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

Case Number: J 0026/10 - 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 disclocation 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:

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Case Number: J 0026/10 - 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 insofar as it rejected the request that the subject of the present appeal, European patent application 00000000 (hereinafter: second divisional application), filed on 2 May 2008 as a divisional application of European patent application XXXXXXXX, be allowed to proceed. European patent application XXXXXXXX (hereinafter: first divisional application) was filed on 2 April 2008 as a divisional application of earlier European patent application YYYYYYYY.

An appeal was also filed against the decision of the Receiving Section dated 27 April 2010 rejecting, with respect to the first divisional application XXXXXXXX the request of the applicant pursuant to Rule 112(2) EPC to set aside the noting of loss of rights of 24 April 2008, and also the auxiliary request for further processing under Article 121(1) EPC as inadmissible (appeal case J 19/10). The decision further stated that the first divisional application XXXXXXXX would not be treated as a divisional application.

II. The mention of grant in respect of earlier European patent application YYYYYYYY was published on 2 April 2008. On the same day European patent application XXXXXXXX was filed as a (first) divisional application of earlier European patent application YYYYYYYY. On 2 May 2008 the application underlying the present appeal, i.e. European patent application 00000000, was filed as

a (second) divisional application to the first divisional application XXXXXXXX.

- III. In respect of the first divisional application the Receiving Section informed the applicant on 24 April 2008 (Noting of loss of rights pursuant to Rule 112(1) EPC) that this application was not being processed as a 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.
- IV. With letter of 2 June 2008 the applicant submitted with regard to the first divisional application 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 XXXXXXXX had been filed in due time and therefore should be treated as a divisional application.
- V. With decision dated 27 April 2010 the Receiving Section rejected all the applicant's requests regarding the first divisional application and the second divisional application (see I. above). In respect of the first divisional application the Receiving Section held that the alleged postal strike could not have any legal relevance.
- VI. By letter dated 7 July 2010, received on the same day, in respect of both the first divisional application (underlying appeal case J 19/10) and the second divisional application (underlying the present appeal) 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 with regard to both divisional applications was received on 7 September 2010.

In respect of the first divisional application underlying appeal case J 19/10 the appellant contended that this application had to be regarded as being filed in time. For further details of the applicant's submissions insofar it is referred to the decision of the board of 17 May 2011 in appeal case J 19/10.

VII. In the oral proceedings held on 17 May 2011 the appeal in appeal case J 19/10 was dismissed.

VIII. In the present appeal case the appellant requested that the second divisional 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 XXXXXXXX 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 divisional 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 - Main request

4. The (second) divisional application 00000000 underlying the present appeal was filed on 2 May 2008 as a divisional application with regard to the first divisional application XXXXXXXX, underlying appeal case J 19/10. The subject of the present appeal is the request that the second divisional application 00000000 be allowed to proceed.
5. For the second divisional application 00000000 to be allowed to proceed as a divisional application with regard to the first divisional application XXXXXXXX it

would be required that the first divisional application XXXXXXXXX could be treated as a divisional application of earlier European patent application YYYYYYYY. However, the present board held in its decision J 19/10 of 17 May 2011 concerning the first divisional application that European patent application XXXXXXXXX cannot be treated as a divisional application of earlier European patent application YYYYYYYY. With regard to the present decision the board refers to the reasons set out in its decision of 17 May 2011 in appeal case J 19/10.

6. Since the appellant based his alleged entitlement to the second divisional application, European patent application 00000000, being allowed to proceed as a divisional application exclusively on the fact that European patent application XXXXXXXXX was pending as a divisional application of earlier European patent application YYYYYYYY when European patent application 00000000 was filed as a divisional application to the first divisional application XXXXXXXXX, European patent application 00000000 too cannot be treated as divisional application.

Request for refund of fees

7. 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