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**Datasheet for the decision
of 23 January 2023**

Case Number: T 2474/19 - 3.4.03

Application Number: 09762206.2

Publication Number: 2300994

IPC: G07F7/04, G07D7/00

Language of the proceedings: EN

Title of invention:

DOCUMENT HANDLER CAPABLE OF PROTECTING A BUILT-IN SENSOR FROM
EXTRANEIOUS SUBSTANCE

Applicant:

Japan Cash Machine Co., Ltd.

Headword:

Relevant legal provisions:

EPC R. 139

EPC Art. 112(1) (a)

Keyword:

Correction of withdrawal of appeal - relevant person
committing the error - actual intention of the relevant person
- relevant error within the meaning of Rule 139, first
sentence, EPC - (no)
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0008/91, G 0001/12, R 0003/22, J 0019/03, J 0005/19,
J 0007/19, J 0008/19, T 0610/11, T 0317/19, T 1000/19,
T 1474/19, T 0444/20, T 0071/21

Catchword:



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Case Number: T 2474/19 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 23 January 2023

Appellant: Japan Cash Machine Co., Ltd.
(Applicant) 3-15, Nishiwaki 2-chome
Hirano-ku
Osaka-shi
Osaka 547-0035 (JP)

Representative: Flach Bauer & Partner
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 2 April 2019
refusing European patent application
No. 09762206.2 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: G. Decker
A. Böhm-Pélissier

Summary of Facts and Submissions

- I. The appeal is against the decision of the examining division refusing European patent application No. 09 762 206 for lack of inventive step.
- II. After the appellant had filed notice of appeal and a statement setting out its grounds of appeal, the board issued a summons to oral proceedings and a communication under Article 15(1) RPBA 2020. In this communication, the board set out its preliminary opinion that the appeal was without merit.
- III. In response to the board's communication, the appellant's Japanese representative wrote the following email to the appellant's professional representative acting in the appeal proceedings:

"Our client's decision has been made on the abandonment of the above-identified case that will lead to the nonappearance to the oral proceedings and non-submission of the response to the oral hearing. Instead, they have also decided the filing a new patent application divided from the above-identified case.

To this end, we will send you new claims for the division before the end of this week to be filed before October 17, 2022."

- IV. By letter dated 17 October 2022, received by the EPO on the same day and published in the European Patent Register on the following day, the appellant declared that it was withdrawing the appeal.

- V. By letter dated 19 October 2022, received by the EPO on the same day and published in the European Patent Register on the following day, the appellant declared that it was retracting its "request" to withdraw the appeal. It requested a correction under Rule 139 EPC because the "request" to withdraw the appeal had been filed erroneously. It also requested a decision based on the file.
- VI. By letter dated 21 October 2022, the appellant provided further arguments supporting its correction request. As an auxiliary measure, it requested that the case be referred to the Enlarged Board of Appeal. The purpose of the referral was to clarify the fundamental question of whether or not automated entries in the European Patent Register immediately after receipt of parties' submissions, such as the entry of the appellant's withdrawal letter, constituted an official public notification.
- VII. In reply, the board set out its preliminary opinion that the appellant's requests should be refused. In response to this, the appellant provided further arguments supporting its case.
- VIII. The appellant's arguments, where relevant to the present decision, can be summarised as follows:
- (a) The appellant's actual intention was to abandon the case by not attending the oral proceedings and not replying to the board's communication, and to file a divisional application. This could be inferred from the email of the appellant's Japanese representative (see section III above).

- (b) The actual intention of the professional representative was to carry out the instructions received from the appellant's Japanese representative, i.e.:
- to file a letter informing the board that the appellant did not intend to attend the oral proceedings
 - to file a divisional application after filing the above letter, as the application would then still have been pending.
- (c) The error committed by the professional representative was to instruct the paralegal in charge to draft the submission to withdraw the appeal, contrary to their actual intention as set out in section VIII.(b) above. The error thus occurred in the act of making the declaration. Furthermore, the error happened due to an excusable oversight.
- (d) Instructing the paralegal to draft the letter, signing it and filing it with the EPO did not in itself rule out an erroneous declaration. If that were the case, then Rule 139 EPC would hardly have any regulatory content as any document filed with the EPO has been drafted according to instructions, signed and filed by a professional representative.
- (e) By entering the withdrawal of the appeal in the European Patent Register, the public had not been officially notified of the withdrawal. The interests of third parties who might have taken note of the withdrawal by file inspection were adequately protected.

