

BESCHWERDEKAMMERN  
DES EUROPÄISCHEN  
PATENTAMTS

BOARDS OF APPEAL OF  
THE EUROPEAN PATENT  
OFFICE

CHAMBRES DE RECOURS  
DE L'OFFICE EUROPEEN  
DES BREVETS

**Internal distribution code:**

- (A)  Publication in OJ
- (B)  To Chairmen and Members
- (C)  To Chairmen
- (D)  No distribution

**Anonymisation:**

- Yes
- No

**Datasheet for the decision  
of 17 May 2011**

**Case Number:** J 0019/10 - 3.1.01

**Application Number:** ...

**Publication Number:** -

**IPC:** -

**Language of the proceedings:** EN

**Title of invention:**

-

**Applicant:**

N.N.

**Opponent:**

-

**Headword:**

Divisional application/N.N.

**Relevant legal provisions:**

EPC Art. 121(1), 122

EPC R. 36(1), 134(2)

RPBA Art. 15(3)

**Relevant legal provisions (EPC 1973):**

EPC Art. 87(1), 122(5)

EPC R. 25(1), 85(2)

**Keyword:**

"Pending earlier application"

"General dislocation in the delivery of mail-extension of time limits/periods"

"Principle of protection of legitimate expectations, professional representative - violation (no)"

"Application to be treated as divisional application (no)"

**Decisions cited:**

G 0002/97, G 0001/09, J 0010/01, J 0005/02, J 0024/03,

J 0018/04, J 0007/05, J 0002/08, T 0267/08

**Catchword:**

-



Case Number: J 0019/10 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 17 May 2011

**Appellant:** N.N.

**Representative:** N.N.

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 27 April 2010.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** C.-P. Brandt  
C. Vallet

## Summary of Facts and Submissions

- I. The present appeal lies from the decision of the Receiving Section dated 27 April 2010 rejecting, with respect to European patent application XXXXXXXXX, the request of the applicant pursuant to Rule 112(2) EPC dated 2 June 2008 to set aside the noting of loss of rights (EPO Form 1044) of 24 April 2008. The Receiving Section also rejected the auxiliary request for further processing under Article 121(1) EPC as inadmissible. The decision further stated that European patent application XXXXXXXXX (hereinafter: first divisional application), filed on 2 April 2008 as a divisional application of earlier European patent application YYYYYYYY, would not be treated as a divisional application. Lastly, the Receiving Section also rejected the request that divisional application OOOOOOOO ((hereinafter: second divisional application, underlying appeal case J 26/10), filed on 2 May 2008 as a divisional application of the first divisional application XXXXXXXXX, be allowed to proceed.
- II. The mention of grant in respect of earlier European patent application YYYYYYYY was published on 2 April 2008.
- III. With letter dated 14 April 2008 the applicant contended that a postal strike had taken place in the Munich area at least on 1 April 2008; he therefore assumed that the first divisional application had been filed in due time.
- IV. On 24 April 2008 the applicant was informed by the Receiving Section (Noting of loss of rights pursuant to Rule 112(1) EPC) that European patent application

XXXXXXXXX was not being processed as a European divisional application (Rule 36(1) EPC) because, when it was filed, the European Patent Bulletin had already mentioned the grant of a patent in respect of earlier European patent application YYYYYYYY.

- V. With letter of 2 June 2008 the applicant requested an appealable decision pursuant to Rule 112(2) EPC. He submitted that the finding of loss of rights was inaccurate because in view of the postal strike at least on 1 April 2008 in the area of Munich the first divisional application (XXXXXXXXX) had been filed in time and therefore should be treated as a divisional application. If the postal strike did not result in the first divisional being regarded by the EPO as having been filed in time as an auxiliary request he asked for further processing in relation to the filing of the first divisional.
- VI. By communication pursuant to Article 113 EPC dated 25 September 2008 the Receiving Section informed the applicant that the alleged postal strike could not have any relevance in the present context, because Rule 134(2) EPC clearly applied to periods (time limits) only and thus was not applicable. According to the case law of the Boards of Appeal Rule 36(1) EPC did not set a time limit but a condition for the filing of a divisional application, namely the pendency of the earlier European patent application (see e.g. J 24/03, OJ EPO 2004, 544, point 4 of the reasons). The present European patent application could therefore not be processed as a divisional application. The auxiliary request for further processing also referred to the

failure to observe a time limit. Consequently, further processing was not available either.

VII. In reply with letter dated 4 December 2008 the applicant maintained all requests and arguments previously made. J 24/03 was not applicable to the present case, because former Rule 85(2) EPC 1973 referred to a "time limit", whereas new Rule 134(2) EPC referred to a "period". The applicant further submitted that Rule 134(2) EPC was more generally applicable than Article 122 EPC. He concluded this from the fact that Article 122 EPC 1973 was not applicable to priority-claiming applications, whereas Rule 85(2) EPC 1973 (Rule 134(2) EPC) was.

VIII. The Receiving Section issued a decision on 27 April 2010 rejecting all the applicant's requests.

IX. By letter dated 7 July 2010, received by the EPO on the same day, the applicant filed a notice of appeal against the decision of the Receiving Section and paid two appeal fees. The statement setting out the grounds of appeal dated 27 August 2010 was received on 7 September 2010.

The appellant maintained all arguments previously made in this matter. Furthermore, he argued that the wording "The time limit for filing divisional applications must be observed" used in the examination report dated 19 July 2006 on earlier European patent application YYYYYYYY would lead a reasonable addressee to conclude that there was a time period in which divisional applications could be filed and hence, that this period could be extended, e.g. in the case of a postal strike.

By not allowing him an extension, the decision under appeal had violated the principle of protection of legitimate expectations.

X. With communication of the board dated 17 February 2011 the appellant was summoned to oral proceedings on 17 May 2011. In an annex to the summons the board set out its preliminary opinion that the different arguments submitted by the appellant failed to convince the Board that the decision under appeal in appeal case J 19/10 was mistaken and had to be set aside.

XI. The appellant did not reply to this communication. Neither the appellant nor his professional representative attended the oral proceedings held on 17 May 2011, as announced with faxed letter dated 16 May 2011.

XII. In his notice of appeal the appellant requested that:

the noting of loss of rights of 24 April 2008 be set aside;

the auxiliary request of further processing be accepted;

European patent application XXXXXXXXX be treated as a divisional application;

second European patent application 00000000 be allowed to proceed, and therefore that the decision of 27 April 2010 be overturned.

Furthermore, in his faxed letter dated 16 May 2011 concerning both divisional applications XXXXXXXXX and 00000000 the appellant requested "a refund of all refundable fees".

## Reasons for the Decision

### 1. *Applicable provisions*

The board agrees with the appellant and the Receiving Section that the provisions of EPC 2000 and its Implementing Regulations apply. In this respect the board refers to Article 7(1), first sentence, and Article 8 of the Revision Act of 29 November 2000 (OJ EPO 2001, Special Edition No. 4, 50) and Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the EPC 2000 (OJ EPO 2007, Special Edition No. 1, 89).

### 2. The appeal is admissible.

2.1 In the decision under appeal, both divisional applications XXXXXXXX and 00000000 are explicitly listed under "Application No./Patent No." and in the order of the "decision" under points 1 to 3 and 4 respectively. Thus the decision under appeal is clearly directed to both patent applications and as a consequence took effect for both European grant proceedings. Hence, although contained in one document, there were two decisions in the legal sense.

2.2 It follows that in order to avoid these decisions becoming final an appeal had to be filed with effect for each of the applications concerned. A notice of appeal and a statement setting out the grounds of appeal were each filed by a single letter but each referred to both the first divisional application



XXXXXXXX and the second divisional application 00000000. Furthermore, two appeal fees were paid. Hence, there are two valid appeals in the legal sense.

2.3 The board notes that the procedure followed by the Receiving Section, namely dealing with two different divisional applications in single proceedings and in a single final decision, does not comply with the requirement for office actions to be clear, comprehensible and legally correct. Even in a case like the present one in which the fate of an application depends on the outcome of another application, both applications are nevertheless legally separate applications. Therefore, the termination of any of these proceedings requires a decision taken in the respective application concerned. The way of proceeding chosen by the Receiving Section entails the risk of misunderstandings and procedural complications, which may lead to a loss of rights to the detriment of the applicant.

3. The appellant was duly summoned, but did not attend the oral proceedings. According to Article 15(3) RPBA the board is not obliged to delay any step in the proceedings, including its decision, by reason only of the absence at the oral proceedings of any party duly summoned who may then be treated as relying only on its written case. In the present case, the board was in a position to take a decision at the end of the hearing.

*Subject-matter of the appeal*

The subject-matter of the present appeal is the request to set aside the noting of loss of rights in respect of

European patent application XXXXXXXXX (Main request), the request for further processing in respect of European patent application XXXXXXXXX (Auxiliary request) and the request that European patent application XXXXXXXXX be treated as a divisional application of earlier European patent application YYYYYYYY.

*Main request*

4. The request that the noting of loss of rights be set aside is allowable if the decision of the Receiving Section of 24 April 2008 that European patent application XXXXXXXXX would not be processed as a European divisional application of European patent application YYYYYYYY was incorrect. However, that is not the case.
  
5. According to Rule 36(1) EPC, a divisional application may be filed relating to any pending earlier European patent application. Where the earlier application proceeds to grant, an application is pending up to but not including the date of publication of the mention of grant in the European Patent Bulletin (notice dated 9 January 2002, OJ EPO 2002, 112; J 24/03, OJ EPO 2004, 544, point 4 of the reasons; J 7/05 of 30 July 2002, point 2.1 of the reasons; G 1/09, OJ EPO 2011, 336). Therefore, the parent application YYYYYYYY was no longer "pending" pursuant to Rule 36(1) EPC when European patent application XXXXXXXXX was filed as a divisional application on 2 April 2008. This fact is not disputed by the appellant.

6. However, the applicant contended that a postal strike took place in the Munich area at least on 1 April 2008 and consequently assumed that patent application XXXXXXXXX should be deemed to have been filed in due time according to Rule 134(2) EPC and could be treated as divisional application. Rule 134(2) EPC reads as follows: "If a **period** expires on a day on which there is a general dislocation in the delivery or transmission of mail ..., the **period** shall extend to the first day following the first day of the interval of dislocation ..." (emphasis added). Therefore Rule 134(2) EPC is applicable only if the wording "... to any pending earlier European patent application ..." pursuant to Rule 36(1) EPC imposes a **period**, i.e. a **time limit** (emphasis added).
  
7. In several earlier decisions, the boards of appeal have ruled that the wording "... to any pending earlier European patent application..." in Rule 36(1) EPC does not set a period/time limit, but rather sets a condition; see e.g. J 10/01 of 15 October 2002 (points 15 to 20 of the reasons), J 24/03 (OJ EPO 2004, 544, point 4 of the reasons, ), J 18/04 (OJ EPO 2006, 560, point 2.1 of the reasons, ), J 7/05 of 30 July 2002 (point 3 of the reasons) and G 1/09 (OJ EPO 2011, 336, point 3.2.4 of the reasons). In view of this established case law, particularly the very thorough and detailed reasoning in J 18/04, the board sees no reason to take a different approach in the present case. Nor is it convinced by the arguments brought forward by the appellant.
  
- 7.1 The argument of the appellant that J 24/03 was not applicable to the present case, because former

Rule 85(2) EPC 1973 referred to a "time limit" whereas new Rule 134(2) EPC referred to a "period" is legally not sustainable in the light of the documents underlying the introduction of the EPC 2000. Special edition No. 5 OJ EPO 2007, 200, under "Rule 134 EPC" refers the reader to "Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1". In "Chapter V - Rule 85 EPC 1973" (corresponding to Rule 134(2) EPC) of these "Explanatory remarks" it is noted that "Amendments are purely editorial". Therefore, no legal consequences can be inferred from the replacement of "time limit" in Rule 85(2) EPC 1973 by "period" in Rule 134(2) EPC. In this regard reference is also made to J 18/04 (point 21 of the reasons) where the board found that in Rule 83 EPC 1973 ("Calculation of *time limits*") the term *period* was the only logical substitute for the term *time limit* throughout the wording of the rule.

- 7.2 Furthermore, the appellant contends that Rule 134(2) EPC is more generally applicable than Article 122 EPC. He concludes this from the fact that Article 122 EPC 1973 was not applicable to applications claiming priority, whereas Rule 85(2) EPC 1973 was applicable in such cases. This may be so, but it results from the fact that Article 122 EPC and Rule 134(2) EPC have differently worded requirements. Aside from that, Article 122 EPC 1973 was not applicable to applications claiming priority (period of twelve months), because re-establishment into the time limit referred to in Article 87(1) EPC 1973 was explicitly excluded in Article 122(5) EPC 1973, whereas Rule 85(2) EPC 1973 did not comprise such an exclusion. By contrast, the EPC - including Article 122 and Rule 134(2) - draws no distinction with regard to the concept of "time limit".

In the absence of any indications to the contrary, if a term has the same wording it must be assumed to have the same meaning.

8. Finally, the appellant argues that an extension of the "period for filing a divisional application" has to be allowed due to the principle of protection of legitimate expectations. He infers this from the fact that in non-unity communications from the EPO, e.g. in the examination report dated 19 July 2006 concerning earlier European patent application YYYYYYYY, the standard wording "The time limit for filing divisional applications (Rule 25(1) EPC 1973) must be observed" is used.

8.1 According to the case law of the boards of appeal, the principle of protection of legitimate expectations governing the procedure between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous, i.e. drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee (G 2/97, OJ EPO 1999, 123). The board is not satisfied that the appellant can rely on the principle of protection of legitimate expectations, even if it is assumed in the appellant's favour that the examination report of 19 July 2006 contained misleading information in mentioning a *time limit* to be observed pursuant to Rule 25(1) EPC 1973. At least three of the above-mentioned decisions (see point 7) finding that Rule 25(1) EPC 1973 (Rule 36(1) EPC) does not set a time limit but a condition, namely J 10/01, J 24/03 and J 18/04, were issued well before the notification of the examination report dated 19 July 2006. Here the board would refer in particular to

J 24/03 and J 18/04, which were published in the Official Journal of the EPO and substantiated that finding in considerable detail.

8.2 In view of this jurisprudence of the Legal Board of Appeal, the appellant's professional representative could not simply rely on the legal accuracy of the wording of the information in the examination report of 19 July 2006. The relevant information was obviously intended only to remind the applicant, as a courtesy service, of the need to file a divisional application in respect of that part of the invention which was held to lack unity. This assessment is also supported by the wording of the respective passage of the communication of 19 July 2006 (point 4, first sentence), informing the applicant that "The subject-matter to be excised may be made the subject of one or more divisional applications" and thus just provided as a recommendation or hint as to how to overcome the non-unity objection raised by the examining division. Unreserved reliance on the correctness of the said information is all the more unjustified since the professional representative must or should have known that EPO examiners do not normally handle procedural issues such as valid filing dates, which are generally dealt with by the Receiving Section.

8.3 In the present case the professional representative could be expected to be familiar with procedural matters in general, and the boards' detailed and consistent jurisprudence in particular (see J 5/02 of 30 July 2002, point 3.2 of the reasons); T 267/08 of 29 November 2010, point 5.2.1 of the reasons). He has also to be aware that any questions relating to the

filing date should be clarified with the Receiving Section (see J 2/08, point 55 of the reasons, OJ EPO 2010, 100). Taking all these circumstances into account it cannot be assumed that a reasonable addressee would and could justifiably conclude that there is a time period in which divisional applications can be filed and that such a period can be extended in the case of a general dislocation of mail services within the meaning of Rule 134(2) EPC.

9. Since for the reasons stated above Rule 36(1) EPC does not set a "period/time limit" and the principle of protection of legitimate expectations does not apply, Rule 134(2) EPC (requiring a "period") is not applicable. Thus the question whether there was a "general dislocation in the delivery or transmission of mail" within the meaning of Rule 134(2) EPC can be left undecided. Hence, the main request that the noting of loss of rights be set aside cannot be allowed.

*Auxiliary request*

10. As an auxiliary request the appellant seeks further processing of European patent application XXXXXXXXX as a divisional application from earlier European patent application YYYYYYYY pursuant to Article 121 EPC. However, Article 121(1) EPC also requires that "... an applicant fails to observe a **time limit** ..." (emphasis added). Since, as has been stated above, the EPC draws no distinction with regard to the concept of "time limit" and in the absence of any indications to the contrary, this term must be assumed to have the same meaning in Article 121(1) EPC as in Rule 134(2) EPC. Due to the fact that Rule 36(1) EPC does not set a

"period/time limit" Article 121(1) EPC is not applicable to this case either. Consequently, the auxiliary request too must fail for this reason alone.

11. Since both the main request and the auxiliary request are rejected, European patent application XXXXXXXX cannot be treated as a divisional application.

*Request for refund of fees*

12. The board considers that the request for "a refund of all refundable fees" submitted with the faxed letter dated 16 May 2011 fails to make clear either its scope and its content and is not admissible. Thus, this request cannot be dealt with and has to be disregarded. In the absence of any substantiated request by the appellant it is not up to the board to identify which fees in the first-instance and appeal proceedings might be refundable. Since the request is clearly and explicitly directed to "*refundable*" fees, it a priori does not encompass a possible reimbursement of the appeal fee, because in the present case the appeal fee is obviously "*not refundable*" pursuant to Rule 103(1)(a) EPC.



**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

P. Cremona

B. Günzel