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shortened version

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J 13/85

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Bezeichnung der Erfindung:

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du

25 August 1986

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence :

Divisional application - whether filing
justified

EPÜ / EPC / CBE

Article 76(1)

Rules 25(1)(a), 51(4), 51(5)

Leitsatz / Headnote / Sommaire

- I. There cannot be more than one effective Communication pursuant to Rule 51(4) and (5) EPC. If a second Communication is sent, this can only be because the first is deemed not to have been sent pursuant to Rule 51(4) EPC, last sentence.
- II. The question whether the subject-matter of a European divisional application extends beyond the content of the parent application (Article 76(1) EPC) has to be decided in the examination procedure by the Examining Division.

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 13 /85

D E C I S I O N
of the Legal Board of Appeal
of 25 August 1986

Appellant :

Representative :

Decision under appeal : Decision of the Receiving Section dated
3 January 1985 refusing the request to allocate
to a divisional application the date of filing
and the priority of the parent application.

Composition of the Board :

Chairman : P. Ford

Member : F. Benussi

Member : R. Schulte

Summary of Facts and Submissions

- I. European patent application No. (hereinafter referred to as "the parent application") was filed on 20 February 1979 claiming priority from a national application filed in the United States of America on 14 August 1978.
- II. On 1 December 1980 the Examining Division sent to the Appellant a Communication inviting him to correct some deficiencies in the parent application and giving him a period of four months to do so.
- III. By the Communication pursuant to Rule 51(4) and (5) EPC dated 22 July 1982 the Examining Division informed the Appellant of the text in which it intended to grant a European patent on the parent application. In accordance with normal practice, the Appellant was given a period of three months to pay the fees for grant and printing and to file a translation of the claims.
- IV. On 22 October 1982, the Appellant requested by telex, duly confirmed on 25 October 1982, permission to add new claims (10 - 16) to the parent application.

After consultation by telephone, on 12 January 1983, at the Examining Division's invitation, the Appellant withdrew the newly added claims. This was confirmed by letter dated 17 January 1983. In this letter, the Appellant also proposed minor clarifying amendments which he desired to make in the text proposed for grant.

- V. After further consultation by telephone with the Examining Division (on 2 and 4 March 1983), the Appellant agreed to amend Claim 1 by telex dated 31 March 1983, confirmed by letter dated 11 April 1983.

- VI. On 24 June 1983 by a new Communication pursuant to Rule 51(4) and (5) EPC, the European Patent Office informed the Appellant of the text in which the Examining Division intended to grant the European patent.
- VII. On 23 November 1983 the European patent was granted.
- VIII. On 12 January 1983 the Appellant had filed the divisional application, which is the subject of the present proceedings, for a method of manufacturing the product which was the subject of the parent application. The claims of the divisional application correspond to those which had earlier been submitted as additional claims to the parent application.
- IX. By a Communication of 7 February 1984, pursuant to Rule 69(1) EPC, the Receiving Section stated that since the divisional application had been filed after the period prescribed by the Examining Division in the first Communication, under Rule 25(1)(a) EPC, the Appellant would have needed the Examining Division's consent to the filing of a divisional application. Furthermore, the Receiving Section noted that the subject-matter of the claims of the divisional application would have extended beyond the subject-matter of the parent application (Article 76(1) EPC).
- X. On 16 April 1984 the Appellant applied for a decision against this finding under Rule 69(2) EPC.

On 3 January 1985, by the decision under appeal, the Receiving Section confirmed its opinion that the divisional application could not have the benefit of the date of priority of the parent application.

XI. It considered that according to Rule 25(1)(a) EPC the Appellant should have sought the Examining Division's approval either before or after filing a divisional application. Furthermore, consent could not have been given as the filing took place too late in the grant procedure on the parent application, i.e. when a Communication under Rule 51(4) EPC had already been sent out.

The Receiving Section, after consulting only the first examiner, stated that it considered that the filing was too late and that the claims of the divisional application would extend beyond the subject-matter of the parent application. The Receiving Section felt moreover that the Appellant was incorrect in assuming that the Examining Division did reopen the substantive examination.

XII. By letter dated 1 March 1985, the Appellant filed an appeal against the decision of the Receiving Section dated 3 January 1985. The appeal was duly paid.

XIII. In the Statement of Grounds filed on 7 May 1985 in support of this appeal, the Appellant contended inter alia that the first communication under Rule 51(4) EPC was set aside by the Examining Division; that the examination was reopened; that the claims of the parent application were changed and that the second communication under Rule 51(4) was issued long after the date of filing of the divisional application.

Reasons for the Decision

1. The appeal complies with the Articles 106 to 109 and Rule 64 EPC and is therefore admissible.

2. Rule 25(1)(a) EPC provides that a European divisional application may be filed after receipt of the first Communication from the Examining Division only within the period prescribed by the communication or after that period if the Examining Division considers the filing of a divisional application to be justified.
3. In the present case, it is not in dispute that the divisional application of 12 January 1983 was filed long after expiry of the period of four months prescribed in the Communication pursuant to Article 96(2) EPC dated 1 December 1980 and that accordingly the consent of the Examining Division to the filing of a divisional application was necessary.
4. The Guidelines for Examination in the EPO (Part A-IV 1.3) indicate that the Examining Division should normally consider the filing of a divisional application justified unless the Communication under Rule 51(4) and (5) EPC has already been sent out, provided that the application is confined to subject-matter contained in the parent application and that nevertheless it claims a different invention.
5. In the Statement of Grounds, the Appellant has rightly submitted that in the present case two Communications pursuant to Rule 51(4) EPC were issued and observed that the divisional application (12 January 1983) was filed after the first communication (22 July 1982) but earlier than the second one (24 June 1983), which has to be regarded as the only effective one, by virtue of Rule 51(4) EPC, last sentence.

6. There cannot be more than one effective Communication pursuant to Rule 51(4) and (5) EPC. If a second Communication is sent, this can only be because the first is deemed not to have been sent, pursuant to Rule 51(4) EPC, last sentence. In the present case, the effective Communication pursuant to Rule 51(4) and (5) EPC was subsequent to the filing date of the divisional application.

The first examiner and the Receiving Section were therefore wrong to consider that the filing of the divisional application took place too late in the proceedings on the parent application.

7. The question whether the subject-matter of the European divisional application extends beyond the content of the parent application (Article 76(1) EPC) has to be decided in the examination procedure by the Examining Division and cannot be decided by the Receiving Section or by a single member of the Examining Division acting alone, in any circumstances.

Therefore the Guidelines (A IV 1.3.3) state that the Receiving Section has to invite the applicant for a divisional application to show the approval of the Examining Division under Rule 25(1)(a) EPC. In that case the applicant has to address himself to the Examining Division competent in respect of the parent application and apply for such an approval. In the present case, the Examining Division has not given a decision refusing approval to file a divisional application. If approval is refused, the decision is open to direct appeal to a Technical Board of Appeal (Article 21(3) EPC).

8. Since the refusal of the divisional application without a preceding decision of the Examining Division under Rule 25(1)(a) EPC is a substantial procedural violation within the meaning of Rule 67 EPC the Board considers that reimbursement of the appeal fee is equitable.

ORDER

For these reasons,

it is decided that:

1. The decision of the Receiving Section dated 3 January 1985 is set aside.
2. The case is remitted to the Receiving Section for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar

B. A. Norman

B. A. Norman

*Sebastian
Frankenberg*

The Chairman

P. Ford

P. Ford