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**D E C I S I O N**  
**of 15 October 2002**

**Case Number:** J 0010/01 - 3.1.1

**Application Number:** 00...

**Publication Number:** -

**IPC:** B29C 65/18, F16G 3/10

**Language of the proceedings:** EN

**Title of invention:**

Method of and apparatus for splicing thermoplastic articles

**Applicant:**

N.N.

**Opponent:**

-

**Headword:**

Divisional application/N.N.

**Relevant legal provisions:**

EPC Art. 122(1), (2), 97(4)

EPC R. 25(1), 51(4), 69(1)

**Keyword:**

"Divisional application"

"Restitutio in integrum"

"Application of amended Rule 25"

**Decisions cited:**

G 0012/91, G 0010/92, J 0006/86, J 23/90, J 0007/96,  
J 0021/96, J 0010/99, T 0210/89

**Catchword:**

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Case Number: J 0010/01 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 15 October 2002**

**Appellant:** Ball, Ronald H.  
1083 Beaufort Avenue  
Oshawa  
Ontario L1G 1G8 (CA)

**Representative:** Hackney, Nigel John  
Mewburn Ellis  
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**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 19 October 2000 refusing the request to set aside the notification pursuant to Rule 69 (1) EPC, to treat the application No. 115 ... as a divisional application and the request for restitutio in integrum.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** H. Preglau  
P. Mühlens

## Summary of Facts and Submissions

- I. European patent application No. 97 ... ("parent application") was filed on 4 April 1997. The communication under Rule 51(4) EPC was dispatched on 28 January 2000. The time limit for approval of the final text ended on 7 June 2000. With letter dated 31 May 2000, received by the Office on 6 June 2000 the applicant expressed his approval. On 15 June 2000 the appropriate communication under Rule 51(6) EPC was forwarded to the applicant.
- II. On 18 July 2000 a patent application was filed as a divisional application of the above-mentioned "parent application". This application was given the No. 115 ...
- III. Concerning this application the Receiving Section issued a communication on 10 August 2000 noting a loss of rights pursuant to Rule 69(1) EPC because the filing took place after approval of the text of the "parent application".
- IV. The applicant applied for a formal reasoned decision and also filed a request under Article 122 EPC.
- V. By a formal decision dated 19 October 2000 the Receiving Section refused to treat the application as a divisional one and also refused the request for re-establishment of rights. As to the request to treat the European application No. 115 ... as a divisional application it argued that the time limit for filing a

divisional application ended with the date of the approval of the earlier application. It further argued that due to Article 122(5) EPC and the jurisprudence of the Boards of Appeal re-establishment of rights was excluded in the given situation.

- VI. An appeal was lodged against this decision on 20 December 2000 and the appeal fee was paid the same day. The statement of grounds of appeal was received on 27 February 2001.
- VII. The appellant argued that his approval had not been unconditional as the option of filing a divisional application was not expressly mentioned and therefore was not ruled out by his statement of approval.
- VIII. He further supported his arguments by reference to decision J 7/96 which follows the view expressed by the Enlarged Board of Appeal G 12/91. The appellant saw a contradiction between the decision J 7/96 and another decision of the Enlarged Board of Appeal, namely G 10/92 which uses the word "reopening" whereas J 7/96 states that up to the publication of the mention of the grant in the European Patent Bulletin according to Article 97(4) EPC the procedure is still pending and therefore the text for grant has not become final.
- IX. As far as the request for restitutio in integrum is concerned the appellant stated that he was unable to file the divisional application within the deadline set by Rule 25 EPC.
- X. Auxiliarily oral proceedings were requested.

XI. In preparation for the oral proceedings the Board issued the preliminary and non-binding opinion that the approval to the publication of the "parent application" was unconditional and that re-establishment of rights was excluded because of a lack of any time-limit having been missed.

XII. In response to this communication the appellant referred to the in the meanwhile amended Rule 25(1) EPC which should be applied to the case under consideration. He also referred to decisions J 6/88, J 10/99 and J 23/90.

With respect to his request for re-establishment of rights he argued that this should be allowed because the approval pursuant to Rule 51(4) EPC was not unconditional.

XIII. Oral proceedings were held on 15 October 2002.

XIV. At the outset the Chairman summarised the relevant facts of the case and repeated the requests of the appellant to set aside the decision under appeal, to allow the request for *restitutio in integrum* (re-establishment of rights) and to treat the application No. 115 ... as a divisional application.

XV. The appellant reiterated his already presented written arguments on the amended Rule 25(1) EPC and its applicability to the case in suit. The discussion then focussed on the question if and to what extent a possible retro-active application of the amended Rule 25(1)EPC could be justified.

XVI. The appellant argued that an unequal treatment of applicants might take place if a distinction was made between pending "divisional applications" and those where the "parent application" procedure was already definitely closed.

The appellant also argued that the legitimate expectations of third parties would not be disappointed when applying the amended Rule 25(1) EPC to the present case as the request to treat the application as a divisional one was already on file from the outset of the procedure.

XVII. After an in-depth discussion of the case the Chairman asked the representative to state his requests and any other comments and informed the representative that after the closure of the debate no further submissions might be made. The requests remained unchanged and no further comments were made. The Chairman closed the debate.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64(b) EPC and is therefore admissible.

*Request to treat European application No. 115 ... as a divisional application (application of amended Rule 25(1) EPC)*

2. As already pointed out during the oral proceedings the Board agrees that the change of rules may have an impact on pending procedures which is determined by the provisions concerning the entry into force of the

amended rules or any other transitional provisions. As regards the amended Rule 25(1) EPC the Administrative Council's Decision simply contains the date of entry into force of the new rule.

3. With the same decision some other rules have been amended and for these amendments the Administrative Council decided to provide for special transitional provisions as to the extent of the applicability of the corresponding new rules.
4. This makes clear that amended Rule 25(1) EPC was applicable from the day of its entry into force and to any pending earlier European patent application, even those where an approval according to Rule 51(4) might have been given. This interpretation of the amended rule can also be found in the "Information of the European Patent Office" (OJ of the EPO 2/2002, page 112).

There is no possibility to re-open already finalised procedures. The minimum requirement according to amended Rule 25(1) EPC is at least a procedure which has not yet been definitely closed so that the European patent application forming the subject of this procedure can function as a basis from which a divisional application can be derived.

5. When applying the amended Rule 25(1) EPC to the case in suit it remains therefore to answer the question if there was a pending earlier European patent application on the day of the entry into force of the amended rule which might serve as the "parent application".



6. The possible parent application proceeded to grant after the approval according to Rule 51(4) EPC had been given. It was published in the Bulletin 01/02 of 10 January 2001. As no opposition was filed the patent was recorded in the Register of European Patents and the proprietor was duly informed of this by letter dated 14 November 2001.
  
7. When amended Rule 25(1) EPC entered into force on 2 January 2002 the procedure concerning the "parent application" was definitely closed. As there was no longer a procedure pending concerning the earlier application a divisional application even in the light of the amended rule was not possible because of the lack of the minimal precondition to allow a divisional application, namely a pending earlier procedure.
  
8. To exclude any misunderstandings attention is drawn to the fact that the present appeal was directed against the decision of the Receiving Section concerning European patent application No. 115 ... (the "divisional application") and not against the decision to grant a patent taken by the Examining Division in the procedure concerning the European patent application No. 97 .... Therefore the suspensive effect of the present appeal is restricted to the decision of the Receiving Section but clearly cannot be extended to the already closed procedure regarding the original earlier application.
  
9. An interpretation of the amended Rule 25(1) EPC as to a retro-active effect even to already closed cases neither finds support in the wording of the Decision of the Administrative Council to amend Rule 25(1) EPC nor in the common principles of legal certainty which

preclude retro-active effect of amended rules (see eg decision T 210/89, OJ EPO 1991, page 433). Thus, this sort of retroactive effect could only come from an expressive order of the legislator, i.e. from a respective transitional provision enacted by the Administrative Council.

10. Although this appeal does not and cannot lie against a decision taken in the procedure concerning the "parent application" because of its being already terminated it seems to be unavoidable to give at least some thoughts to the interpretation of the appellant of his approval or non-approval in the earlier case. The appellant argues that his approval according Rule 51(4) EPC, given in the procedure concerning the European patent application No. 97 ..., was not unconditional and therefore the Office was not correct in terminating this procedure.
11. The respective letter which was sent to the Office by the representative of the applicant reads as follows:  
"In response to the Communication under Rule 51(4) EPC dated 28 January 2000, I hereby approve the proposed text for grant". No restrictions or reservations were made.
12. The attempt to construe a lack of "unconditionality" because the intention to still file a divisional application was not expressly excluded cannot be successful because it cannot be based on any legal provision of the EPC nor on any general principle. Nowhere it is stated that the approval is only unconditional if it is accompanied by a declaration that no divisional application will be filed, or alternatively if no explicit reference is made to a

divisional application, then the approval is only given "on condition". On the contrary, it is a general principle of law that a condition which is only kept in mind ("mental reservation") is irrelevant.

13. According to Rule 51(4) EPC the Office informs the applicant of the text in which it intends to grant the patent and invites the applicant to pay the fees for grant and to file the necessary translations. If the applicant does this , he is deemed to have approved the text intended for grant.
14. Concerning European patent application No. 97 ... the applicant complied with all these requirements (payment of fees, translations) and even sent a letter of approval. He never mentioned any disagreement and he also did not file any appeal during this procedure which might have shown that he was not satisfied with the decision taken by the Office. The Board fails to see any sign of a condition or disagreement introduced by the appellant in the before mentioned procedure.

*As to the request for restitutio in integrum*

15. Restitutio in integrum is an exceptional remedy which may only be allowed if the preconditions set out in Article 122 EPC are complied with. As already mentioned in the communication accompanying the summons to oral proceedings Article 122 EPC cannot apply to divisional applications because the legal provisions dealing with divisional applications do not contain any time limit which, in case of non-compliance, would lead to a loss of rights.
16. This conclusion is also supported by the Jurisprudence

of the Legal Board of Appeal. On several occasions the Legal Board found that not every "time limit", "time limitation" or "time restriction" under the EPC is also a time limit pursuant to Article 122(1) EPC. According to the decision J 21/96 (cited by the Receiving Section in the decision under appeal) Rule 25(1) EPC does not lay down a time limit within the meaning of Article 122(1) EPC but merely identifies a point in the grant procedure after which a divisional application may no longer be filed. This decision was taken when the former version of Rule 25(1) was in force, but can be applied to the case in suit as well, as only the defined point in time has been changed from the approval of the text according to Rule 51(4)EPC to the moment where the earlier application is no longer pending

Time limits can be set out either immediately by a provision of the EPC or by an individual act of an officer of the EPO to be observed by the applicant otherwise a loss of right might be the consequence of non-observance of this time limit (see also introduction to part VI.E "Re-establishment of rights" in Case Law of the Boards of Appeal of the European Patent Office, 4th ed., 2001, page 294).

17. The situation of divisional applications differs from usual time limits. Article 76 EPC which is the main article dealing with divisional applications merely states that the procedure to be followed in carrying out the divisional application, the special conditions to be complied with and the time limit for paying the varying fees are laid down in the Implementing Regulations (paragraph 3). As already pointed out earlier, Rule 25(1) EPC in the amended version only

says that a divisional application is possible as long as an earlier application is pending.

18. The intention of the law with respect to divisional applications is clear. Article 76 EPC provides for the possibility to file divisional applications but does not understand this as an obligatory act during the examination procedure. It is completely left to the discretion of the applicant to make use of this possibility or not. If the applicant decides to file a divisional application he has to do so before the earlier procedure is terminated. If he does not file a divisional application no further reaction of the Office is provided for in the EPC.
19. As there is no time limit set by the EPC to file a divisional application no time limit can be missed. As the EPC does not oblige the applicant to file a divisional application no act can be omitted which needs to be completed (Article 122(2) second sentence EPC) and no right linked to the observation of a time limit can be lost. Therefore the main pre-condition for a successful re-establishment of rights as laid down in Article 122(1) EPC is not present.
20. Under these circumstances the Board sees no justification for further consideration of the request for re-establishment of rights.

## **Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset