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Datasheet for the decision
of 4 July 2023

Case Number:	T 0433/21 - 3.3.06
Application Number:	13866092.3
Publication Number:	2935122
IPC:	B01J20/12, C02F1/28, C02F1/42, C02F1/58, C02F101/10, C02F103/00
Language of the proceedings:	EN

Title of invention:
Slurry for Treatment of Oxyanion Contamination in Water

Applicant:
Phoslock Pty Ltd

Headword:
Retraction of a declaration to withdraw the appeal (denied)

Relevant legal provisions:
EPC Art. 125
EPC R. 139

Keyword:
Correction of error - (no) - immediately evident that nothing else could have been intended (no)
Error of representative
Retraction of a declaration to withdraw appeal
Conditions for retracting a declaration
Ancillary proceedings after closure of appeal proceedings
Exercise of discretion to make a referral to the Enlarged Board of Appeal

Decisions cited:
G 0001/09, G 0001/12, R 0003/22, J 0010/87, J 0011/87, J 0004/97, J 0004/03, J 0019/03, J 0028/03, J 0014/04, J 0001/11, J 0006/13, J 0002/15, J 0005/19, T 1244/08, T 0610/11, T 1934/14, T 0161/17, T 0695/18, T 2148/18, T 2474/19, T 0333/20

Catchword:

1. Neither the omission of a procedural act nor an error caused by miscommunication between the applicant and the representative or by an incorrect recollection of the applicant's instructions can be regarded as an error under Rule 139 EPC, provided that the document filed with the EPO is deemed to express the representative's intention at the time of filing.
2. A request for correction of a declaration of withdrawal of an appeal under Rule 139 EPC does not reopen the appeal proceedings, but only starts ancillary proceedings to decide whether the appeal proceedings should be reopened.

Europäisches Patentamt
European Patent Office
Office européen des brevets

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Case Number: T 0433/21 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 4 July 2023

Appellant: Phoslock Pty Ltd
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Northbridge, New South Wales 1560 (AU)

Representative: Müller Schupfner & Partner
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Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 1 December 2020 refusing European patent application No. 13866092.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman S. Arrojo
Members: L. Li Voti
C. Heath

Summary of Facts and Submissions

I. This case concerns the rescission of a declaration to withdraw the appeal on the grounds that such declaration was allegedly made in error. The case also concerns the question of whether a request to reopen appeal proceedings should have the consequence that the appeal is again pending.

II. On 1 December 2020, the examining division refused European patent application no. 13866092.3, a decision against which the applicant appealed.

III. On 29 November 2022, the Board issued a communication in regard of such appeal. The communication was rather negative, as it concluded that none of the requests on file appeared to be allowable. The communication mentioned Rule 103 EPC (the possibility of obtaining a partial refund of the appeal fee when withdrawing the appeal).

IV. In a submission dated 29 December 2022, the then appellant wrote the following:

"In the name and on behalf of the applicant, Phoslock Pty Ltd., our appeal filed on February 9, 2021 against the decision of the examining division of December 1, 2022 is hereby withdrawn"

V. In view of this declaration, the oral proceedings were cancelled on 5 January 2023. On 12 January 2023, the order to close the case was sent to the appellant's representative. Orders were issued on 16 and 17 January 2023 to refund the outstanding fees.

VI. With a submission dated 20 January 2023, the appellant who henceforth is referred to as "the petitioner" made the following requests:

"1. Es wird beantragt, den im Schreiben vom 29. Dezember 2022, eingereichten Antrag auf Basis der Regel 139 EPÜ oder aufgrund allgemeiner Rechtsgrundsätze nach Art 125 EPÜ, dahingehend zu korrigieren, dass dieser als Antrag auf eine Teilanmeldung verstanden wird, wie er mit Aktenzeichen 23152685.6 am heutigen Tage beim EPA eingereicht wurde.
2. Hilfsweise wird beantragt, den im Schreiben vom 29. Dezember 2022, eingereichten Antrag auf Basis der Regel 139 EPÜ oder aufgrund allgemeiner Rechtsgrundsätze nach Art 125 EPÜ, dahingehend zu korrigieren, dass dieser als Antrag auf eine Teilanmeldung verstanden wird, mit Bezugnahme auf die frühere Anmeldung 13866 092, wobei diese Bezugnahme sowohl die Beschreibung als auch die Ansprüche betreffen soll.
3. Darüber hinaus wird beantragt oder zusätzlich hilfsweise wird beantragt, das Beschwerdeverfahren in der Europäischen Patentanmeldung 13866 092.3 wieder aufzunehmen.
4. Des Weiteren hilfsweise wird beantragt, eine mündliche Verhandlung durchzuführen."

VII. The petitioner provided the following reasons for the above requests: first, it had always been the intention of the petitioner to file a divisional application rather than to withdraw the appeal. Second, in requesting the correction, the petitioner had acted without delay as the order that the appeal proceedings had been closed only came to the representative's attention on 16 January 2023. Only in connection with the Office's further communications regarding the repayment of fees (16 and 17 January 2023) was the case fully appreciated. Third, the declaration of withdrawal contained an error (the decision of the examining division was indicated as of 2022, but in fact had been rendered in 2020) that would have made it immediately apparent to third parties that no withdrawal of the appeal could have been intended (as the period for filing an appeal would have barely started had the appealed decision been rendered on 1 December 2022). Fourth, declarations made in error could be retracted according to § 119 German Civil Code (BGB), which by way of Art. 125 EPC should find application in the present circumstances.