Reasons for the Decision

1. By letter dated 17 October 2022, the appellant unambiguously and unconditionally withdrew the appeal. This withdrawal was not a "request", as per the wording of the appellant, but a binding procedural declaration with the immediate effect of terminating the appeal proceedings. At the same time, the substantive issues settled by the contested decision at first instance became final (see G 8/91, OJ EPO 1993, 346, Reasons 11.2 and 12). As a further consequence, the appeal proceedings were closed without a substantive decision.

2. *Request for correction of an error, Rule 139, first sentence, EPC*

 - 2.1 To reverse the consequences of the withdrawal of the appeal as set out above, the appellant filed a request for correction of the withdrawal under Rule 139, first sentence, EPC two days after the withdrawal.

 - 2.2 As underlined by the Enlarged Board of Appeal in decision R 3/22, Reasons 4, an appellant's request for correction of withdrawal of the appeal under Rule 139, first sentence, EPC is a relevant request within the meaning of Rule 104(b) EPC. Consequently, the board concerned may no longer consider the proceedings closed if such a request is filed; instead it must decide on it.

 - 2.3 According to Rule 139, first sentence, EPC, "*[l]inguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request*".

- 2.4 Relevant errors within the meaning of Rule 139, first sentence, EPC
 - 2.4.1 In G 1/12, OJ EPO 2014, 114, Reasons 34, the Enlarged Board of Appeal pointed out that the list in the wording of Rule 139, first sentence, EPC and the rule's heading ("*Correction of errors in documents filed with the European Patent Office*") make it clear that the rule deals with cases in which an error of expression in a declaration has occurred, or in which a mistake in a document is the consequence of (such) an error. Such concrete errors can only occur when the declaration is actually being made (see also T 71/21, Reasons 6.4.2).
 - 2.4.2 Consequently, errors in the run-up to the declaration being made, such as errors relating to the general motivation for the declaration, the decision-making process or the assumptions on which the declaration is based, are irrelevant (see J 7/19, Reasons 4 to 6; T 71/21, Reasons 6.4.2).
 - 2.4.3 Moreover, the principle of legal certainty requires the limitation set forth in the last point. Since errors in the run-up to the declaration are not objectively identifiable in the specific declaration itself and are thus hardly verifiable, any requester could claim that such an error had occurred, leading to the result that any withdrawal would potentially be eligible for correction; this would be detrimental to legal certainty (see J 7/19, Reasons 7).
- 2.5 Relevant person committing the error
 - 2.5.1 As per J 19/03, Reasons 12, it is not sufficient to prove that a divergence occurred between the true

intention of the party and the declaration filed by its professional representative; rather, it is additionally required that this divergence was caused by an error on the part of the person who was competent to make the decision on the procedural act before the EPO.

Therefore, as a rule, in cases where the party is represented by a professional representative, the error pursuant to Rule 139 EPC must be an error of the professional representative in expressing the professional representative's own intentions (see also T 610/11, Reasons 4.6, and Case Law of the Boards of Appeal of the European Patent Office, 10th edition, 2022 ("Case Law"), IV.B.3.8.4 and V.A.7.3.7).

2.5.2 This result is corroborated by the determination of the relevant errors within the meaning of Rule 139, first sentence, EPC. Indeed, if it is only the errors that occur when the declaration is actually being made (see section 2.4.1 above) that matter, then it is clear that it is the acting person's error which must be considered, i.e. the error of the person who actually filed the document to be corrected.

2.6 The original intention of the acting person

2.6.1 In G 1/12, Reasons 37(a), the Enlarged Board of Appeal emphasised that the correction must introduce what was originally intended. The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans. It is the party's actual rather than ostensible intention which must be considered.

2.6.2 To avoid irrelevant errors in the run-up to the declaration to be corrected being considered and to satisfy the principle of legal certainty (see sections

2.4.2 and 2.4.3 above), the original intention of the acting person *with regard to the concrete declaration in the document* must be decisive. In other words, to determine the original intention of the acting person, it is precisely the relevant errors within the meaning of Rule 139, first sentence, EPC that must be taken into account, and not an overriding general motivation such as "filing an admissible appeal" (see T 71/21, Reasons 6.4.2).

2.7 Applying the principles set out in sections 2.4 to 2.6 above, the board concludes that the correction request is not allowable.

2.7.1 It is the professional representative's original intention when making the declaration at issue that matters. In this context, the appellant submitted that its professional representative instructed the draft of a submission to withdraw the appeal and then signed the withdrawal letter and filed it with the EPO. The board is unable to see in this declaration any error within the meaning of Rule 139, first sentence, EPC. When signing and filing the document, the professional representative actually intended to make a declaration of exactly this content and did not commit any errors relating to the declaration, its content or its transmission.

2.7.2 Contrary to the appellant's submission, it is not relevant that the professional representative originally intended to carry out the appellant's instructions but erroneously failed to do so. This error was committed by the professional representative in the run-up to the declaration, apparently because they no longer had the appellant's instruction in mind before proceeding to declare the withdrawal of the

appeal. The alleged original intention to carry out the appellant's instructions is thus tantamount to an irrelevant overriding motivation, comparable to the general intention to meet all of the requirements of the law and/or the case law to achieve a certain legal consequence.

2.7.3 The board is not persuaded by the appellant's argument that there would be hardly any practical use cases for corrections under Rule 139, first sentence, EPC if the above considerations regarding the professional representative's original intention were correct (see section VIII.(d) above).

(a) The board has never claimed that preparing, signing and filing a declaration in accordance with a professional representative's concrete intention would in itself rule out an erroneous declaration. Rather, typical cases where a correction request under Rule 139, first sentence, EPC may be allowed concern scenarios where the professional representative intends to take a certain procedural step (for example paying a certain fee via a payment form) but commits a formal error that is visible in the document to be corrected when taking this step (for example erroneously selecting the wrong fee amount in the payment form, or indicating or omitting the wrong payment method in the payment form; see the circumstances underlying decisions J 8/19, T 317/19, T 1000/19, T 1474/19 or T 444/20).

(b) Also in the case in hand a correction would have theoretically been conceivable if, for example, the professional representative had used a template containing two alternative declarations to be

ticked (i.e. the withdrawal of the appeal on the one hand and the information that the appellant did not intend to attend the oral proceedings on the other) and had accidentally ticked the wrong alternative (i.e. the former one). Of course, in this scenario the requester's burden of proof that the latter alternative constituted the original intention would be heavy, if the original intention were not immediately apparent (see G 1/12, Reasons 37(b)).

2.7.4 Since there is no error within the meaning of Rule 139, first sentence, EPC, the question of whether the error invoked by the appellant occurred due to an excusable oversight is irrelevant. Therefore, it does not have to be decided whether this question is a valid criterion (see in this regard J 5/19, Reasons 2.2 to 2.5).

2.8 By the same token, it can be left open whether Rule 139, first sentence, EPC is applicable to a withdrawal of the appeal (see the case in T 695/18 [R 3/22] where the board, in its communication under Article 15(1) RPBA 2020 of 4 January 2023, answered this question in the negative because there was no *pending* case in these circumstances).

3. *Request for referral to the Enlarged Board of Appeal, Article 112(1)(a) EPC*

3.1 The appellant's auxiliary request for referral to the Enlarged Board of Appeal under Article 112(1)(a) EPC aims at clarifying the question of whether an automated entry in the European Patent Register may constitute an official public notification (see section VI. above). This question becomes relevant only if there is an error within the meaning of Rule 139, first sentence,

EPC that may be corrected. In that case, a correction of the withdrawal of the appeal may nevertheless be denied if the public has already been notified of the withdrawal (see Case Law, IV.B.3.8.3).

3.2 However, the appellant's request for correction must be refused for the reason alone that there is no error within the meaning of Rule 139, first sentence, EPC (see section 2. above). It follows that the appellant's auxiliary request for referral to the Enlarged Board of Appeal is rendered moot and must likewise be refused.

4. *Result*

4.1 The immediate effects of a withdrawal of the appeal may not be reversed by way of correction under Rule 139, first sentence, EPC in the case in hand. Consequently, the appeal proceedings are terminated without a substantive decision.

4.2 For reasons of clarity, the board will expressly declare this effect of the withdrawal of the appeal in the decision's order.

Order

For these reasons it is decided that:

1. The request for correction of the withdrawal of the appeal is refused.
2. The request for referral of a question to the Enlarged Board of Appeal is refused.
3. The appeal proceedings are terminated.

The Registrar:

The Chairman:



S. Sánchez Chiquero

T. Häusser

Decision electronically authenticated