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Aktenzeichen / Case Number / N^o du recours : J 15/85

Anmeldenummer / Filing No / N^o de la demande :

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Bezeichnung der Erfindung :

Title of invention :

Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du 10 July 1986

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /

Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Abandonment of claim

EPO / EPC / CBE Rule 25(1)(a)

Abandonment of claim - Divisional application:
refusal of consent

Leitsatz / Headnote / Sommaire

If an applicant cancels claims included in a European patent application but fails to state at the same time that their deletion is without prejudice to the filing of a divisional application, the Examining Division will be obliged to refuse its consent to the subsequent filing of a divisional application

**Europäisches
Patentamt**

Beschwerdekammern

**European Patent
Office**

Boards of Appeal

**Office européen
des brevets**

Chambres de recours



Case Number : J 15 /85

**DECISION
of the Legal Board of Appeal
of 10 July 1986**

Appellant :

Representative :

Decision under appeal : of the Receiving Section dated 25 January 1985
refusing to allow European patent application
No. to proceed as a divisional
application.

Composition of the Board :

**Chairman : P. Ford
Member : F. Benussi
Member : R. Schulte**

Summary of facts and submissions

- I European patent application No. was filed in the name of X on 24 August 1979, claiming priority from two national applications filed in the United States of America on 28 August 1978 and on 18 April 1979. The application was published on 5 March 1980.

- II On 15 June 1981 X assigned among other applications, European patent application No..... to the present Appellant.

- III By a communication dated 14 October 1981, the Examining Division informed the Appellant that the European patent application did not meet the requirements of the European Patent Convention as each of the 16 claims lacked either novelty or inventive step.

- IV In a letter dated 1 February 1982, sent in response to this communication, the Appellant's representative submitted a new set of Claims 1-9 to replace all the previously presented claims.

- V In a second communication dated 17 June 1982, the Examining Division stated that Claim 1, after amendments to the wording, could be allowable.

- VI With a letter dated 30 September 1982 the Appellant's representative submitted a set of four claims corresponding to the previous Claims 1-4 except that Claim 1 has been amended as suggested by the Examining Division in the communication dated 17 June 1982. By the same letter, the Appellant's representative cancelled the remaining claims.

- VII Advance notice of the communication pursuant to Rule 51(4) and (5) EPC, in which the text proposed for the European patent application was set out, was sent to the Appellant's representative on 28 June 1983.
- VIII On 19 September 1983, by a communication pursuant to Rule 51(4) and (5) EPC, the Examining Division informed the Appellant's representative that it was intended to grant a European patent on the basis of the amended text of the patent application.
- IX By letter dated 10 November 1983, the Appellant's representative informed the Examining Division that the Appellant considered that a much broader protection than that provided by the claims mentioned in the communication pursuant to Rule 51(4) and (5) EPC should be allowed, namely protection for the composition used in the Appellant's process and that that could be secured by the filing of a divisional application.
- X On 14 November 1983, the Appellant filed a divisional application in respect of the composition, stating in a letter attached to the divisional application that the necessity for filing a divisional application had not become apparent until the communication under Rule 51(4) EPC had been received.
- XI By decision of 15 March 1984, a European patent was granted on application No..... on the basis of the documents referred to in the communication under Rule 51(4) EPC. No appeal was filed against this decision.
- XII By communication dated 27 March 1984, pursuant to Rule 69(1) EPC, the Receiving Section stated that, pursuant to Rule 25(1)(a) EPC, as the divisional application had been filed after the period prescribed by the Examining

Division in the first communication, the filing of the divisional application should have been approved by the Examining Division responsible for the examination of the parent application. The Examining Division refused its approval because the filing of the divisional application took place too late in the granting procedure of the parent application.

XIII By letter received on 25 May 1984, the Appellant applied for a decision against this finding under Rule 69(2) EPC.

XIV By the decision under appeal, dated 25 January 1985, the Receiving Section held that the divisional application could not be dealt with as a divisional application because the Examining Division responsible refused to approve the filing of a divisional application.

XV By letter dated 19 March 1985, the Appellant's representative filed a notice of appeal, requesting cancellation of the decision of the Receiving Section dated 25 January 1985. The appeal fee was duly paid.

XVI In the Statement of Grounds of the appeal, dated 24 May 1985, the Appellant's representative submitted that:

- (1) The precise nature of the invention was appreciated after the time for proposing amendments in response to the Advance Notice in the parent application but before the decision to grant the original application.

- (2) the allowance of this application as a divisional application would not prejudice any third party because the claim requested was clearly foreshadowed in the original application as filed and published: that excluded any question of introducing protection for matter not originally disclosed.
- (3) the invention made a significant technological advance in the art: that should have been an additional reason to consider the filing of a divisional application to be justified.

XVII In a letter to the Board of Appeal dated 14 February 1986, the Appellant's representative drew attention to a favourable decision on another application given in circumstances which he alleged were similar.

XVIII In a communication of the Legal Board of Appeal dated 15 May 1986, sent to the Appellant's representative with a summons to oral proceedings, it was indicated that in the present case two matters were of special significance, i.e. the abandonment of Claims 5-9 in the parent application by the representative's letter dated 30 September 1982, responding to the Examining Division's second communication dated 17 June 1982; and the fact that the divisional application was not filed until after the communication under Rule 51(4) EPC had been sent out.

XIX At the oral proceedings held on 10 July 1986, the Appellant's representative confirmed the Appellant's main and auxiliary requests.

He argued that the Appellant had never abandoned the subject-matter of Claim 8, since the relevant description was still contained in the parent application. He further submitted that the public interest would not be adversely

affected by the filing of the divisional application, because the public could not perform the subject-matter of the parent application without using the subject-matter of the divisional application and the divisional application concerned only a composition for use in the process of the parent application.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. In proceedings before it, a Board of Appeal is obliged, in conformity with Article 114(1) EPC, to examine the facts of its own motion without restriction to the facts, evidence and arguments provided by the parties and the relief sought. In the present case, the Board has taken the point, of its own motion, that the Appellant abandoned the relevant subject-matter of the claims of the parent application.
3. By letter of 30 September 1982, after receiving the Communication of the Examining Division pursuant to Article 96(2) and Rule 51(2) EPC, dated 17 June 1982, the Appellant amended the parent application, introducing new claims corresponding to the previous Claims 1-4, and declaring that the remaining claims should be cancelled.

When cancelling the remaining claims, the Appellant did not state that their deletion should be without prejudice to the filing of a divisional application. Even though the description of the patent application still contained information relating to the compositions which had been the subject-matter of the cancelled claims, it was therefore

clear that the Appellant no longer sought protection for the compositions per se. Article 84 EPC expressly states that the claims shall define the matter for which protection is sought.

4. At the date of abandonment of claims to the compositions per se, the parent application had been published so that the public had access to the file. The public was thus immediately entitled to assume that, since there was no reference to filing of a divisional application, the Appellant had irrevocably abandoned and would not thereafter seek to obtain protection for the compositions per se. It was pointed out to the Appellant's representative by the Board during the oral proceedings that a third party would be free to manufacture the compositions per se within the designated states and sell them for use elsewhere.
5. It follows that the Examining Division would have been obliged to refuse its consent to the filing of a divisional application at any time after the abandonment. In these circumstances it is not necessary to consider whether the Examining Division was justified in refusing its consent on the ground that the divisional application was not filed until after the communication under Rule 51(4) EPC had been sent out in the parent case. However, nothing in the present decision should be understood as casting doubt upon the principle on which the Examining Division refused consent.
6. The Board has been unable to find any basis on which the present appeal could be allowed.

ORDER

For these reasons,

it is decided that:

the appeal against the Decision of the Receiving Section dated 25 January 1985 is dismissed.

The Registrar

The Chairman