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**Datasheet for the decision
of 3 February 2023**

Case Number: J 0003/22 - 3.1.01

Application Number: 16890421.7

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IPC: G06Q30/00, G06Q30/08,
G06Q40/00, G06Q40/04, G06Q40/06

Language of the proceedings: EN

Title of invention:
METHOD AND SYSTEM FOR SEALED BID AUCTIONS

Applicant:
Wang, Kevin Sunlin

Headword:
Correction of an explicit withdrawal/WANG

Relevant legal provisions:
EPC Art. 122
EPC R. 139

Keyword:
Re-establishment of rights - (no)
Correction of error - (no)

Decisions cited:

J 0008/80, J 0010/87, T 0824/00, J 0012/03, J 0025/03,
J 0014/04, J 0018/10, J 0006/13

Catchword:

Once the public is officially informed by an EPO publication of an explicit declaration of withdrawal and without any indication that this declaration might have been erroneous, there is no room for a further balancing of the interests of the general public and the applicant (confirming the settled case law of the boards of appeal, see Reasons 2.2 to 2.13).



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Case Number: J 0003/22 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 3 February 2023

Appellant: Wang, Kevin Sunlin
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 17 November 2021 considering the request for re-establishment of rights inadmissible and rejecting the request for a correction of the withdrawal of the application under Rule 139 EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: P. Guntz
L. Basterreix

Summary of Facts and Submissions

- I. The appellant is trying to remedy the consequences of a declaration of withdrawal of his European patent application No 16890421.7 submitted by his former representative against the appellant's intention. His appeal lies against the examining division's decision of 17 November 2021 (i) holding his request for re-establishment of rights inadmissible and (ii) rejecting an implicit request for a correction of the withdrawal of the application under Rule 139 EPC.
- II. On 13 February 2020, the examining division issued a second communication indicating that the refusal of the application under Article 97(2) EPC should be expected. Oral proceedings were scheduled for 4 June 2020.
- III. A few days earlier, on 7 February 2020, the appellant's Indian representative had instructed the appellant's European professional representative via email as follows:
- "Please do not take any future action for this patent application, as our client do not want to proceed further."*
- IV. Despite the fact that this email, according to the appellant, had to be read in the context of the appellant's search for a new representative who should only handle the payment of renewal fees and although no such order had been given by the appellant or his Indian representative, his European representative, on 19 May 2020, submitted the following declaration to the European Patent Office (EPO):

"...we are informing you that nobody will attend the proceedings ... and the Applicant intends to

WITHDRAW THE ABOVE EP APPLICATION

This letter must therefore be considered an

EXPLICIT WITHDRAWAL

of the above EP Application."

- V. The representative had not informed the appellant or his Indian representative of the summons to oral proceedings, the above-cited letter of 19 May 2020 or the EPO's letter of acknowledgement of the withdrawal dated 25 May 2020. The examining division, having cancelled the oral proceedings, included both letters in the Register of European Patents and closed the file.
- VI. In October 2020, the appellant found out about the unsolicited withdrawal.
- VII. On 25 May 2021, the appellant, having hired a new European representative, filed a request for re-establishment of rights into the time limit to attend oral proceedings. This letter was treated by the examining division also as an implicit request for a correction of the withdrawal of the application under Rule 139 EPC.
- VIII. With the appealed decision, the examining division:
- (i) held the appellant's request for re-establishment of rights inadmissible since the loss of rights was not caused by missing a time limit
 - (ii) rejected the implicit request to correct the letter withdrawing the application for the reason that the withdrawal had been registered and made public in May 2020.

- IX. With the statement of grounds of appeal, the appellant did not further challenge the first part of the decision (i). Remittal to the examining division was requested only if the Board intended to overrule this decision. The appellant submitted arguments why the second part of the decision (ii) should be overruled.
- X. The Board was not convinced by these arguments and issued a preliminary opinion on 27 September 2022. Oral proceedings by means of videoconference were held on 3 February 2023, at the end of which this decision was announced.
- XI. The appellant acknowledges the case law of the boards that, for legal certainty and to protect the general public, an erroneous withdrawal can only be corrected if the withdrawal has not been officially made public either by publication in the Patent Bulletin or by entry into the Register of European Patents.