VIII. On 25 January 2023, the petitioner filed further evidence in relation to the above request to reopen the appeal proceedings. The evidence consisted of a letter sent to the client by the representative on 18 January 2023, which included inter alia the following statements:

"We refer to the latest correspondence in the above-identified case. According to your instructions of December 28, 2022, we have withdrawn the appeal on December 29, 2012, in particular as the outcome of the appeal proceedings did not seem to be promising. Rather, the Boards of Appeal indicated that they were highly likely going to reject the application in total. With letter of the same date, i.e. December 28, 2022, you instructed us to file a divisional application. In this regard, the file has now come to my personal attention, whereas I have realized, that the divisional application has not been filed so far."

The instructions received from the client on 28 December 2022 were as follows:

"Further to our emails below, please withdraw the appeal on the present application prior to the 29 December 2022 deadline (which we understand is extendable to 1 January 2023) and request a refund of the official fee.
Please also file a divisional application."

IX. In a subsequent communication, the Board expressed doubts that the petitioner had committed an "error" in the sense of Rule 139 EPC by withdrawing the appeal, and that, even if there had been an error (*quod non*), the request for correction of the error had been made in due time. The Board further took the view that decision **R 3/22** required the Boards to provide a procedure for requesting the reopening of the appeal proceedings in the event of the withdrawal of a declaration to withdraw an appeal, but that this could not be understood to mean that the appeal proceedings were reopened on the basis of such a request.

X. The petitioner, taking note of the Board's preliminary opinion as well as the recent decision **T 695/18**, disagreed with the Board's arguments and reformulated its requests as follows:

"i. Die im Schreiben vom 29. Dezember 2022 eingereichten Rücknahme der Beschwerde gemäß Regel 139 EPÜ oder Artikel 125 EPÜ dahingehend zu berichtigen, dass sie als eine Einreichung der am 20. Januar 2023 eingereichte Teilanmeldung verstanden wird.

ii. Hilfsweise, dass die Rücknahme der Beschwerde als Einreichung einer Teilanmeldung mit Bezugnahme auf die Beschreibung und die Ansprüche der früheren Anmeldung verstanden wird.

iii. Hilfsweise, dass die im Schreiben vom 29. Dezember 2022 eingereichten Rücknahme der Beschwerde gemäß Regel 139 EPÜ oder Artikel 125 EPÜ dahingehend berichtigt wird, dass sie am 21. Januar 2023, also ein Tag nach Einreichung der Teilanmeldung, eingereicht wurde.

iv. Hilfsweise, das Beschwerdeverfahren wieder aufzunehmen.

v. Zusätzlich hilfsweise, eine Vorlage nach Artikel 112(1) EPÜ mit den folgenden Vorlagefragen zu stellen:

1. Eröffnet ein Antrag nach Regel 139 EPÜ das Verfahren vor den Beschwerdekammern erneut?

2. Sollte Frage 1 bejaht werden, so wird die Frage weiterhin dahingehend konkretisiert, ob die Möglichkeit der Wiedereröffnung des Beschwerdeverfahrens die Möglichkeit einer Einreichung einer Teilanmeldung eröffnet?

3. Sollte Frage 1 bejaht werden: muss der Antrag nach Regel 139 EPÜ in einem gewissen Zeitrahmen gestellt werden?"

XI. These were in fact the petitioner's final requests maintained at the oral proceedings held on 4 July 2023. During the hearing, all issues in relation to a correction under Rule 139 EPC and a possible reopening of the appeal proceedings were extensively discussed, as follows:

- At the outset, the Board pointed out that it was not minded to follow decision **T 695/18** to the extent that it had found Rule 139 EPC only applicable to pending appeal cases, but not to cases where the appeal had already been withdrawn (see point 1 below).

- The petitioner argued that a mistake had been made in the declaration of 29 December 2022. Decisions **G 1/12** point 37 (c) and **J 5/19** had held that for Rule 139 EPC to apply, an error could also consist of an omission. The omission in this case concerned the failure to file a request for a divisional application, as had been the petitioner's true intention (see point 4 below). Apart from Rule 139 EPC, also Art. 125 EPC in connection with national law, here § 119 German BGB, could form the basis for rescinding a declaration of intent. Under § 119 German BGB, a rescission was possible if undertaken without undue delay (see points 3 and 6 below). The Board drew the attention of the petitioner to the recent decision **T 2474/19**, which appeared to concern a similar situation and which had refused to correct a declaration to withdraw the appeal by converting this declaration into a declaration to file a divisional application and to withdraw the appeal.
- The question of whose error should be relevant: The error of the representative or that of the represented party. The petitioner in this regard submitted that the case at issue concerned an error of the representative and asked the Board to follow the case law (**T 2474/19**) concluding that for an error must have been committed by the representative in order to be correctable under Rule 139 EPC (see point 4 below).
- Furthermore, point 2.1 (c) of decision **J 5/19** was discussed, namely whether third parties, upon inspection of the declaration to withdraw the appeal, would have had reason to suspect that such

declaration should be given a different meaning. In this regard, the petitioner drew attention to the wording "decision of the examining division of December 1, 2022" mentioned in the letter of 28 December. This date was clearly erroneous, because the mention of a decision of December 2022 could hardly have been subject to appeal proceedings pending on 28 December 2022. Third parties would thus clearly have reasons to suspect that this declaration could not refer to the withdrawal of an appeal raised against such decision (see point 6 below).

- In regard of the requirement for immediate correction of an error, the petitioner referred to the German BGB and the requirement of rescission "without undue delay". In the case at issue, the rescission was declared as soon as the error was discovered, namely once the outstanding fees were refunded on 17 and 18 January 2023. Furthermore, that any rescission of a declaration to withdraw the appeal was made in good time prior to the withdrawal taking effect by way of publication in the Patent Bulletin (see point 6 below).
- Following the Board’s decision not to allow a correction of the declaration to withdraw the appeal, the petitioner referred to decision **R 3/22** concerning the order to "reopen proceedings" and the exact meaning thereof. The petitioner argued in this regard that this clearly implied the continuation of the previous appeal proceedings with the consequence that such proceedings would be pending again once a request for correction under Rule 139 EPC had been made. Asked by the Board whether any request for correction under Rule 139 EPC that related to a withdrawal of the appeal, however frivolous and belated (e.g. years after

appeal proceedings had been closed) would automatically make such appeal proceedings pending again, the petitioner took the view that belated or frivolous requests should be deemed inadmissible. An inadmissible request would of course not make the appeal proceedings pending again. In addition, the petitioner argued that the EPC did not envisage "ancillary proceedings" as had been held in decision **T 695/18**, which had taken a wrong turn in this regard and should be considered divergent from earlier decisions such as **J 5/19** (see point 7 below). "Inventing" such procedure would mean a completely new avenue that would, *inter alia*, justify a referral to the Enlarged Board of Appeal as a question of fundamental importance (see point 8 below). Initially, such referral was requested on two points: First, whether Rule 139 EPC should apply to the retraction of a withdrawal of appeal, and second, whether a request under Rule 139 EPC to allow such retraction would make appeal proceedings pending again. However, as the Board decided in favour of the petitioner on the first point, a referral was requested only for the second point.

Reasons for the Decision

1. Rule 139 EPC – Scope of Application

1.1 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". In decision **G 1/12**, OJ EPO 2014, 114, reasons 34, the Enlarged Board of Appeal pointed out that Rule 139 EPC 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. The relevant declaration refers to the one actually filed with the Office, which in the case at issue is the declaration of withdrawal.

1.2 A correction procedure is necessary because the party is normally bound by its declarations as notified to the Office, as was held in decision **T 610/11** of 8 September 2016, reasons 4.4:

> *"According to said decision **J 19/03** (point 5 of the Reasons), "[…] as a general rule, an applicant is bound by its procedural acts notified to the EPO provided that the procedural statement was unambiguous and unconditional (cf. **J 11/87**, points 3.3 and 3.6 of the reasons, OJ EPO 1988, 367; J 27/94, point 8 of the reasons, OJ EPO 1995, 831) and is not allowed to reverse these acts so that they can be considered as never filed (**J 10/87**, point 12 of the reasons, OJ 1989, 323; **J 4/97**, point 2 of the reasons)."*

1.3 In terms of terminology and legal meaning, it is important to distinguish between a "retraction" of a declaration of intent and its "rescission". A retraction of a declaration of intent (including a withdrawal) is possible before the declaration of intent has had any legal effect. For this to be the case, the retraction must reach the addressee either before or at the same time as the declaration itself, as concluded in decision **J 1/11** of 28 June 2011, reason 3, referring to a general principle of European law, e.g. sec. 130 (1) 2nd sentence German Civil Code, Arts. 1328 et seq. Italian Civil Code, Art. 1118(2) French

Civil Code, while not clear in the UK (Chitty on Contracts 34th ed. 2021, 4-078). In the context of both the EPC and the Paris Convention (Art. 4C), one day is the smallest temporal unit (Rule 131(1) EPC). Therefore, if a statement to disregard the withdrawal reaches the Office at the same time (meaning: the same day) as the withdrawal, both (conflicting) declarations have reached the Office at the same time and no legal effect can be given to the declaration of withdrawal, notwithstanding all the requirements otherwise imposed on rescissions (this is how the Board understands decision **T 2148/18** of 7 December 2021, where both the withdrawal and the declaration to disregard the withdrawal reached the Office on the same day). Only a withdrawal made during oral proceedings becomes immediately effective. This is nonetheless based on procedural reasons, and not on substantive ones, since either the oral proceedings are declared closed with the effect of *res iudicata*, or (in the case of appeal and cross-appeal) a subsequent retraction still during oral proceedings would have to be examined in the same way as a late-filed request. The Board notes that the position here differs from the one taken by decision **T 1244/08**, reasons 4.

1.4 However, a declaration can no longer be disregarded if it has already had legal effects, which is the case from the day following the receipt of such declaration. Here, the request to undo such legal effects is considered as a rescission and is subject to certain conditions.

1.5 One line of cases has held that for the withdrawal of an appeal, no rescission under Rule 139 EPC or under any other legal basis should be possible: **T 1244/08** of 7 July 2011 and **T 695/18** of 3 March 2023. The reason put forward in the latter decision was that Rule 139 EPC "*is applicable only if proceedings before the EPO for some other purpose are pending when the request for correction is received by the EPO. The request for correction is inadmissible if received when no such proceedings are pending*" (catchword 2). This narrow interpretation of Rule 139 EPC in decision **T 695/18**, points 3.2.8 et seq. was justified by the the absence of any time limits or fee requirements to protect legal certainty, which would bring Rule 139 EPC into conflict with other legal instruments such as petitions for review under Art. 112a(4) EPC or re-establishment of rights under Art. 122 EPC. While the Board agrees with the need to set limits to requests under Rule 139 EPC in order to ensure legal certainty, it is not convinced that **G 1/12** should be given such a narrow reading, as such an interpretation would have implied that in the factual situation that gave rise to the referral, there would have been no admissibly pending appeal and the request for correction under Rule 139 EPC would have been deemed inadmissible, which was not the case. The Board thus concludes that the concept of "appeals" mentioned in point 35 of the reasons of **G 1/12** should not be construed narrowly as referring to "admissibly pending appeals", but broadly as also encompassing appeal cases that would be pending if the correction under Rule 139 EPC was allowed.

1.6 The Board's position is further confirmed by decision **R 3/22** of 22 November 2022, which ordered the reopening of proceedings in case **T 695/18** to determine whether the withdrawal of the appeal could be rectified. This decision concluded that the success of a request under Rule 139 EPC "cannot be ruled out *a priori*, and if the request is successful, a decision on the merits of the appeal would be possible". It follows from these conclusions that a request to correct a declaration of withdrawal of the appeal under Rule 139 EPC can potentially be successful, which implies that Rule 139 EPC is applicable. The Board also finds itself in agreement with other decisions that applied Rule 139 EPC in a situation where only a successful correction would have made the appeal proceedings pending again, but found the request not to be allowable on the basis that no error under Rule 139 EPC could be identified e.g. **T 2474/19** of 23 January 2023.

2. **Starting Point**

The different approaches to the question of whether Rule 139 EPC can be applied to the rescission of a withdrawal of appeal, and also to the way in which Rule 139 EPC should be applied, appear to reflect the inherent tension between doing justice to an applicant's individual situation and providing coherence and legal certainty. Some decisions such as **T 2148/18** and **J 5/19** of 21 January 2021 appear to have leant towards the former, while others, such as **T 1244/08** and **T 695/18** towards the latter. This difference in approach or perception is also reflected in the respective majority and minority opinions in decision **G 1/12**.

The Board in this regard is mindful of the fact that procedural requirements, strict as they may seem, are not self-serving rules for the smooth working of patent offices, but serve the public interest in terms of publicity, transparency and legal certainty. The public would be ill-served by well-meant, yet ill-explained exceptions to seemingly strict rules in order to do justice to individual cases. Such case-specific exceptions invariably lead to uncertainty and entice litigation. The above considerations apply all the more since the typical users of the European patent system are professional representatives (mandatory for applicants not resident in EPC-Member States) who have passed a qualifying examination and do not need special protection for inexperienced users.

3. **Requirements of Rule 139 EPC**

The requirements for a correction under Rule 139 EPC have been set out in decision **G 1/12** point 38 as follows: (a) the correction must introduce what was originally intended, (b) the error must consist in an incorrect statement or omission and (c) the request must be filed without delay. Decision **J 5/19**, point 2.1 of the reasons based on the earlier decision **J 6/13** of 23 July 2013, point 4 of the reasons, adds that a third party upon file inspection must have had good reason to suspect that the withdrawal was made in error in order to allow a rescission thereof.

4. **Application to the case at issue**

In the case at issue, the petitioner declared a withdrawal of the appeal, yet in fact had received instructions to file a divisional application and withdraw the appeal. Although the petitioner first argued that the withdrawal was meant to be the filing of a divisional application, during oral proceedings it was submitted that the declaration to withdraw the appeal was not erroneous, but incomplete, and the error was the omission to (additionally) file a divisional application, as if one page of the document as submitted on 29 December 2022 had gone amiss. The Board is in agreement with the petitioner that according to decision **G 1/12**, omissions in a document may also be corrected under Rule 139 EPC: e.g. where a declaration is filed in the name of "John Smith" instead of "John Smith, Inc.", this is an omission that may be correctable. Yet the omission must relate to a document which was actually filed with the Office. As held in decision **T 2474/19** of 23 January 2023, point 2.4.2 of the reasons: *"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".* The omission of a procedural act is not an error or omission in a document which can be likened to "[l]inguistic errors, errors of transcription and mistakes", nor does it relate to a "document filed with the European Patent Office". In the present case, the omission of the procedural act of filing a divisional application is not a drafting error in the document to withdraw the appeal. If the Board were to follow the petitioner's line of argumentation, anyone could file a blank page or even no page at all and later claim that the true intention was to file an application, an opposition, an appeal or any other document, and request a correction under Rule 139 EPC. In this respect, as stated in **T 2474/19**, reasons 2.7.2:

"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."

