delay. The communication that the second application could not be treated as a divisional application was issued on 22 May 2018. The request for correction was filed on 29 May 2018.

3.4 Finally, the requested correction would not jeopardise the legitimate expectations of the public. By consulting the register, any third party would have received notice of both events at the same time, i.e. the withdrawal of the parent application and the filing of the divisional application. Subsequently, they could have made only two inferences at the time the withdrawal was published: either that the divisional application had been validly filed or that a mistake had occurred. In neither case could they have relied on the withdrawal as giving the green light to practice the invention. If they had done so, this would have been without proper justification.

3.5 An objection which could be raised against the approach taken by the board in this case is that it creates legal uncertainty. In order to rely on a withdrawal for any business decision it may not be sufficient to check that an application has been withdrawn. A third party would also have to check that no other application filed by the same applicant was pending, the claims of which could cover the same subject-matter as that disclosed in the withdrawn application. Only in the latter situation could a third party rely on the

withdrawal as giving clearance to start practicing the invention.

- 3.6 The board, however, does not consider that the approach taken in this decision would create legal uncertainty. A correction would be possible only if the general requirements were met. Therefore, a mistake within the meaning of Rule 139 EPC must exist, meaning that the withdrawal does not reflect the true intention of the applicant. Furthermore, the correction of the mistake shall not jeopardise the legitimate interests of the public. The specific circumstances of this case are that third parties were informed at the same time that one parent application was withdrawn and one divisional application was filed, without knowing the chronological order of the two events. Regardless of what they may have assumed in light of these circumstances, they would in any case have realised that the invention disclosed in the parent application could still be the subject-matter of a pending application, either because the parent application could be reinstated under Rule 139 EPC, or because the divisional application was effectively filed under Article 76 EPC.

4. *The requested correction*

- 4.1 The original request submitted by the appellant was to set aside the decision under appeal and to reinstate the application. This request, if granted, would lead to a situation in which both the original application and the divisional application would be pending again, but this was not the intention of the applicant, which effectively meant to withdraw the parent application.

4.2 According to the request filed at the oral proceedings the withdrawal will be corrected such that it was made in a period of time between 9 and 20 May 2018. In the board's view the result which this request aims to achieve corresponds to the true intention of the applicant for the following reasons.

4.3 The US agent gave two instructions: first, the instruction to file a divisional application before the deadline of 10 May 2018, and second, the instruction to abandon the parent application. The applicant did not indicate any specific date on which the withdrawal should occur. As a consequence, any withdrawal made on any date after the divisional application was filed would have correctly implemented the second instruction. However, such an active withdrawal was only possible until 20 May 2018. After that date, the parent application would have been deemed to have been withdrawn under Article 94(5) EPC. For this reason the correction requested at the oral proceedings re-establishes a situation which corresponds to the original and true intention of the applicant: indeed, by virtue of its retroactive effect, the correction ensures that the divisional application is deemed to have been validly filed on 8 May 2018, while the parent application is deemed to have been effectively withdrawn afterwards.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The withdrawal of European patent application No. 15750584.3 is corrected such that it was made on a date between 9 and 20 May 2018.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated