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D E C I S I O N
of 8 July 2005

Case Number: J 0018/02 - 3.1.01

Application Number: 99203999.0

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:
Fuel oil compositions

Applicant:
INFINEUM USA L.P.

Headword:
Patent application filed with EASY software/INFINEUM

Relevant legal provisions:
EPC Art. 75(1)(a), 80, 122, 125
EPC R. 24(1), 25(1) [version applicable before 2 January 2002],
51(4) [version applicable before 1 July 2002]
"Notice of the President of the Office on EASY filing"

Keyword:
"Filing of divisional application with EASY-software - paper
copy filed later as approval given to the parent application"
"Application of the principle of correlation and mutual
dependency (no)"
"Approval with minor corrections deferred (no)"
"Inconsistency between the paragraph 5 "paper copy"
requirement in the Notice on EASY filing and interpretations
of Article 80 EPC"

Decisions cited:
G 0010/92, G 0012/91, J 0027/84, J 0011/91, J 0036/92,
J 0014/85, J 0015/95, J 0016/95, J 0017/95, J 0024/95,
J 0025/95, J 0029/95, J 0012/99, J 0006/00

Catchword:

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Case Number: J 0018/02 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 8 July 2005

Appellant: INFINEUM, USA L.P.
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Decision under appeal: Decision of the Receiving Section of the EPO
dated 22 March 2002.

Composition of the Board:

Chairman: J.-C. Saisset
Members: G. Weiss
P. Mühlens

Summary of Facts and Submissions

- I. European patent application 95 942 662.8 was filed on 13 December 1995. A communication pursuant to Rule 51(4) EPC (version applicable at the time) was sent to the appellant on 21 May 1999. The four-month time limit for approval was extended at the appellant's request. By a letter dated 29 November 1999 and received on 30 November 1999, the appellant approved the text of the proposed application: "applicant approves the text of the Druckexemplar subject to the following corrections In view of the minor nature of the corrections, the Examiner is kindly asked to hand-amend the pages on file. The applicant apologises for the delay in responding to the Rule 51(4) communication which was due to the need to file divisional applications on instructions from the client."
- II. On the same day, 30 November 1999, a printout of F1001E (Request for grant) and a diskette containing the technical documents produced using the EASY software were filed in respect of European patent application No. 99 203 998.2 with notification that the application was a divisional application based on the earlier European patent application No. 95 942 662.8.
- III. By communication sent by fax on 14 December 1999, the Receiving Section informed the applicant of the deficiency - the paper copy of technical documents and the conformity statement were missing - and invited him to file the technical documents in paper form. In the communication, reference was made to Rules 25(1) EPC (version applicable at the time) and 51(4) EPC (version applicable at the time).

- IV. The paper application documents were filed on 15 December 1999.
- V. By communication pursuant to Rule 69(1) EPC of 24 July 2000, the Receiving Section informed the applicant that the application could not be treated as a divisional application because it had not been filed in due time in the form required by the Notice of the President dated 22 July 1997 concerning the filing of European patent applications prepared by means of the EASY software (OJ EPO 1997, 377), which prescribed that the paper copy of the technical documents accompanying Form 1001E would constitute the authentic version of the application and that the date of receipt of these documents would be the date of receipt of the application (paragraph 5). The paper copies of the technical documents were filed on 15 December 1999, which is therefore the date of receipt of the application. It follows that the application was filed too late to be treated as a divisional application, the approval in the parent application having been given on 30 November 1999.
- VI. By letter received on 2 August 2000, the representative requested that the filing of the divisional application be allowed, and if necessary that oral proceedings be arranged, and, should the request not be allowed, that a decision be issued under Rule 69(2) EPC.

It was pointed out that the earlier application had been the subject of accelerated examination and that after receipt of the Rule 51(4) EPC communication a time of the principle of "correlation and mutual

dependency" and the decision J 36/92 of 20 May 1994 (not published in OJ EPO).