Thus, the Board finds that in the present case the representative made an error by omission, but not an omission concerning the content of the document that was actually filed, but an omission to carry out the client's instructions. The omission of a procedural act cannot in itself be regarded as a correctable error under Rule 139 EPC, because it does not fall within the scope of an error or mistake in a "document filed with the European Patent Office" as required by that Rule, but rather constitutes an error or mistake in the run-up to the filing of the document. This narrow interpretation of the concept of "error" not only conforms to the wording of Rule 139 EPC, but also alleviates the concerns highlighted in decision **T 695/18**, i.e. that applying Rule 139 EPC to such cases as the current one would compromise legal certainty.

The petitioner also invoked the provision of § 119 German Civil Code (BGB) for the interpretation of what should be considered an error, yet could not point to a different definition that would have helped its case in this regard.

5. **Further requirements for correcting errors**

For the sake of completeness, the Board will also address the further points raised during the oral proceedings in relation to a correction under Rule 139

EPC, the first being whose error should be relevant for the assessment under Rule 139 EPC, the error of the representative or the represented. During the oral proceedings, the petitioner argued in this regard that the case at issue concerned an error of the representative and asked the Board to follow the case law in which a correctable error under Rule 139 EPC was based on an error of the representative (**T 2474/19**) rather than the represented (**J 5/19**). The latter decision in point 3.2 concluded as follows:

"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."

On the other hand, decision **T 2474/19** reasoned as follows:

*"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.

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."

As indicated in point 4. above, the Board finds the latter approach to be particularly helpful. It is of course true that a representative who mistakenly fails to follow the client's instructions always acts in error. However, the relevant error must relate to the document actually filed with the EPO, and such an error can only be made by the representative when filling out the document. In other words, the relevant discrepancy is not the one between the client's instructions and how they are carried out by the representative, but between what the representative intended to file (to which the client's instructions may be circumstantial evidence) and what he or she actually filed. This excludes errors caused by miscommunication between the client and the representative, or by an incorrect recollection of the client's instructions, because in such cases the representative would be considered to have filed what he or she intended to file.

In the case at issue, the Board assumes in the petitioner's favour that at the time of receiving the instructions from the applicant, the representative's intention was to file a divisional application in addition to or *in lieu* of a withdrawal. However, as it is not immediately apparent that this was also the intention of the representative at the moment of filing the document, "the requester bears the burden of proof, which must be a heavy one" (decision **G 1/12**, reasons 37). In other words, the representative must show that at the moment of filing the document, he or she intended something different from what was actually done. In the present case, the Board does not consider it sufficient to point out that the client had given instructions to file a divisional application, since the representative may well not have had this in mind when filing the letter of 29 December 2023. In any case, it is the representative who has to furnish proof that when filing the withdrawal he or she had intended to file a divisional application prior to or *in lieu* of a withdrawal of the appeal. In the absence of such proof, the Board must conclude that, given the content of the document filed with the EPO, the intention of the representative at the time of filing the statement was only to withdraw the appeal.

6. **Further requirements to safeguard the interests of third parties**

6.1 It is appropriate at this stage to further deal with the petitioner's position concerning Art. 125 EPC and § 119 German BGB. The petitioner's arguments here are straightforward: An error was committed (§ 119 BGB) by the representative (§ 166 (1) BGB) who notified the Office without culpable delay after discovering the error (§ 121 BGB). Rescission should thus be possible and the damage caused to the Office or third parties by such erroneous declaration should be compensated, § 122 BGB.

6.2 Leaving aside the fact that such rules may well be different in other EP Member States and that German law does not appear to apply these rules to procedural declarations, statements made in the course of patent proceedings are not comparable to those made in the course of civil transactions. Procedural acts such as patent applications, oppositions and appeals are addressed to the public at large ("letters patent" - a terminology originating from the English, meaning "an open letter addressed by the king to all his subjects at large") and are of considerable public importance in that they have a bearing on the freedom to operate.

6.3 It is in this context, and for this reason, that case law has restricted the possibility of retracting declarations of intent in the context of application, opposition and appeal proceedings. In this respect, the Board sees no difference between the requirements stipulated for an applicant withdrawing, in writing, an application or a patentee withdrawing an appeal against a decision to revoke a patent. In both cases, the public is informed that a certain technology will no longer be subject to a monopoly right, and in both cases, the basis for requesting such a correction is the same, namely Rule 139 EPC.

6.4 One of the requirements to safeguard the interests of the public is that an indication of any error must be found in the document itself: decision **J 5/19**, point 2.1 of the reasons based on the earlier decision **J 6/13** of 23 July 2013, point 4 of the reasons. The latter decision mentions in particular the legitimate expectations of third parties and legal certainty in general: "A third party upon file inspection must have had good reason to suspect that the withdrawal was made in error in order to allow a retraction thereof". In the case at issue, the only argument advanced by the petitioner was the fact that the date of the decision under appeal was erroneously given as "2022", although it should have been "2020". Third parties should thus have been aware that no withdrawal could have been intended in such circumstances. The Board finds this argument unconvincing, as anyone reviewing the file would have been aware of the negative opinion of the Board filed one month prior to the withdrawal, and the specific mention of a partial reimbursement of the appeal fee for a withdrawal occurring within one month. A reasonable observer would thus have concluded that it was the indication of the year "2022" that was erroneous, not the declaration of withdrawal.

6.5 Further requirements are that the retraction must be made immediately and before the public has been notified thereof. The case law deals with these two conditions (immediate reaction and absence of a reliable communication to the public) as cumulative requirements starting with decision **J 10/87** of 11 February 1988, reasons 8 "*because the public interest in being able to rely on information officially published by the European Patent Office must rank higher than the interest of a patent applicant wanting his erroneous statement already notified to the public to be ignored. In these cases, legal certainty must prevail.*".

The petitioner in the case at issue argued that the rescission of the declaration of withdrawal was communicated as soon as the representative became aware that something had gone wrong, which was, moreover, before the withdrawal was published in the Patent Bulletin, i.e. before it had taken legal effect. According to decision **G 1/12**, reasons 37 and decision **T 2148/18** of 7 December 2021, reasons 2.2.3, the request for retraction must be filed without delay. When interpreting the requirement of acting without delay as a subjective one, the Board acknowledges that the representative notified the Office as soon as he had become aware of the discrepancy between his client's instructions and what had actually happened. This, however, was three weeks after the withdrawal had been notified and published in the European Patent Register. The case is thus different from decision **J 4/97** of 9 July 1997 where the withdrawal had not been published in the Patent Register. In decision **J 4/03** of 9 September 2004, the deciding Board considered publication in the Patent Bulletin to be decisive (as was argued by the petitioner in the case at issue), but this was subsequently qualified in decision **J 14/04** of 17 March 2005 to the effect that publication in the European Patent Register had the same function and weight as publication in the European Patent Bulletin. This was reiterated in decision **J 1/11** of 28 June 2011, reasons 6, where it was stated that

> *"internet technology as implemented by the European Patent Office has made this distinction no longer relevant for determining the basic condition of the official notification of the withdrawal to the public. The European Patent Register nowadays allows for a file inspection online no different than the European Bulletin allows for an online access of its*

contents. Since 1 January 2005, the Bulletin has been issued in electronic form only, and paper copies are no longer available. The previous distinction between "inspection" that required either a personal visit to the European Patent Office or a specific oral or written request regarding a particular application, and a "publication" effected by sending out the European Patent Bulletin to the world at large seems no longer justified or justifiable."

This line of argumentation was confirmed by decision **J 2/15** of 20 July 2015. Furthermore, according to decision **J 14/04** of 17 March 2005, reasons 8, it is irrelevant whether someone actually consulted the file on the date of publication, and only the fact that the information was easily available to the public has to be considered.

The Board agrees with these decisions. The point stressed by the petitioner, namely that the withdrawal would become effective only after publication in the Patent Bulletin appears to be incorrect, since withdrawals and revocations of a patent are not published in the European Patent Bulletin. The petitioner also put forward another argument, namely that even if the public were to inspect the file and learn of a withdrawal, it would not be in a position to know at that point in time whether a divisional application had been filed or not. In other words, had the petitioner (*quod non*) filed a divisional application before withdrawing the appeal, the public would not have been aware of it. A withdrawal of the appeal could thus not be an indication that no further divisional applications would be pending. The Board is not persuaded on this point: The question is whether the public could have learned of the withdrawal of the appeal, not whether the public could not have learned of some other procedural act. In summary, the Board concludes that also the further requirements that case law has stipulated for a valid rescission of a withdrawal have not been met and that the petitioner's case must also fail for these reasons.

7. **The consequences of a request for correction under Rule 139 EPC**

7.1 The Board now turns to the consequences of refusing the request for correction. This is of importance because the petitioner, after filing its request for correction, also filed a divisional application in the belief or understanding that a request under Rule 139 EPC to rescind the withdrawal of the appeal would *ex lege* reopen the appeal proceedings with the consequence that the patent application would still be pending. After all, an application is pending up to the date on which the European Patent Bulletin mentions the grant of the European patent or up to the date on which the application is refused, withdrawn or deemed withdrawn (see decision **J 28/03)**. This is relevant to the extent that Rule 36 EPC requires that a divisional application can only be filed in relation to a pending earlier patent application. According to decision **G 1/09** (OJ 2011, 336), a "pending (earlier) European patent application" is a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence. Since appeal proceedings have a suspensive effect under Article 106 EPC, the decision to refuse an application does not take effect until the appeal proceedings have been closed, so divisional applications can be filed under

Rule 36(1) EPC as long as appeal proceedings are pending.

7.2 In case **T 695/18**, the Board initially denied the request for correcting the withdrawal of an appeal in the absence of an available remedy. Upon appeal by way of a petition for review, decision **R 3/22** set this ruling aside and made the following order: "*The proceedings before Technical Board of Appeal 3.5.03 are reopened*." From this, the petitioner concluded that also in the case at issue, the formerly pending appeal proceedings should be continued. After all, only previously pending proceedings could be reopened. The Board, in its provisional opinion, took the view that this was not a correct reading of the order:

> *"The current proceedings (concerning the request for correcting the withdrawal of the appeal) do not make the appeal proceedings pending again. Rather, they are meant to establish whether the underlying application and the related appeal proceedings should be deemed still pending and thus be continued at the stage they were prior to ordering their termination. By the order to terminate appeal proceedings, the case has become res iudicata. The Board has been asked to render a decision not in the appeal proceedings, but rather in proceedings meant to determine whether the order can be set aside and the appeal proceedings be continued, which the Board would refer to as ancillary proceedings. If it were different, the effect of res iudicata would be negated and the request to reopen proceedings would automatically lead to their reopening. In other words, the request to continue proceedings, however ill-founded, would ex lege lead to their continuation regardless of the merits of such request, not unlike*

in fairy tales where wishes are granted no sooner than they have been uttered.
An applicant who requested withdrawal of the appeal might years later request correction under Rule 139 EPC and already thereby make the case pending again - with the consequence that a new divisional application can be filed even if the request is subsequently deemed unfounded. Thus, during the time the request for continuation of the appeal proceedings was pending, the effects of making the request would be equivalent to those resulting from a successful request. Or, worded differently, an unsuccessful request would have the same effect as a successful one. If in the case at issue the request under Rule 139 EPC had been made, say, three years after the order to terminate appeal proceedings, the requested reopening of proceedings would occur by the mere fact of making it. Even further, also a subsequent withdrawal of the request for correction could then lead to the result that proceedings would have been reopened and a divisional application could be filed within this window period of pendency."

7.3 Upon rehearing the case, the Board in case **T 695/18** confirmed this approach:

"4.5 The present request for correction under Rule 139 EPC was no self-fulfilling prophecy in the sense that it automatically entailed the reopening of the appeal proceedings, and in these limited-purpose ancillary proceedings (cf. point 2 above), the request for correction is to be refused. The finality of the settlement on the merits brought about by the withdrawal thus remains. Moreover, since this finality was exclusively in the hands of the party

(see point 3.1.2 above), no final decision was needed for the legal effects to ensue.
4.6 From the ancillary nature and limited scope of these proceedings (cf. point 2 above), it further follows that potential substantive rights associated with the application would only arise if appeal proceedings were reopened after a finding that Rule 139 EPC was applicable, then after another finding that the request for correction was allowable. This was not the case here."

7.4 The Board notes that the above paragraphs provide a helpful starting point for reading decision **R 3/22** in context. The purpose of this decision was to provide a competent forum for arguing a case of an allegedly erroneous termination of the appeal proceedings. The first decision in **T 695/18** was overturned because it had denied such forum, which was deemed to infringe the petitioner's right to obtain a decision based on all relevant requests (Rule 104(b) EPC). The provision of such a forum does however not imply a reopening of the appeal proceedings, but merely means that the Board dealing with such a request is the competent body to decide on the question of whether the appeal proceedings should in fact be reopened. The Board therefore interprets the order of the Enlarged Board in decision **R 3/22** as follows: "Proceedings before the competent Board should be provided". Such proceedings are not the appeal proceedings, but may, according to the nomenclature proposed in the final decision in case **T 695/18**, be considered as "ancillary proceedings", i.e. proceedings arising out of or in connection with the earlier appeal proceedings, once those proceedings have been concluded. This is also consistent with the reason why a procedural violation was invoked: Not because the Board in **T 695/18** had failed to reopen the appeal proceedings, but because it had failed to provide a forum in front of which the petitioner could argue its case for correction under Rule 139 EPC.

7.5 The petitioner argued that the EPC did not provide a basis for these ancillary proceedings, so that the concept as such was *contra legem*. The Board however notes that, irrespective of the nomenclature used in each case, there are multiple examples in the case law of decisions taken within a context in which the appeal proceedings were no longer pending, such as decisions on apportionment of costs (see **T 161/17** of 16 June 2017), on reimbursement of the appeal fee (see **T 333/20** of 17 December 2020) or on correction of the minutes (see the second decision in case **T 1934/14** of 8 October 2018). In all these cases, the Boards provided a forum by means of "ancillary proceedings" in order to argue an alleged wrong, i.e. to decide on a valid request outside the substantive scope of the appeal proceedings as such. The Board considers that such "ancillary proceedings" are not only consistent with the EPC, but in some cases represent the only means of securing the right to a decision dealing with all relevant requests.

7.6 It is also noted that both the Board's preliminary opinion and decision **T 695/18** have highlighted the anomaly of any approach in which the consequences of a request to provide a remedy should be the same as if the request had been granted, i.e. that the request to reopen the proceedings should automatically imply that the proceedings are reopened. In response to these concerns, the petitioner took the view that only admissible requests should have this consequence, while obviously groundless requests should be deemed inadmissible *a priori*. The Board is not convinced by this argumentation, which appears to confuse the criteria for admissibility and allowability, as it would imply that any request that is not clearly inadmissible would automatically have the same consequences as an allowable request, thus effectively circumventing the requirements for allowability.

7.7 In its preliminary opinion and at the oral proceedings, the Board also referred to the problem of *res iudicata*: If the petitioner were correct in its reading of the order rendered in case **R 3/22**, it would mean that a decision (e.g. to close oral proceedings due to a withdrawal of the appeal) could be set aside by a mere request, which flings in the face of well-established procedural principles. A final judicial decision can only be set aside by another judicial decision (namely the one to grant the request for correction and reopen the appeal proceedings), not by the request of a party. While legal certainty does not require that final decisions cannot be set aside in any circumstances, it does require that this can only be done in the context of proceedings at the end of which a decision is taken on whether or not the effect of *res iudicata* should be set aside and the proceedings reopened. If it were otherwise, any decision of the Boards of Appeal could (at least temporarily) be reopened by a request under Rule 139 EPC, however ill-founded.

8. **Request for a referral to the Enlarged Board (denied)**

8.1 Under Article 112(1) EPC, there are two grounds on which questions may be referred to the Enlarged Board. The first is "uniform application of the law" and applies where the Boards have given diverging decisions or where a Board intends to deviate from an interpretation or explanation of the EPC given by one or more Boards in previous case law. The second ground "point of law of fundamental importance" requires that a Board considers that the question cannot be answered directly and unambiguously by reference to the EPC. A point of law is also to be regarded as "of fundamental importance" if its implications go beyond the specific case at hand. Such importance is established if it could be relevant to a large number of similar cases.

8.2 As to the question of divergence, the petitioner withdrew its request. A referral would also not have been necessary (and would thus have been inadmissible), since the outcome of the case, which is no different from that in **T 695/18**, does not depend on such divergence.

8.3 Concerning the question of "point of law of fundamental importance", there is a certain divergence as to how this criterion should be interpreted. The majority opinion in **G 1/12** held that "*a point of law is also to be regarded as fundamental, if its importance extends beyond the specific case at hand*" and that such importance is established if the point of law could be relevant to a large number of similar cases (point 10 of the reasons). On the other hand, the minority opinion criticised that this "*view implies that "importance" within the meaning of Article 112 EPC is nothing more than mere relevance, the number of cases affected then being neither a suitable nor an appropriate criterion for establishing the admissibility of a referral to the Enlarged Board of Appeal. Apart from the fact that it is impossible to ascertain the number of cases in which a point of law was, is or might become relevant, it remains also* *totally unclear where the line between a small and a large number of cases has to be drawn and whether the location of that line depends on the point of law concerned*" (point 48 of the reasons). The minority opinion did however not put forward an alternative interpretation. It is, of course, tempting for any Board to regard its own case(s) as "of fundamental importance", just as it is for any representative whose case depends on how the law is interpreted. Nonetheless, to put this into perspective, the Board notes that the question at issue here has not arisen before and, given the relatively small number of reported cases on the rescission of the withdrawal of an appeal in general, is unlikely to arise in droves. No question about the interpretation of the Paris Convention or any other international agreement is at stake, nor does the situation relate to fundamental concepts of the EPC. The Board agrees that the issue is relevant to the specific case at hand, but not to the European patent system in general.

8.4 As an additional consideration, the Board notes that the above criteria for a referral as set out in **G 1/12** were written from the perspective of the body to whom the case was referred (the Enlarged Board of Appeal) and concerned the question of admissibility of the referral. From the point of view of the referring Board, admissibility of a referral is of course a necessary prerequisite. However, this does not mean that every referral that would be admissible must necessarily be made. Rather, the decision to refer is a discretionary one (Bühler, in: Singer/Stauder, Europäisches Patentübereinkommen, 8th ed. 2019, Art. 112 note 16). However, where a Board wants to deviate from an earlier decision of the Enlarged Board, it should refer the question (stipulated in Art. 21 Rules of Procedure of the Boards of Appeal for reasons of comity). The fact that this is not a Common Law jurisdiction allows for contradictory decisions to coexist. The disadvantage thereof may – to a certain extent and for a limited time – be offset by the possibility of different Boards engaging in a non-coercive discourse with each other. A non-coercive discourse ("herrschaftsfreier Diskurs") according to Wolfgang Habermas (elaborated in "Theorie des kommunikativen Handelns" 1981) has as its object a decision through the persuasive force of the best argument. It requires equal partners in a communication, an equal opportunity to be heard and a symmetrical situation, all of which is given when different Boards, which are not in a hierarchy amongst each other and are equally competent to interpret the EPC, decide on the same question of law and are forced to come up with better arguments when contradicting each other. Ideally, a sequence of such decisions can then lead to a common understanding as to the best argument and the best answer to a given legal problem. A Board may therefore refrain from making a referral in the belief that its own decision, as part of a non-coercive discourse, will lead to a commonly accepted answer to a certain legal problem. Particularly in cases where a problem has only recently been identified, a non-coercive discourse may be helpful in arriving at a commonly accepted answer or in providing an argumentative basis for a future referral.

9. For the above reasons, all three requests of the petitioner – to allow a correction under Rule 139 EPC, to reopen appeal proceedings and to refer certain questions to the Enlarged Board of Appeal – must be refused.

Order

For these reasons it is decided that:

1. ***The request for a correction under Rule 139 EPC /Art. 125 EPC is refused.***
2. ***The request for reopening of the appeal proceedings is rejected.***
3. ***The request for referral of certain questions to the Enlarged Board of Appeal is rejected.***

The Registrar: The Chairman:

A. Pinna S. Arrojo

Decision electronically authenticated