However, the appellant is of the opinion that this case law should be distinguished from the current circumstances where the appellant has been deprived of his patent application through no fault of his own because of actions contrary to his wishes or instructions taken by attorneys to whom he entrusted the application.

Special reasons for not applying the case law were to be seen in the circumstances of the COVID-19 pandemic, which hit Italy and India exceptionally hard, impeding the flow of information and making meaningful communication between both the appellant's two representatives in these two countries and proper handling of pending cases extraordinarily difficult.

The Board was asked to apply the principle of proportionality and to balance the error committed by a party and the consequences for it, in the case at hand, the entire loss of the patent. The hypothetical risk to a third party relying on the declaration of withdrawal published by the EPO should be outweighed by the loss suffered by the appellant.

Another consequence of the COVID-19 situation was that enterprises fighting for their very existence were, on the one hand, too occupied to consult the Register of European Patent for potential withdrawals of patent applications and could not, on the other hand, trust the correctness of the entries in this register. Deviating from settled case law under these unprecedented circumstances would not prejudice the handling of future cases since it was only under these very special and unique circumstances that the public could not legitimately expect the entries in the European Register to be correct.

In May 2020, the appellant still had legitimate expectations of success; a limitation of the claims to patentable subject-matter could have been performed during oral proceedings. In Russia, South Korea and Japan, patents had been granted on applications of the same patent family.

Having discovered the withdrawal in October 2020, the appellant, lacking knowledge of the procedure at the EPO, was not capable of reacting at once. He first had to seek advice and find, via his US-American representative, a new European representative.

XII. The appellant requested that the decision to refuse his request (i) for re-establishment of rights under

Article 122 EPC and (ii) for correction of the withdrawal of the application under Rule 139 EPC be set aside in its entirety and that the application No 16890421.7 may proceed. Alternatively, the applicant requested that the parts of the decision in relation to either request (i) or (ii) be set aside and that the application No 16890421.7 may proceed.

Reasons for the Decision

1. Request for re-establishments of rights

The Board shares the examining division's view that the request is inadmissible already for the reason that the missed time limit to attend oral proceedings did not lead to the loss of rights. This alone renders the request inadmissible. Under Article 15(8) of the Rules of Procedure of the Boards of Appeal (RPBA 2020), reference is made to the impugned decision, Reasons 9 to 12.

2. Request for correction of the erroneous withdrawal

2.1 Once an explicit and unambiguous withdrawal of a patent application has been made public, there is no basis under the EPC to undo such a declaration.

2.2 The case law of the boards on the correction of erroneous withdrawals is well founded and typically deals with withdrawals declared against the intention and without any fault or with very little fault of the appellant. In all these cases, the consequences of the applicant losing their patent application were severe. This fact, however, did not lead the boards to decide

in favour of the applicant and to the detriment of the general public's trust in the reliability of the Register of European Patents and in the freedom to work an alleged invention that was no longer claimed by an applicant.

2.3 A withdrawal being "erroneous" implies that it does not express the true intention of the applicant (J 8/80).

2.4 Since decision J 10/87, requests for retraction of the withdrawal of an application as a whole have only been held allowable under Rule 88 EPC 1973 and later under Rule 139 EPC 2007 if the public had not been officially notified of the withdrawal by the EPO at the time the retraction of the withdrawal was applied for.

2.5 Since decision J 25/03 (referring to decisions T 824/00 and J 14/04), it is established case law that an entry in the Register of European Patents renders a declaration of withdrawal public in the same way as a publication in the Patent Bulletin.

2.6 The mentioned decisions already balance the interests of the general public and the applicant. They came to the conclusion that until the public is officially informed by an EPO publication, the applicant's interest in correcting an erroneous withdrawal should prevail. This ceases being the case when the public may rely on an officially published declaration of withdrawal, at least where the file does not contain any indication that this declaration might have been erroneous.

2.7 In the case at hand, there is an explicit, unconditional and unambiguous declaration of withdrawal, and there is nothing to suggest to the public that any potentially diverging intent of the

appellant exists.

- 2.7.1 The renewal fee for the fifth year had been paid many months in advance. Thus, even if this could have been seen by the public, it would not contradict a later decision to withdraw the application. In case J 12/03, Reasons 9, not even a payment three days before the withdrawal was accepted as casting sufficient doubt.
- 2.7.2 The same holds true for the reasonable expectations of a patent to be granted (see J 18/10 and J 6/13). Such prospects were even questionable in the case at hand. Given that the examining division's second communication was again negative, any observer familiar with the case law of the boards would see the withdrawal as a reasonable action since applications containing almost no technical features except that a computer was used to implement the claimed method and system normally have little chance of being found inventive.
- 2.7.3 In this respect, the law under the EPC fundamentally diverges from other jurisdictions that allow for the patenting of mere business methods and the like. Thus, the fact that patents have been granted on parallel applications in Russia, South Korea and Japan is of little significance for whether neutral observers would have held the withdrawal of the application in response to the negative communication unreasonable to an extent that they would have suspected the withdrawal to have been made erroneously.
- 2.7.4 Thus, no observer having read the declaration of the appellant's former representative would have doubted the appellant's intent to withdraw the application,

which had been expressed twice in capital letters.

2.8 The fact that the error occurred without any fault of the appellant does not qualify as exceptional circumstances that would justify differentiating the case at hand from the settled case law. The applicant not being responsible for a mistaken withdrawal is the rule rather than the exception since the second prerequisite for a correction under J 10/87 reads "the erroneous withdrawal is due to an excusable oversight". Most cases deal with errors caused by representatives misinterpreting or ignoring orders of their clients, confounding cases or the like. Thus, the Board sees no reason and no basis to diverge from the settled case law and balance the interests of the general public and the appellant in a way that the latter's loss should outweigh the protection of the general public and its expectation that an explicitly withdrawn application remains withdrawn.

2.9 Nor can the fact that communication between the appellant, his Indian representative and his European representative became difficult due to the pandemic in early 2020 lead to a different conclusion. It has not been submitted that the European representative made any attempt to reach the Indian representative before withdrawing the application. It has also not been submitted that email communication was interrupted for three months between 7 February 2020 when the European representative was instructed not to take any future action for the patent application and 19 May 2020 when he submitted the declaration of withdrawal. Even if this had been the case, the unavailability of instructions could maybe explain an inactivity of a representative but not the taking of an unsolicited action. Thus, the pandemic cannot be seen as the cause

for the withdrawal.

2.10 Moreover, the EPC has rules on the consequence of general dislocations in the delivery or transmission of mail (Rule 134(2) EPC leading to an extension of periods) and on the consequence of re-establishment of rights after having missed a period (Article 122(5) EPC protecting the legitimate expectation of the public that a published loss of rights has led to an invention becoming public domain). But the EPC does not have any provision to safeguard the legitimate expectation of the public that an explicit declaration of withdrawal of an application submitted in the name of applicants by their representatives and published by the EPO is correct. It is questionable whether there is room for the concept of analogous application of a provision in the law of international treaties. Even if this question were answered in the affirmative, there would at least be no possibility to apply the very specific provision of Article 122(5) EPC analogously here. Thus, the lawmaker's decision to not provide a similar provision for the correction of unintended submissions under Rule 139 EPC has to be acknowledged, and it has to be accepted that, as a consequence, the case law of the boards gives priority to the protection of the public over the loss suffered by an applicant in whose name a mistaken statement of withdrawal was submitted.

2.11 Finally and contrary to the appellant's submission, it cannot be assumed that due to the pandemic the public had not taken notice of the withdrawal between 19 May 2020 and 25 May 2021 (a period of more than a year) before the appellant submitted his request for re-establishment which could as well be interpreted as a request for correction under Rule 139 EPC.

2.12 There is also no basis to assume that the public during the pandemic could not and did not trust in the correctness of the Register of European Patents.

2.13 Thus, the Board has come to the conclusion that once the public is officially informed by an EPO publication of an explicit declaration of withdrawal and the file does not contain any indication that this declaration might have been erroneous, there is no room for a further balancing of the interests of the general public and the applicant. Therefore, the intensity of the latter's loss, how many persons really relied on the correctness of the Register and whether the appellant should have reacted immediately after having discovered the unsolicited declaration of withdrawal in October 2020 are not decisive in the case at hand.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated