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File Number: T 1073/92 - 3.4.1  
Application No.: 87 901 834.9  
Publication No.: 0 258 392  
Title of invention: Apparatus for iontophoretic drug-delivery

Classification: A61N 1/30

D E C I S I O N  
of 11 February 1993

Applicant: ALZA CORPORATION

Headword: Withdrawal of appeal/ALZA

EPC Article 111

Keyword: "Request for change of text after Rule 51(4) EPC communication refused" - "Application refused under Article 97(1) EPC" - "Appeal to allow change of text withdrawn in combination with request for grant pursuant to Rule 51(4) EPC communication" - "Remittal with order to grant"

Catchwords

Request for "withdrawal of the appeal" interpreted as a request for withdrawal of the main request, only, plus a request for remittal.



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 1073/ 92 - 3.4.1

DECISION  
of the Technical Board of Appeal 3.4.1  
of 11 February 1993

Appellant : ALZA CORPORATION  
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California 94303-0802 (US)

Representative : Werener, Hans-Karsten, Dr.  
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Decision under appeal : Decision of the Examining Division 040 of the  
European Patent Office dated 7 August 1992  
refusing European patent application  
No. 87 901 834.9 pursuant to Article 97(1) EPC.

Composition of the Board :

Chairman : G. D. Paterson  
Members : R.K. Shukla  
U.G.O.M. Himmler

## Summary of Facts and Submissions

- I. European patent application No. 87 901 834.9 was filed in 1987, and on 6 November 1991 the Examining Division issued a communication under Rule 51(4) EPC indicating the text in which it intended to grant the patent. The applicant approved this text on 12 November 1991. Subsequently, however, on 21 February 1992 the applicant withdrew his approval of the text, and filed a new set of claims to replace the claims in such text, within the framework of an application for restitutio in integrum under Article 122 EPC.

During subsequent procedure the applicant was informed by the Examining Division that the amended claims filed on 21 February 1992 were rejected under Rule 86(3) EPC as well as on substantive grounds (in particular, under Articles 52(4), 84 and 123(2) EPC), and that grant of a patent was only possible with the text which accompanied the Rule 51(4) EPC communication. The application for restitutio in integrum under Article 122 EPC was held to be inadmissible.

On 7 August 1992 the Examining Division issued a decision refusing the application under Article 97(1) EPC, since the applicant no longer approved of the text with which grant was intended by the Examining Division.

The final paragraph of the decision stated as follows:

"If, however, the applicant, following the present rejection, would request the grant of a patent on the basis of the documents cited in the communication under Rule 51(4), a decision to grant will be issued at once as the applicant has already filed the translation of the claims and has paid the grant and printing fees."

- II. The applicant filed a notice of appeal on 30 September 1992, in which it was requested that the Article 122 EPC proceedings should be continued on the basis of the claims filed on 21 February 1992.
  
- III. On 4 December 1992 the Appellant filed a letter stating that "Herewith the appeal against the above-mentioned decision is withdrawn". The letter went on to say inter alia that the applicant now requests the grant of a patent on the basis of the documents cited in the communication under Rule 51(4) EPC. Refund of the appeal fee was requested.

**Reasons for the Decision**

- 1. At first sight the Appellant's statement in the letter filed on 4 December 1992 that the appeal against the Examining Division's decision is withdrawn could easily be understood to mean that the appeal was withdrawn. According to Decision G 8/91 dated 1 October 1992 (to be published) this would cause the decision of the Examining Division to become immediately and automatically effective, with the result that the patent application would be finally refused.

However, it is obvious from the complete contents of the letter filed on 4 December 1992 that the Appellant did not intend to withdraw the appeal as such, but only to withdraw the request set out in the notice of appeal referring to the application under Article 122 EPC and the claims filed on 21 February 1992. Accordingly, the Appellant's letter dated 4 December is so interpreted. The communication dated 29 January 1993 from the Registry of the Board of Appeal

acknowledging the withdrawal of the appeal is withdrawn and should be ignored.


2. The letter filed on 4 December 1992 is also interpreted as a Statement of Grounds of Appeal, and the appeal is therefore admissible.
3. Even though interlocutory revision under Article 109 EPC could have been made having regard to the interpretation of the letter filed on 4 December 1992 set out in paragraph 1 above, having regard to the wording of such letter it is not surprising that no interlocutory revision took place. There is no basis on which the appeal fee could properly be refunded, under Rule 67 EPC or otherwise.
4. In the light of Decision G 8/91 referred to above, it is clearly important that an appellant should only state that the appeal is withdrawn if he is sure that that is what he really wants.

Order

For the above reasons it is ordered that:

1. The decision of the Examining Division is set aside.
2. The case is remitted to the first instance with an order to grant a patent with text as identified in the communication under Rule 51(4) EPC dated 6 December 1991.
3. Refund of the appeal fee is refused.

The Registrar:

  
M. Beer

The Chairman:

  
G.D. Paterson