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D E C I S I O N
of 28 October 2005

Case Number: J 0004/02 - 3.1.01

Application Number: 01102571.5

Publication Number: -

IPC: A61M 5/32

Language of the proceedings: EN

Title of invention:
Syringe storage and disposal container

Applicant:
Licence Management Pty Limited

Opponent:
-

Headword:
Divisional application/LMP

Relevant legal provisions:
EPC Art. 76, 122
EPC R. 25(1), 51(4)

Keyword:
"1988 version of Rule 25 EPC reasonable and applicable - yes"
"2002 version of Rule 25 EPC applicable - no"
"Article 122 EPC applicable to 1988 version of Rule 25 EPC - no"

Decisions cited:
G 0010/92, G 0002/02, G 0003/02, J 0011/91, J 0016/91,
J 0021/96, J 0024/03

Catchword:
-



Case Number: J 0004/02 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 28 October 2005

Appellant: Licence Management Pty Limited
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Decision under appeal: Decision of the Receiving Section dated
25 September 2001 refusing the request for
reinstatement pursuant to Article 122 EPC,
refusing the request for oral proceedings and
deciding that pursuant to Rule 25(1) EPC
European patent application 01102571.5 will not
be treated as a divisional application, and
that all fees paid in respect thereof will be
refunded once the decision becomes final.

Composition of the Board:

Chairman: J.-C. Saisset
Members: H. Preglau
S. C. Perryman

Summary of Facts and Submissions

- I. The appeal lies against the decision of the Receiving Section dated 25 September 2001 refusing the request for reinstatement pursuant to Article 122 EPC, and deciding that pursuant to Rule 25(1) EPC European patent application 01 102 571.5 will not be treated as a divisional application.
- II. European patent application 01 102 571.5, from which the present appeal arises was filed on 2 February 2001 as a purported divisional application of application 97 102 041.7, which was itself a divisional application. By letter of 18 July 2000, received by the EPO on 21 July 2000, the appellant had approved the text of the specification proposed for grant on application 97 102 041.7, subject to one amendment. The EPO informed the appellant that this amendment was accepted. The decision to grant dated 2 January 2001 on application 97 102 041.7 was duly issued, stating that mention of grant would appear in the European Patent Bulletin of 7 February 2001. This issue of the bulletin and the corresponding Patent specification were duly published on 7 February 2001.
- III. On the 20 March 2001 the EPO dispatched a communication "Noting of loss of rights" according to Rule 69(1) EPC informing the applicant that the application could not be treated as a divisional application since it was filed after approval had been given in respect of the pending parent application. By facsimile dated 8 April 2001 a request was made pursuant to Article 122 EPC for re-establishment of rights accompanied by supporting evidence. By facsimile dated 30 May 2001 the applicant

also requested a decision under Rule 69(2) EPC and the appointment of oral proceedings in case the EPO intended to refuse the request.

- IV. The Receiving Section issued the Decision under appeal on 25 July 2001 refusing the request for re-establishment, the request for oral proceedings and stating that application 01 102 571.5 will not be treated as a divisional application. The reasons given were essentially that re-establishment was not possible as Article 122 EPC did not apply as Rule 25(1) EPC did not lay down a time limit within the meaning of Article 122 EPC, as stated in decision J 21/96 point 2, and the application could not proceed as a divisional as it was filed outside the time limit of Rule 25(1) EPC.
- V. A Notice of Appeal was filed on 3 October 2001, and the appeal fee was paid on the same date. Grounds of Appeal were filed on 4 December 2001.
- VI. On 11 July 2002 the Board issued a summons to oral proceedings to take place on 4 February 2003, accompanied by a communication. The Appellant made further submissions by letters of 17 and 18 December 2002, and 13 January 2003.
- VII. The oral proceedings duly took place 4 February 2003. At the end of the oral proceedings the Board indicated that the proceedings would be continued in writing, and the Board would issue a further communication.
- VIII. The Board issued a further communication dated 3 September 2004 together with copies of material

therein referred to, and referring also to decisions G 2/02, G 3/02 and J 24/03. The Appellant made a response to this dated 3 November 2004.

IX. The arguments put forward by the Appellant both in writing and at the oral proceedings can be summarized as follows:

- The 1988 version of Rule 25(1) EPC was incompatible with Article 76 EPC and unreasonable, as already held in decisions J 11/91 and J 16/91 particularly in the reasons points 2.3.3 to 2.3.6, and thus could not validly lay down the final date by which a divisional application on a pending earlier European patent application had to be filed, instead it should be permissible to file divisionals to any pending application.

- That the 1988 version of Rule 25(1) EPC was unreasonable was shown by the reasons for changing it given in document CA/127/01 of 15 September 2001 submitted to the Administrative Council, on the basis of which the latter made its decision of 10 October 2001 which put into force the 2002 version of Rule 25(1) EPC with effect from 2 January 2002, which reasons read as follows:

"3. The present Rule 25(1) causes many problems in practice. For example, a communication under Rule 51(4) is not issued in every application, while applicants often realise after approval that they omitted to file a divisional and try to re-open proceedings in any possible way.

4. The objective of the amendment of Rule 25 in 1988 was to have a final date for filing a divisional which the applicant would have in his own hands, but which would still be early enough to ensure that the public would be informed by means of an indication on the printed patent specification that a divisional application had been filed.

5. During the 1999 EUROTAB meeting it came to light that many contracting states have a far more liberal policy than the EPO as to the last day for filing a divisional, and accept a divisional on any pending application. It is proposed to amend Rule 25 EPC accordingly. The word "any" clarifies that it is irrelevant what kind of application the parent is. The parent could thus be a divisional itself.

6. Grant proceedings are pending until the date that the European Patent Bulletin mentions the grant (cf J 7/96, OJ 1999, 443), or until the date that an application is finally refused or (deemed) withdrawn. The applicant is aware of the date on which the grant of the patent will be published, so he will know until when he can file a divisional. Under the proposal, the public will no longer be informed by the patent specification that a divisional has been filed, but since interested parties nowadays tend to rely on electronic databases for

patent information, and these databases will be able to show within a short time whether a divisional has been filed, the proposed system should have no drawbacks for third parties."

- There were thus strong doubts that the Enlarged Board of Appeal would adhere to the view expressed in Opinion G 10/92 that the 1988 version of Rule 25(1) EPC was valid and was to be applied as it stood, instead of adopting the view expressed in decisions J 11/91 and J 16/91. At the very least a question on this should be referred to the Enlarged Board of Appeal, such as questions (C), (D) and (E) of the Third Auxiliary Request, so that the Enlarged Board could make a new assessment of the question in the light of the subsequent change of law.
- Even if the 1988 version of Rule 25(1) EPC was valid as it stood, Article 122(1) EPC did apply to the time limit for filing a divisional laid down by this rule, and accordingly the Appellant's request for re-establishment into the period for filing a divisional needed to be considered on its merits.
- Article 122(1) EPC did not contain details as to what was a time limit. There was no requirement that this be set by the EPC or by the Office, nor that it be expressly given the applicant.
- Article 122(1) EPC only expressly required that the non-observance of a time limit cause the loss

of a right, and this was the case here, and in fact Opinion G 10/92 acknowledged that failure to comply with this provision of Rule 25(1) EPC meant the loss of a substantive right.

- While agreeing that in German law a distinction was made between a "Frist" and a "Termin" (set date) the period allowed for filing a divisional application under the 1988 version of Rule 25(1) EPC was clearly a "Frist", namely a period for performing a procedural act, and not a "Termin" or set date, and so could not be precluded from *restitutio* under Article 122 EPC. The period was the time between filing the parent and the date of giving approval.

- The legislator's will to provide a loss of right after the expiry of a time limit did not prevent the application of *restitutio* but was actually a precondition for this.

- Decision G 1/86, allowing also opponents to rely on Article 122 EPC for re-establishment into the time limit for filing grounds of appeal, showed that Article 122 EPC should be given a wide interpretation beyond its explicit wording, and such a wide interpretation was also advocated in all commentaries. Thus for example in the paper published by Prof. Dr. Dr. Romuald Singer (GRUR int. 1981, 719) on the historical development of Article 122 EPC there was nothing which could justify the exclusion of the time limit laid down in the [1988 version of] Rule 25(1) EPC from Article 122(1) EPC.

- Rule 25(1) EPC was not one of the time limits excluded by Article 122(5) EPC, and this supported the view that Article 122 EPC should also be applied to the period for filing a divisional which was a time limit in the sense of Article 122(1) EPC.

- Decision J 21/96 merely contained an unreasoned assertion that the 1988 version of Rule 25(1) EPC contained no time limit, and the decision J 7/90 referred to therein was totally silent on this question. Thus there was only a single case denying that Rule 25(1) EPC contained any time limit, but no established case law to this effect. The Board should thus reconsider this important point and, if it could not immediately adopt a view favourable to the applicant, at least submit a question on this to the Enlarged Board of Appeal.

X. The requests finally submitted by the Appellant on 3 November 2004 and received on 5 November 2004, are the following:

The Main Request is that the request under Article 122 EPC dated 6 April 2001 be granted and European patent application No. 01 102 571.5 be treated as a divisional application.

The First Auxiliary Request is that the following points of law be referred to the Enlarged Board of Appeal:

- (A) Is Article 122 EPC applicable to the period of time for filing a divisional application as specified in Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 ?
- (B) Does the answer to question (A) also apply to Rule 25(1) EPC as valid from 2 January 2002 in view of the fact that the end of the period for filing a divisional application is in both cases a conditional act, namely the applicant's approval to the text for grant of the earlier application in case of Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 and the mentioning of the grant of the patent in the European Patent Bulletin in case of Rule 25(1) EPC as valid from 2 January 2002?

The Second Auxiliary Request is that European patent application No. 01 102 571.5 be treated as a divisional application on the grounds as set forth in decisions J 11/92 and J 16/91, particularly on the ground of points 2.3.3 to 2.3.6 of the reasons.

The Third Auxiliary Request is that the following points of law be referred to the Enlarged Board of Appeal:

- (C) Can Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 allowing filing of a divisional application up to approval in accordance with Rule 51(4) concerning the parent application be considered perfectly reasonable and appropriate as found in G 10/92 in the light of the experience with this provision and in comparison with the

corresponding provisions in the contracting states as documented in CA/127/01 ?

(D) In case Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 cannot be considered perfectly reasonable and appropriate in retrospect, can the view on the validity of Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 as set forth in G 10/92 be upheld?

(E) In case the view on validity of Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 as set forth in G 10/92 cannot be upheld, is it within the discretion of the EPO to accept a divisional application on a pending European application after the approval in accordance with Rule 51(4) EPC in the light of the experience with Rule 25(1) EPC as valid from 1 October 1988 to 1 January 2002 and in comparison with the corresponding provisions in the contracting states as documented in CA/127/01?

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.
2. Following the oral proceedings that took place on 3 February 2002 and the Board's subsequent communication of 3 September 2004, no request for further oral proceedings was made. As the subject of the proceedings remained the same, only legal issues being addressed in said communication of 3 September

2004 and the reply thereto by the appellant, the Board is in a position to issue its decision without further communication or appointment of oral proceedings whilst respecting the rights of the Appellant pursuant to Articles 113 and 116 EPC.

3. It is not in dispute that on the facts of this case (see point II above) the application from which the present appeal arises was filed on 2 February 2001, after the date on which the appellant had given approval of the text, in accordance with Rule 51, paragraph 4, EPC in which the European patent on the purported parent application 97 102 041.7 was to be granted, but before the date on which a patent was actually granted on this, that is, while the purported parent application was still pending.

Version of Rule 25(1) EPC to be applied

4. The version of Rule 25(1) EPC in force between 1 October 1988 and 1 January 2002 (hereinafter referred to as "1988 version of Rule 25(1) EPC") reads:

"Up to the approval of the text, in accordance with Rule 51, paragraph 4, in which the European patent is to be granted, the applicant may file a divisional application on the pending earlier European patent application."

5. In accordance with general principles of law, the validity of an act, here the filing of a purported divisional application, is judged according to the law in force at the time of the act being performed. On the date of filing of 1 February 2001, the law governing

the filing of divisionals was the 1988 version of Rule 25(1) EPC. As the appellant had at the time of filing the purported divisional application already approved the text in which the earlier application was to be granted, this purported filing of a divisional application was not permitted by this governing law.

6. The appellant seeks to avoid this result in two ways, both by filing an application pursuant to Article 122 EPC to have rights re-established in respect of filing a divisional application in respect of the 1988 version of Rule 25(1) EPC, and alternatively by arguing that the law to be applied should rather be that of the version of Rule 25(1) EPC in force from 2 January 2002 (hereinafter referred to as "2002 version of Rule 25(1) EPC") which reads:

"The applicant may file a divisional application relating to any pending earlier European patent application."

The Board will first deal with the question of the applicable law.

7. The validity of the 1988 version of Rule 25(1) EPC, has already been considered by the Enlarged Board of Appeal in Opinion G 10/92, which came to the conclusion that the 1988 version of Rule 25(1) EPC meant precisely what it said (see point 1), and that the Administrative Council had reasonably exercised its rights as legislator under the provisions of Article 76(3) EPC in setting such a specific time limit for filing a divisional (see points 9 to 11, disapproving consolidated cases J 11/91 and J 16/91 (OJ EPO 1994, 28)

which had come to the opposite conclusion). This Board agrees wholly with the reasons given and conclusions reached in that Opinion.

8. It is true that by decision dated 18 October 2001, the Administrative Council changed Rule 25(1) EPC to the above quoted 2002 version, but only with effect from 2 January 2002. It must be presumed that the Administrative Council were aware of Enlarged Board of Appeal Opinion G 10/92 on the 1988 version of Rule 25(1) EPC. If the Administrative Council had wished for the 2002 version of Rule 25(1) EPC to apply from an earlier date, they were free to do this. It would then however have been expected for the sake of legal certainty that they would have explicitly indicated such earlier date. That the Administrative Council enacted that the new version should only apply as of a future date can only mean that they intended that before the 2 January 2002 the 1988 version of Rule 25(1) EPC should continue to apply.

9. The Appellant argues that the reasons as set out in preparatory document CA/127/01 submitted to the Administrative Council justifying a change to Rule 25(1) EPC, on the basis of which document the Administrative Council by its decision of 18 October 2001 did indeed change the law to the more generous provisions of the 2002 version of Rule 25(1) EPC, mean that the provisions of the 1988 version of Rule 25(1) EPC must be treated as unreasonable. In particular the appellant argues this in relation to the reason stated in point 7 of CA/127/01 which reads:

"Under the proposal the public will no longer be informed by the patent specification that a divisional has been filed, but since interested parties nowadays tend to rely on electronic databases for patent information, and these databases will be able to show within a short time whether a divisional has been filed, the proposed system should have no drawbacks for third parties."

10. However the fact that the Administrative Council considered that technical developments allowed a change in the law as from a particular date which made the provision more favourable to applicants, cannot in anyway suggest that the previous provision in force before that time was unreasonable. A legislator must find some balance between the interest of applicants for a patent obtaining the broadest protection possible by filing divisional applications even at a very late stage and the interests of third parties who wish to have legal certainty as early as possible in relation to what divisional applications may affect their business interests. There may be many different legal provisions each balancing these conflicting interests in a different way, for each of which provisions there would be good reasons without this meaning that a different legal provision would be unreasonable. Merely because the legislator has changed the law provides no basis for saying that the previous version of the law was unreasonable. The Board cannot see that the introduction of the new 2002 version of Rule 25 EPC, allows the 1988 version of Rule 25(1) EPC to be treated as unreasonable, or to ignore the fact that the

Administrative Council left the 1988 version of Rule 25(1) EPC in force until 1 January 2002.

11. Further as stated in point 8 of decisions G 2/02 and G 3/02 of the Enlarged Board of Appeal (OJ EPO 2004, 283) point 8.8:

"In a codified legal system such as the EPC, the judge cannot simply decide, as the need arises, to substitute himself for the legislator, who remains the primary source of law. He may certainly find occasion to fill lacunae in the law, in particular where situations arise for which the legislator has omitted to provide. He may even contribute to the development of the law, beyond the filling of lacunae. In principle, however, statute law should provide him with reference points, even if these are incomplete."

Merely because the legislator could have been more generous to certain classes of applicants by introducing a change in the law earlier, does not entitle the Boards of Appeal to apply the EPC contrary to its explicit provisions for the time in question, and so be more generous than the legislator intended.

12. Not to apply the 1988 version of Rule 25(1) EPC as it stands, would be to go against what the legislator has laid down, against what the Enlarged Board of Appeal has stated in opinion G 10/92 specifically in point, against the general principle above quoted stated in decisions G 2/02 and G 3/02, and against the uniform practice of the Boards of Appeal subsequent to opinion G 10/92. This Board would not be prepared to do so, as

it agrees with the existing statement of the law. Nor does it consider a referral of any question of law on this to the Enlarged Board of Appeal necessary, as the legal position is already quite clear that at the date relevant for this appeal, 2 February 2001, the 1988 version of Rule 25(1) EPC is to be applied as it stands.

Article 122 and Rule 25 EPC

13. The Appellant's request pursuant to Article 122 EPC requires first a consideration of the circumstances in which Article 122 EPC is applicable at all. Article 122(1) EPC reads "*The applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of this Convention, ofthe loss of any other right*". The equivalent terms for "time limit" in the equally authentic German and French texts of the EPC are respectively "Frist" and "délai". Whereas the English term "time limit" is a rather general term having no specific established meaning in English law, the German term "Frist" and French term "délai" have quite specific legal meanings, in particular for the purposes of the national legal provisions on *restitutio* under Swiss and German patent law. This is of significance as the origin of Article 122 EPC goes back to the first working draft of 15 November 1961 (Erster Arbeitsentwurf eines Abkommens über ein europäisches Patentrecht, Bonn, den 15 November 1961, pages 16 to 23, containing definition of Frist, and referring on

page 20 to Schweizerisches Patentgesetz, Artikel 47 und 48, and Deutsches Patentgesetz, Artikel 43), which bases the suggestion of *restitutio* on corresponding provisions in German and Swiss patent law (see article by Dr Romuald Singer in GRURInt 1981, 719 (hereinafter Singer 1981)). For the purposes of this German and Swiss national legislation "Frist" (or "délai") had a much more precise meaning than suggested by the English "time limit", which more precise meaning could be paraphrased in English only by the long expression "period prescribed for performing a procedural act". Further a "Frist" was distinct from a "Termin" or in English "set date". This distinction could be critical for the application of the institution of *restitutio* which was normally only possible in the case of a "Frist" and not a "Termin".

14. Without going so far as to suggest that "time limit" in Article 122 EPC must be interpreted in precisely the sense that "Frist" or "délai" was interpreted under German or Swiss law, the Board considers that the equal authenticity of the official text of the EPC in each official language means that the term "time limit/Frist/délai" cannot be interpreted broadly merely on the basis of the English text used, but must be given the same meaning for all three languages, and one that can be said to be fairly based on the usage of the respective terms in the countries whose provisions served as model for the institution of *restitutio*, insofar as the drafters of the EPC did not deliberately intend to depart from such usage. There is no indication that the drafters did wish to depart from such usage. Thus the mere fact that, as in the 1988 version of Rule 25(1) EPC, a cut-off date, the date of

- approval of the text for grant of the earlier application, is laid down after which a divisional application cannot be validly filed, cannot be taken to imply that there is a "time limit/Frist/délai" involved for the purposes of Article 122 EPC, as while such a cut-off date could be described as a "time limit", it cannot be described as a "Frist" or "délai", nor is it so described in the 1988 version of Rule 25(1) EPC.
15. The use of the rather broader English term "time limit" in the English text seems to have been introduced as a mere translation of the German "Frist" and French "délai". As English law does not know of such *restitutio* or any institution equivalent to such *restitutio* of general application, and the contribution of the British delegation seems essentially to have been confined to suggesting that the whole provision was unnecessary, but if it existed it should be narrowly interpreted (see Singer 1981, page 722), the Board cannot infer that the presence of the English "time limit" can or should lead to the provision of Article 122 EPC being given a broader interpretation than warranted by "Frist" in the German text or "délai" in the French text.
16. That Article 122(5) EPC does not list Rule 25 EPC as a provision excluded from the provisions of Article 122 EPC cannot assist the Appellant's argument. The excluded provisions all in their French or German text refer to a "délai" or "Frist" respectively, whereas neither of these terms (nor in fact the English term "time limit") appears in the 1988 version of Rule 25(1) EPC. Obviously if no "time limit/Frist/délai", is involved under the 1988 version of Rule 25(1) EPC

Rule 2, then already for that reason *restitutio* cannot apply to the filing of a divisional application, and there could be no question of needing a mention under Article 122(5) EPC to exclude the application of *restitutio* in relation to the filing a divisional application.

17. It is also relevant to consider the version of Rule 25(1) EPC in force during the ten years prior to 1 October 1988 reading:

(1) A European divisional may be filed:

(a) at any time after the date of receipt of the earlier European patent application by the European Patent Office, provided that after receipt of the first communication from the Examining Division, the divisional application is filed within the period prescribed in that communication or that after that period the Examining Division considers the filing of a divisional application justified.

(b) within two months following the limitation at the invitation of the Examining Division of the earlier European patent application if the latter did not meet the requirements of Article 82.

The German and French texts of this version of the Rule use the term "Frist" and "délai" respectively for the English term "period prescribed" of part 1(a), but not in part 1(b). The only presumption that can arise from the fact that Rule 25 is not mentioned as excluded in Article 122(5) EPC is that the "time limit/Frist/délai" mentioned in part 1(a) of the

original version of 1977 Rule 25(1) EPC was not meant to be excluded from *restitutio*.

18. The decision of the Administrative Council of 10 June 1988 which enacted the 1988 version of Rule 25(1) EPC, was taken on the basis of the proposals in preparatory document CA/29/88 which in Article 3 on pages 3 to 6 explained the considerations underlying the proposed new (1988) version as follows:

- "1. Divisional applications filed after the first communication on the parent application has been received from the Examining Division are currently subject to certain restrictions which are essentially the same as those set out in Rule 86(3) EPC.
2. However, because divisional applications are examined separately from the parent application, the sequence of procedures differs from that applying when amendments are made to a single patent application. Thus the Examining Division has to approve the filing of a European application before it is examined. There is no need at this stage to consider its content.
3. The Guidelines (Part C-VI, 9.3) accordingly state that the filing of a divisional application should normally be regarded as justified unless the communication under Rule 51(4) EPC has already been sent. Since the same fees are payable for a divisional as for an independent European application, in practice applicants tend to file

divisional applications only when it is important for them to do so.

4. The present procedure requiring approval by or a request from the Examining Division causes complications because at this stage the earlier application is in the hands of the Examining Division in Munich whereas the divisional application still has to go through the examinations on filing and as to formal requirements by the Receiving Section at the Hague.
5. Under the Paris Convention for the Protection of Industrial Property the conditions under which patent applications may be voluntarily divided - including those currently laid down in Rule 25(1) EPC - may be determined by national or regional law (Article 4 G (2) Paris Convention).
6. It is therefore proposed that the mere formality of obtaining Examining Division agreement be abandoned and that an applicant be entitled to file divisional applications until such time as he has under Rule 51(4) EPC given his approval of the text in which the patent is to be granted. This would eliminate existing differences between voluntary and mandatory division, particularly with regard to the time limits. The change would not affect the question of what may be substantively constitute the subject-matter of a divisional application, which in any case is a matter to be examined after the applicant has filed a request for examination.

7. The new wording of Rule 25(1) EPC simplifies the procedure for both the Office and the applicant and makes for greater certainty in divisional proceedings. It is in line with the thinking of those concerned in industry and the patent profession.

It should be emphasized that the filing of a divisional application is in no circumstances admissible once the applicant has approved, in accordance with Rule 51(4) EPC, the text in which the patent is to be granted on the parent application.

8. No transitional arrangement is necessary since once the proposed decision has entered into force it will no longer be possible for the Examining Division to disallow filing of a divisional application under Rule 25(1)(a) as it now stands, irrespective of whether the divisional application was filed before or after that date. Only divisional applications already finally declared to be unjustified will be unaffected by the new ruling."

19. From point 7 of document CA/29/88 - XXIX above cited it emerges clearly and unambiguously that it was the legislators intention that the filing of a divisional application in no circumstances be admissible once the applicant has approved, in accordance with Rule 51(4) EPC, the text in which the patent is to be granted on the parent application. This was precisely the same cut-off date for the filing of a divisional, which the

Examining Division had applied in exercising its discretion to refuse consent to the filing of a divisional under the earlier version of Rule 25 EPC. Thus it is in accordance with the legislator's intention that this date of approval be a cut-off date, and it was intended that nothing, not even proof that the failure to file the divisional application by this date was despite all due care having been used by the would-be applicant, would allow the filing of a divisional after this date.

20. A further consideration why *restitutio* should not apply to the situation of filing a divisional under the 1988 version of Rule 25(1) EPC, based on the principle that legal provisions should be appropriate to the situation in which they are to be applied. It is of the essence for the grant of *restitutio* that all due care has been used, and this is a high standard. Giving approval of the text in which the parent application is to be granted is something known to the applicant, so that not filing the divisional before doing this would seem in virtually all cases to be attributable to ignorance or forgetfulness of the law, which would be incompatible with all due care having been used. It thus makes no legal sense by a contorted interpretation of the term "time limit" to afford the possibility of *restitutio* in a situation which cannot occur except where all due care clearly has not been used thus preventing the grant of *restitutio*.

21. The above reasons deal specifically with arguments put forward by the Appellant in this case. The same conclusion that the 1988 version of Rule 25(1) EPC does not lay down a time limit within the meaning of

Article 122(1) EPC was arrived at in exemplary brief fashion in decision J 21/96 of 6 May 1998 on the basis that "...It merely identifies a point in the grant procedure after which a divisional application may no longer be filed..." (see point 2 of that decision). Similarly decision J 24/03 of 17 February 2004 also, for the reasons set out in its points 3 to 6, arrives at the conclusion that Article 122 EPC is not applicable to the filing of a divisional as Rule 25 EPC involves no time limit in the sense of Article 122 EPC. The Board in this composition agrees with the reasoning of these two decisions and adopts such reasoning as further grounds supporting its conclusion that Article 122 EPC is not applicable to the filing of a divisional.

Conclusions

22. As the present application was filed outside the period laid down in the 1988 version of Rule 25(1) EPC for filing divisional applications, and as the request under Article 122 EPC must be refused for the reasons given under points 13 to 21 above, the Appellant's Main Request cannot be allowed.

23. Again for the reasons stated in points 13 to 21 above the Board considers that the legal position is clear that there is no possibility of relying on the provisions of Article 122 EPC where an applicant only attempts to file a divisional application under the provisions of the 1988 version of Rule 25(1) EPC after the date on which he has given approval to the text of the earlier application, and this is also the established case law of the Boards of Appeal.

- Accordingly the Board sees no occasion to refer question (A) set out in the appellant's First Auxiliary Request, or any similar question of law to the Enlarged Board of Appeal.
24. Question (B) set out in the appellant's First Auxiliary Request relates to a hypothetical question concerning the 2002 version of Rule 25(1) EPC in force from 2 January 2002. The answer to this question (B) would not be relevant to any issue arising in this appeal, and accordingly is not suitable for a referral under the provisions of Article 112(1) EPC in this case.
25. As the Board does not regard either question the subject of the First Auxiliary Request suitable for referral, the First Auxiliary Request must be refused.
26. The Second Auxiliary Request asks that this Board follow decisions J 11/91 and J 16/91, and in particular the ground of points 2.3.3 to 2.3.6 of their reasons coming to the conclusion that the 1988 version of Rule 25(1) EPC is incompatible with Article 76 EPC and does not represent the final date by which a divisional application on a pending earlier European patent application must be filed. Decisions J 11/91 and J 16/91 have been disapproved by Enlarged Board of Appeal in opinion G 10/92, and these decisions cannot be treated as correctly stating the law. For the reasons given above in points 7 to 12 this Board fully agrees with the view of the law and the reasons stated in opinion G 10/92, and accordingly the Second Auxiliary Request is refused.

27. For the reasons set out in points 7 to 12 above the 1988 version of Rule 25(1) EPC can be considered perfectly reasonable and appropriate, so that the answer to Question (C) set out in the appellant's Third Auxiliary Request is clearly yes. This is in accordance both with opinion G 10/92 and the established case law following that opinion, and the Board sees no need for the referral of this question to the Enlarged Board of Appeal under the provisions of Article 112(1) EPC.

28. Question (D) and (E) set out in the appellant's Third Auxiliary Request presuppose that the answer to question (C) is not definitely yes, and that question (C) is to be referred to the Enlarged Board of Appeal. As this Board considers that the answer to question (C) is definitely yes, and is not referring question (C) to the Enlarged Board of Appeal, referral of questions (D) and (E) is also unnecessary.

29. As the Board considers that none of the questions the subject of the Third Auxiliary Request need be referred the Third Auxiliary Request must be refused.

Order

For these reasons it is decided that:

1. The requests for referral of questions to the Enlarged Board of Appeal are refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J. C. Saisset