- VII. On 12 June 2001, the Receiving Section issued a communication in which it upheld its finding that the application could not be treated as a divisional application. It was clearly indicated that since all the documents constituting the authentic version of the application had not been received, or even despatched, by the time of filing of the approval under Rule 51(4) EPC, Rule 25(1) EPC cannot be said to have been fulfilled. The reference in the letter of approval to the need to file divisional applications is not relevant in this respect. It is to be read as an explanation of why an extension to the time limit was requested, not as a clear statement that a divisional was filed. It cannot therefore be said that this reference and the declaration of approval have to be seen as correlated and mutually dependent on each other.
- VIII. In his response filed on 16 August 2001, the appellant reiterated his argument that the principle of "correlation and mutual dependency" developed by the case law of the Legal Board of Appeal should be applied in a situation where an applicant:
- (a) has intended to comply with the provisions of Rule 25(1) EPC by correctly synchronising the filing of a divisional application and the response to the Rule 51(4) communication on the parent application,

(b) has indicated this intent to the EPO and confirmed the act of filing the divisional in his Rule 51(4) response, and

(c) through an administrative error, nevertheless formally fails to comply with Rule 25(1) EPC.

This principle is applicable in the present case. Reference was also made to J 27/84 (OJ EPO 1995, 831).

IX. On 22 March 2002, the Receiving Section issued a decision refusing to treat the application as a divisional application of the earlier application on the grounds explained above. In particular the case law of the Legal Board of Appeal cited by the appellant was discussed in points 6 to 8 of the Reasons for the decision:

"In the view of the Receiving Section, decision J 36/92 concerned a special situation and therefore has to be confined to the facts. There, the documents for the divisional application arrived one day later than the applicant's approval under Rule 51(4) EPC in the parent application because they were sent by courier, while the letter of approval was filed, according to the facts, in error by facsimile. However, by the time the approval was received at the EPO, not only had the applicant already despatched all the documents necessary for the filing of the divisional application but had included in the letter of approval an unambiguous statement that a divisional application had been filed on the same day so these two pieces of information had to be seen as correlated and mutually dependent on each other. Under these circumstances, the

Legal Board found that the requirements of Rule 25(1) EPC had been fulfilled (Reasons, point 3).

In the case of decision J 27/94, the first sentence of the applicant's letter contained the approval of the text and the second sentence a declaration that a divisional application would be filed, with reference to J 11/91 [filing of a divisional application up to the date of the decision to grant]. Here, too, the Legal Board held that these two declarations could not be separated from each other without neglecting their correlation and mutual dependence. The applicant had made it quite clear that he was declaring his approval because it was still possible to file a divisional application thereafter, according to the case law on which he was relying (Reasons, point 8). As the Legal Board commented in later decisions (see eg J 14/95, J 24/95, both of 20 August 1997), the situation in J 27/94 was that both intentions existed at the same time but could not be realised in parallel. The inconsistency of the declarations was a reason not to consider the approval as valid.

It is true that in the present case the letter of approval in the earlier application No. 95 942 662.8 referred to the delay being "due to the need to file divisional applications on instructions from the client". However, this is to be read as an explanation of why an extension to the time limit was requested, not as a clear statement that divisional applications were filed. Nor is there an evident inconsistency with the approval. It cannot therefore be said that this reference and the declaration of approval have to be

regarded as correlated and mutually dependent on each other as in J 36/92 or J 27/94."

- X. On 22 May 2002, the applicant filed a notice of appeal against this decision, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 1 August 2002.

- XI. On 25 May 2004, the Board issued a first communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal. A second communication from the Board was issued on 2 March 2005 together with the summons to oral proceedings pursuant to Rule 71(1) EPC.

- XII. Oral proceedings were held on 8 July 2005.

- XIII. The appellant's arguments, including those submitted with the statement of grounds and in reply to the Board's communications, can be summarised as follows (order of arguments as made by the appellant):

(a) Concerning the application of the principle of "correlation and mutual dependency":

The application documents should be regarded as having been filed not later than the letter of response of 30 November 1999. This position is supported by reference to the principle of "correlation and mutual dependency" as developed in J 36/92 and J 27/94. The appellant's clear intention to co-ordinate two actions as a single procedural act provided a sufficient degree of correlation and mutual dependency to justify allowance of the divisional filing under Rule 25(1) EPC.

In the present case, the file history of the earlier application was highly relevant in defining the overall circumstances surrounding the filing of the divisional application. The earlier application was under accelerated examination. During this process the applicant had expressed his intent to file divisional applications (applicant's letter of 19 March 1999: "the applicant intends to pursue other subject matter in due course via divisional applications"), but after receiving the Rule 51(4) communication had nevertheless requested an extension of the time limit for response. In his response (applicant's letter of 29 November 1999: "Further to the communication under R.51(4) EPC dated 12 May, applicant approves the text of the Druckexemplar subject to the following corrections"), having been granted an extension, he apologised for the delay but stated that this "was due to the need to file divisional applications" [emphasis added], ie a direct reference to the act of filing rather than an expression of mere intent.

A request for a time extension during accelerated examination is very unusual. Having received the Rule 51(4) communication, there would normally be no reason to delay the proceedings. It is apparent from this special context, from the earlier declared intent to file divisional applications, and from the explicit statement in the response to the Rule 51(4) communication, that the only reason for this unusual step was the need to file divisional applications, and hence implicitly to comply with Rule 25(1) EPC. In these particular circumstances, the applicant's response to the Rule 51(4) communication and filing of

the divisional applications should therefore be seen as correlated and mutually dependent on each other. In summary, the EPO was notified *twice* of the applicant's clear intention to file divisionals. The second sentence of the Rule 51(4) EPC reply made express reference to the filing of divisionals, communicated the applicant's intention to file divisionals within the permitted time, conferred the information that the Rule 51(4) reply and the filing of divisionals were coordinated procedural acts and provided the information that the applicant did not intend his Rule 51(4) EPC reply to damage the filing of his divisional.

Considering the circumstances of this case, it appears that the junior member of staff given the task by the formalities department of completing the document submission had, at that point in time, been unfamiliar with the details of the EASY system. The paper copies were omitted from the document packs and the covering letter of 29 November 1999, in spite of the "pages end" stipulation on the signed 1001 form. The appellant (through the representative) always intended the filing of the divisional and the text approval of the parent to be correctly synchronised, and had given instructions in accordance with the internal working practices of the in-house patent department. It must, however, also be accepted that whilst an administrative error clearly did take place, this error was attributable at least in part to the lack of knowledge of the staff member given the task of carrying out the final step of document submission.

(b) the applicant's final approval of the text for grant in respect of the earlier application took effect on or after the filing date of the subsequent applications:

G 10/92 makes it clear ("it is desirable that, from a certain point in time onwards, the EPO can rely on the proposed text for grant which has been agreed upon by both the applicant and the Examining Division" [emphasis added] (Section 10, last paragraph)) that the final approval of the text by the applicant is the decisive moment on which the filing of a divisional application must be judged. The date on which the text for grant was finally approved in respect of the earlier application in the present appeal should therefore be determined.

The Rule 51(4) response of 30 November 1999 was not an unconditional approval of the notified text of the earlier application, but a request for amendments under Rule 86(3) EPC and an indication that, subject to the amendments being allowed, the text (in the amended text) could be deemed to be finally approved by the applicant. The approval of the text in the parent application was "unequivocal", an approval which is *conditional upon* the acceptance of proposed amendments by the examining division.

This circumstance (analogous to J 29/95) leads to the conclusion that the final approval of the text for grant cannot be deemed to have been given until the examining division has considered and allowed the proposed amendments under Rule 86(3) EPC. Only when this acceptance is given is the official text on file

put in the form approved by the applicant; it is at this point that the applicant's final acceptance should be "deemed" to take effect. The allowance of the amendments was first notified to the applicant in the Rule 51(6) EPC communication dated 23 December 1999 (ie eight days after the filing date of 15 December 1999 accorded by the Receiving Section to the later applications). Also, according to G 12/91, this communication must have resulted from the completion of the relevant EPO internal procedure three days before the issued date, ie on 20 December 1999. On the balance of probabilities the appellant considers it unlikely that the amendments under Rule 86(3) EPC were allowed prior to 15 December 1999, and on this basis the approval of text would not have been deemed final before the filing of the later applications.

Even if substantive examination is not re-opened in accordance with (old) Rule 51(5) EPC, it is clear that the examining division must assent to any amendments proposed by the applicant (see the Notice of the Vice-President of DG 2, dated 20 September 1988, concerning the treatment of requests for amendments to application documents following dispatch of the communication pursuant to Rule 51(4) EPC (EPO OJ 1989, 43) at paragraph 3, sub-paragraph (c)). Until that point is reached, the policy consideration of a mutually-agreed text has not been met. It is expressly stated in the above-mentioned notice that a request for amendments is to be understood as approval of the entire set of documents in the *amended text*, ie *not* the text as notified in the Rule 51(4) communication. The examining division cannot possibly assent to the amended text until it has studied the amendments.

It may feel that a position in law, in which a request for amendments introduces possible unclarity into the assessment of when the text is approved, is in principle unattractive. However, even if unattractive, this position logically follows on from the practice developed from the above-mentioned notice, and the policy consideration of grant on the basis of a mutually-agreed text. G 10/92 already expressly accepts that the final approval of the text can by definition be a moveable object. Examination can be reopened by the response to a first Rule 51(4) EPC communication, and in principle a very different text subsequently agreed. Unclarity in this respect therefore already exists, as a consequence of the wording of (old) Rule 25(1) EPC which referred to the approval of the text, and not simply to the "date of response to the Rule 51(4) EPC communication".

(c) The third argument: inconsistency between the paragraph 5 "paper copy" requirement of the Notice on EASY filing and Article 80 EPC

The requirement set out in paragraph 5 of the Notice of the President concerning EASY software, namely that the date of receipt of the paper copy (not the electronic copy) of the application documents will constitute the date of receipt of the EASY application, is in conflict with preceding and subsequent interpretations of the primary legislation (Article 80 EPC), as evidenced by measures adopted by the President under Rule 24(1) EPC.

Before the notice on EASY filing, the President issued a Notice relating to filing by facsimile (EPO OJ 1992, 306). After the notice on EASY filing, the President issued a Notice relating to on-line filing (EPO OJ 2002, 545). Both are consistent in their approach; the date of filing of the application is that on which the electronic form of the documents is received by the EPO. In the case of on-line filing, paragraph 7 of the Notice of 2002 states that the filing date accorded is the date of receipt of the electronic application documents, provided that these documents satisfy the requirements of Article 80 EPC. No written confirmation is required. In the case of filing by facsimile, paragraph 5 of the 1992 notice states that the filing date accorded is the date of receipt of the facsimile, provided that this satisfies the requirements of Article 80 EPC. In this case, written confirmation may be requested. It is clear that, in transmitting a facsimile to the EPO, the applicant does not physically send (and the EPO does not physically receive) anything other than an electronic document (encoded in a data signal down a telephone line). Nevertheless, this was sufficient to meet the requirements of Article 80 as far back as 1992. These notices are consistent in requiring the received electronic application to comply with the provisions of Article 80 EPC.

In contrast, in the 1997 notice on EASY filing, the President took the view (in setting out the "paper copy filing date" requirement, paragraph 5) that the electronic document *per se* of this approved communication means (the EASY diskette) did not in itself satisfy the requirements of Article 80 EPC. On the contrary, only a paper copy would suffice to

provide a date of receipt (filing date). This approach is contrary to the interpretation of Article 80, as applied before and afterwards.

There is also no basis in law for justifying various interpretations of primary legislation on the basis of powers provided only in subordinate legislation. On the contrary, the primary legislation must govern. Whilst Rule 24(1) EPC provides the President with power to permit filing by other means of communication, and lay down conditions governing their use, this can only be done within the legal framework of the primary legislation. Having decided to permit filing by the EASY diskette means of communication, there was no basis in Article 80 EPC or in law to draw the distinction that, on this occasion, the electronic documents would nonetheless *not* satisfy Article 80 and thus not to accord a valid filing date. The "paper copy filing date" requirement in paragraph 5 of the EASY Notice was an *ultra vires* oversight, and contrary to the public policy consideration supporting filing by electronic means.

(d) The fourth argument:

In general terms, the administrative error must be seen in the context of its consequences, namely the irreversible and definitive loss of patent protection obtained by virtue of the divisional application. The error was that a paper copy of the application was not filed at the same time as the EASY version; the paper copy was filed shortly after the application was filed via EASY. Thus the sanction is out of proportion with the error. It would seem appropriate to apply the

principle of proportionality recognised by the boards of appeal as a principle to be applied within the meaning of Article 125 EPC. There is no appropriate legal remedy for the error. If a time limit is not observed, there is provision for correction under Article 122 EPC and the policy requirements accepted and set by the boards of appeal allow for the correction of errors, in an acceptable manner, with respect to the sanctions incurred.

- XIV. The appellant requested that the decision under appeal be set aside, that the application be treated as divisional application of the earlier application 95 942 662.8 and that the filing date of the parent application be accorded; furthermore, that a binding direction be included in the order that the examination be accelerated.
- XV. At the end of the oral proceedings, the Board announced its decision.

Reasons for the Decision

1. The appeal complies with the provisions of Articles 106 to 108 EPC and of Rules 1(1) and 64 EPC and is, therefore, admissible.
2. In the present case, the applicable versions of Rules 25(1) and 51(4) EPC are those which were in force respectively before 2 January 2002 and 1 July 2002. The divisional application needed to be filed no later than on the date on which grant of the parent application

was approved following the communication issued pursuant to Rule 51(4) EPC.

- 2.1 The divisional application was filed using the EASY software. A Notice from the President of the European Patent Office dated 22 July 1997 (OJ EPO 1997, 377) had announced the possibility for applicants of filing patent applications in electronic form using the EASY software. The notice indicates that "EPO Form 1001E and the paper copy of the technical documents accompanying Form 1001E will constitute the authentic version of the application. The date of receipt of these documents will be the date of receipt of the application". The same information was also published in the July 1999 update of the Guidelines for Examination, A-II, 1.1.2, fourth paragraph.
- 2.2 The Board considers that the applicable texts - Rules 25(1), 51(4) EPC, the Notice from the President dated 22 July 1997 and the corresponding Guidelines for Examination - are clear and indisputable. Especially, the wording of that notice and of the guidelines clearly and unequivocally indicates that the date of receipt assigned is the date on which the paper copy of the documents concerned is received by the EPO.
3. *The first argument: application of the principle of "correlation and mutual dependency"*
 - 3.1 Concerning the appellant's first argument and applying the principle of "correlation and mutual dependency", the application documents should be regarded as having been filed no later than with the letter of 30 November 1999.

3.2 The Legal Board of Appeal has developed and applied the principle of "correlation and mutual dependency" to date in nine decisions, namely J 36/92, J 27/94, J 14/95, J 15/95, J 16/95, J 17/95, J 24/95, J 25/95 and J 06/00. Only J 36/92 and J 27/94 are essentially discussed during the appeal proceedings.

J 36/92 concerned an obvious correlation between the approval given and the filing of a divisional application. For a purely administrative reason linked to an error for which the firm of the professional representative involved was to blame, the divisional application was sent by post and the approval was faxed. The Board established a correlation between the two acts which had not been carried out simultaneously owing to an administrative error.

In J 27/94 - the principles of which were refined in J 14/95, J 15/95, J 16/95, J 17/95, J 24/95 and J 25/95 - the question at issue was whether the approval expressed by the applicant in reply to the Rule 51(4) communication was sufficiently clear to the EPO for the examining division to be able to issue the communication under Rule 51(6) EPC. The Legal Board had considered that the applicant had only given its approval "because it was still possible to file a divisional application thereafter", ie until the decision pursuant to Article 97(2) EPC to grant the European patent for the earlier application, according to J 11/91 (OJ EPO 1994, 28). In the aforementioned decisions following on from J 27/94, the Board stated that "in J 27/94 it was clear to the Examining Division when receiving the applicant's letter that the

applicant wanted his approval to take immediate effect but also that the applicant still wanted to file a divisional application on the basis of Rule 25 EPC as interpreted in J 11/91. Both intentions existed at the same time but could not be realised in parallel."

- 3.3 The approach adopted in J 36/92 and J 27/94 (also in J 17/95 which was expressly mentioned during the oral proceedings) cannot be applied to the present case since there was neither an administrative error in the sense of J 36/92 nor uncertainty or ambiguity as regards the approval expressed by the applicant. The applicant's statement expressing his approval is clear and unequivocal. The examining division could only conclude from this that the grant procedure was to be continued with the issue of the communication under Rule 51(6) EPC. The requested corrections were "minor". It was moreover entitled to consider that the divisional application had been filed in good time since the reply to the Rule 51(4) communication had explained why approval had been received late and the applicant, who was perfectly familiar with the applicable legal provisions, had filed the divisional application in accordance with Rule 25(1) EPC. Nor can an administrative error in the sense of J 36/92 be ascertained: it is more an ignorance of the legal regulations, ie only the paper version of the divisional application constitutes the authentic text (which the appellant seems to accept in his letter of 6 August 2004 in which he states that "the junior member of staff given the task by the formalities department of completing the document submission had ... been unfamiliar with the details of the EASY system"; the appellant and the representative "intended the

filing of the divisional and the text approval of the parent to be synchronised, but that the error is attributable in part to the lack of knowledge of the staff member given the task" [emphasis added]), which has nothing to do with the approval expressed by the applicant. Had the applicant known when expressing his approval that only the paper version constituted the authentic text, he would have complied with the requirements regarding the filing of his divisional application. In this instance, however, the paper copy was not filed with the technical documents accompanying Form 1001E and the question of a non-observance of a time limit and any legal remedies is not under discussion.

3.4 Moreover, the second sentence of the approval of the wording proposed for the parent application, "applicant apologises for the delay in responding to the Rule 51(4) communication, which was due to the need to file divisional applications", can be interpreted only as an explanation of why an extension to the time limit was requested and not as a clear statement that divisional applications were filed.

3.5 Under these circumstances, the principle of "correlation and mutual dependency" developed by the Legal Board of Appeal cannot be applied to the present appeal.

4. *The second argument: applicant's final approval of the text for grant in respect of the earlier application took effect on or after the filing date of the subsequent applications*

- 4.1 The applicant's approval of the text for grant in its letter of 30 November 1999 is clear and unequivocal. Not even the corrections/amendments proposed by the representative ("the minor nature of these corrections", according to his letter of 30 November 1999) could defer the date of the applicant's approval given at the earliest on the filing date of the paper copy of the divisional application, or even the date of despatch of the communication pursuant to Rule 51(6) EPC. This second argument is unfounded for a number of reasons.
- 4.2 According to Article 97(2)(a) EPC, if the examining division is of the opinion that the application and the invention to which it relates meet the requirements of the convention, it will decide to grant the European patent for the designated contracting states provided that it is established, in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in respect of which the examining division intends to grant the patent (see also Article 113(2) EPC). Hence, in order to establish that approval, Rule 51(4) EPC provides that, before the examining division decides to grant the European patent, it will inform the applicant of the text intended for grant and will request him to indicate his approval of this text.
- 4.3 This approval is a procedural statement and sets a clear point in time for both the EPO and the applicant, as Rule 25(1) EPC allows an applicant to file a divisional application only up to the approval in accordance with Rule 51(4) EPC. As stated in the Enlarged Board's Opinion of 28 April 1994 (OJ EPO 1994, 633, reasons 7), "for Rule 25 to apply it is the

applicant's final approval of the proposed text for grant that is decisive. If examination proceedings are reopened by the Examining Division after the approval in accordance with Rule 51(4) EPC, because - for whatever reason - the proposed text for grant is to be amended, Rule 51(4) EPC requires that the applicant once again be informed of the text in which the Examining Division intends to grant the European patent. In this case, for Rule 25 to apply, it is the last approval given by the applicant during proceedings that is decisive. Hence a divisional application may always be filed until the applicant's final approval in accordance with Rule 51(4) EPC, ie until it is clear that the applicant approves the final text proposed by the Examining Division".

4.4 The words "until it is clear that the applicant approves the final text proposed by the Examining Division" imply that, when the applicant files amendments/corrections with the approval in accordance with Rule 51(4) EPC, the proceedings are formally reopened for objections made by the examining division and that these objections are eventually addressed by the applicant. In that case, a second communication under Rule 51(4) EPC is required.

4.5 The Enlarged Board of Appeal in its decision G 10/92 considered also the advantages of the Rule 25 (old version) stressing in particular that under Rule 25 EPC the applicants can "determine this point [of the approval] themselves by giving approval in accordance with Rule 51(4) EPC, meaning that they are no longer ... dependent on the discretion of the Examining Division or on a time limit set in its first communication" (see

section 10, second paragraph). Therefore it is the applicant who fixes the exact date of the approval. It is only if the examining division cannot follow the amendments proposed by the applicant that the examining division has to reopen the procedure and a new notification pursuant to Rule 51(4) EPC has to be reissued.

- 4.6 Allowing amendments/corrections together with the approval of the proposed text for grant pursuant to Rule 51(4) EPC does not necessarily mean that the examination proceedings have to be reopened. The examining division has to examine the proposed amendments/corrections for their allowability. But such examination does not constitute the formal step of reopening the examination proceedings. If the proposed amendments/corrections - in the applicant's letter of 30 November 1999 it referred to "the minor nature of these corrections" - can be allowed, it is not necessary for the proceedings to be reopened. This was the case with the parent application of the application under consideration. It would only have been necessary to reopen the examination proceedings if the examining division had failed to agree to the amendments/corrections proposed by the appellant with regard to the parent application and had not only rejected them but also concluded that objections still needed to be met. This would have required a formal communication informing the applicant that the examination proceedings were to be reopened. In the present case, in which the examining division allowed the amendments/corrections forthwith, it was neither necessary to reopen the examination proceedings nor to issue a new communication under Rule 51(4) EPC. To

reopen the proceedings and issue a communication would have been pointless since the examining division was able to establish the applicant's approval of the text intended for grant. For the same reason, no second communication under Rule 51(4) EPC is required when amendments requested by an applicant in reply to a communication in accordance with said rule can be immediately accepted by the examining division (see J 29/95, OJ EPO 1996, 489, reasons 3).

4.7 With the letter received on 30 November 1999, the applicant gave his approval ("Applicant approves the text") subject to some corrections which he described as minor ("minor nature of these corrections"). The wording of this letter is not ambiguous and does not contain any reservations in connection with these corrections. In the Board's view, these are only "minor corrections" in this instance and not amendments. Moreover the sentence ("Applicant apologises for the delay in responding to the Rule 51(4) communication, which was due to the need to file divisional applications on instructions from the client.") suggests that the appellant knew perfectly well that he was giving his approval under Rule 51(4) EPC on the basis of the connections established with the filing of the divisional application.

4.8 Thus, the only approval given by the appellant in accordance with Rule 51(4) EPC was that received on 30 November 1999, ie before the paper version of the divisional application was filed on 15 December 1999. The latter was therefore filed late. This finding is in keeping with the common practice of the EPO based on the wording of Rule 51(6), first and second sentences,

EPC, according to which if the proposed corrections/amendments are accepted by the examining division, the grant procedure is resumed immediately with the Rule 51(6) EPC communication (see also Guidelines for Examination C-VI, 4.9 and 4.10). This is also in accordance with the Notice from the Vice-President DG 2 dated 20 September 1988 and cited by the appellant which relates only to amendments. Therefore, the divisional application has to be filed on the same day as the request for amendments and/or corrections. The Legal Board of Appeal reached a similar conclusion in its decision J 12/99 dated 16 March 2001 (not published in the OJ EPO).

5. *The third argument: inconsistency between the paragraph 5 "paper copy" requirement in the Notice on EASY filing and interpretations of Article 80 EPC*

Concerning the third argument, the Board judges that Rule 24 EPC should be considered as an implementing provision to Article 75 EPC. Rule 24(1), second sentence, EPC confers power on the President of the Office to authorise the filing of European patent applications using telecommunication systems and to lay down the conditions governing their use. Rule 24(1), third sentence, EPC incorporates the written confirmation which the President of the Office may, but need not, impose by virtue of his power to lay down the conditions of use. This would make it possible to dispense with the written confirmation, should it become superfluous in view of advances in technology. In the present case the paper copy accompanying EP-EASY is not the written confirmation, but the authentic version of the application (see paragraph 5 in the

Notice on EASY filing). The date of filing has to be accorded on the basis of the paper version of the application documents, provided it complies with Article 80 EPC.

It is superfluous to make comparisons with the other technical means of communication for filing a European patent application. Rule 24(1), second sentence, EPC confers general power on the President of the Office to lay down conditions governing the use of the means of communication, without there having to be any connection whatsoever between such conditions.

6. *The fourth argument:*

The Board sees no way of applying the principle of proportionality as requested by the appellant given that the applicable legal provisions are clear and unambiguous and the appellant's intention was clear. There is thus no scope for a different interpretation.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset