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**Datasheet for the decision
of 12 July 2007**

Case Number: J 0007/05 - 3.1.01

Application Number: 0407598.4

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

Porcine leptin protein, nucleic acid sequences coding therefor
and uses thereof

Patentee:

PURINA MILLS, INC., et al

Opponent:

-

Headword:

Re-establishment for filing divisional application/PURINA
MILLS

Relevant legal provisions:

EPC Art. 122, 76(1), 76(3)

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

Keyword:

"Re-establishment of rights for filing a divisional
application (no)"

Decisions cited:

J 0018/04

Catchword:

-



Case Number: J 0007/05 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 12 July 2007

Appellants:

PURINA MILLS, INC.
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Decision under appeal:

Decision of the Receiving Section of the
European Patent Office of 18 November 2004.

Composition of the Board:

Chairman: B. Günzel
Members: P. Mühlens
K. Garnett

Summary of Facts and Submissions

- I. The appeal lies against the decision of the Receiving section dated 18 November 2004 by which it was decided that European patent application no. 04075985.4 would not be treated as a divisional application.

- II. The earlier European patent application no. 97934986.7 - the "parent application" - was filed on 17 July 1997 as an international application (PCT/US97/12483). The mention of the grant of a patent in respect of this application was published in the European Patent Bulletin 04/14 of 31 March 2004 (European patent no. 0 973 887).

- III. On 31 March 2004, the appellants filed by fax a divisional application to this parent application. The application was given the application no. 04075985.4. The EPO informed the appellants by "Noting of loss of rights pursuant to Rule 69(1) EPC" (EPO Form 1044) dated 21 May 2004 that the application could not be treated as a divisional application because when it was filed on 31 March 2004, the parent application was no longer pending.

- IV. By letter dated 28 May 2004, the appellants applied for a decision on the matter by the European Patent Office (Rule 69(2) EPC). They submitted that the divisional application had been filed on 30 March 2004, before the mention of the grant of the parent application, and thus when the parent application was still pending. In support of their submissions, they filed as evidence a copy of an automatic acknowledgement of the receipt of the fax ("Rapport de contrôle de transmission").

However, this copy shows 31 March 2004 as date of the fax transmission.

- V. By the impugned decision, the Receiving Section decided that application no. 04075985.4 would not be treated as a divisional application. The Receiving Section held that this application had been late filed, on 31 March 2004, as appeared both from the Office files and the "Rapport de contrôle de transmission" submitted by the appellant.
- VI. An appeal was filed by fax on 11 January 2005, followed on 18 March 2005 by a written statement setting out the grounds of appeal. The appellants now submit that the divisional application was filed late due to misunderstandings and/or errors at the representative's office. One of the secretaries had tried to fax the application, including all appendices, to the European Patent Office on 30 March 2004. She then erroneously took a paper she found in the fax machine as the document acknowledging the receipt and noted in the appropriate list that the filing had been done ("fait"). It was only one day later, on 31 March 2004, that another secretary noticed that the actual receipt indicated "error", and faxed the documents again to the European Patent Office. The appellants submit that the deadline for filing a divisional application (the parent application must be still pending: Rule 25(1) EPC) is a time limit, and thus re-establishment of rights under Art. 122 EPC would have been possible. However, the communication from the European Patent Office dated 21 May 2004 (i.e. the Notice of loss of rights pursuant to Rule 69(1) EPC) wrongly deprived them of any possibility of re-establishment, as it was

said in that communication that re-establishment in respect of the non-observed time limit was not possible. In the appellants' view, this is contrary to the EPC, because Rule 25(1) EPC is not among the provisions under which re-establishment is excluded (Art. 122(5) EPC). If it had not been forbidden by the communication, the appellants would have filed a request for re-establishment according to Art. 122(2) EPC.

VII. The Board issued a communication dated 14 March 2007 drawing the appellants' attention to the Board's case law according to which the deadline under Rule 25(1) EPC for filing a divisional application is not a time limit in the meaning of Art. 122 EPC and that this provision is consequently not applicable.

VIII. The appellants request that the decision under appeal be set aside and that the European patent application no. 04075985.4 be treated as a divisional application in respect of the earlier application no. 97934986.7.

By letter dated 20 June 2007, the appellants withdrew the request for oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2.1 According to Rule 25(1) EPC, a divisional application may be filed relating to any *pending* earlier European patent application. Where the application proceeds to grant, an application is *pending* up to (but not including) the date that the European Patent Bulletin

mentions the grant of the European Patent. In the present case, this date was 31 March 2004. Thus, a divisional application could have been filed up to 30 March 2004.

- 2.2 The Board is in no doubt that the divisional application was late filed, on 31 March 2004. This appears clearly both from the files of the Office and from the documents submitted by the appellants themselves as evidence in support of their submissions made before the Receiving Section. Moreover, in the appeal proceedings, the appellants no longer submit that the divisional application was received on 30 March 2004.

3. With respect to the appellants' submissions concerning re-establishment of rights, the Board holds that in the present case, the first condition to be satisfied under Art. 122 EPC is that the deadline under Rule 25(1) EPC must constitute a *time limit*, because Art. 122 EPC is only applicable where a "time limit" has not been observed. Only if this condition is satisfied will there arise the questions whether a request for re-establishment is still possible having regard to Art. 122 (2) EPC and whether the request is well-founded.
 - 3.1 The first question - whether the deadline to file a divisional application is a time limit - is a point of law of general interest. This Board has dealt with the problem in its decision in case J0018/04 (OJ 2006,560). After an exhaustive examination of the legal situation, taking into account previous decisions of the boards of appeal on largely the same point of law, the Board came

to the conclusion that Rule 25(1) EPC does not define a time limit for the purposes of Art. 122 EPC. Rule 25(1) EPC imposes a substantive requirement which must be fulfilled when a divisional application is filed. A Board has no power to excuse an applicant from complying with this substantive requirement. The time restriction imposed on applicants by Rule 25(1) EPC lacks the conceptual elements of a time limit, i.e. a period of time determined in years, months or days and a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted.

- 3.2 By its decision in case J 0018/04, the Board confirmed prior jurisprudence on this question. The Board sees no reason to repeat in detail the arguments leading up to the decision in J 0018/04 and it is enough to say that it sees no reason to deviate from this jurisprudence. As a consequence, re-establishment of rights is not possible in the present case.

Order

For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel