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Aktenzeichen / Case Number / N^o du recours : J 1/90

Anmeldenummer / Filing No / N^o de la demande : 88 117 008.8

Veröffentlichungs-Nr. / Publication No / N^o de la publication :

Bezeichnung der Erfindung: Fluoropolymer compositions

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement :

ENTSCHEIDUNG / DECISION

vom / of / du 16 August 1990

Anmelder / Applicant / Demandeur : Chemical Fabrics Corp.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Time limit for divisional application/CHEMICAL
FABRICS

EPÜ / EPC / CBE Rules 25(1), 51(4) EPC

Schlagwort / Keyword / Mot clé : "Approval" ambiguos - filing of divisional
application allowed.

Leitsatz / Headnote / Sommaire

Europäisches
Patentamt

Beschwerdekammern

European Patent
Office

Boards of Appeal

Office européen
des brevets

Chambres de recours



Case Number : J 1/90

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D E C I S I O N
of the Technical Board of Appeal
of 16 August 1990

Appellant : Chemical Fabrics Corp.
New Hampshire
(USA)

Representative : Portal, Gérard
Cabinet Beau de Loménie
55, rue d'Amsterdam
F-75008 Paris

Decision under appeal : Decision of the Receiving Section
of the European Patent Office
dated 17 August 1989.

Composition of the Board :

Chairman : O. Bossung
Members : M. Lewenton
J. Stephens-Ofner

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Summary of Facts and Submissions

- I. In the proceedings in respect of European patent application No. 85 400 719.2 (parent application) filed on 11 April 1985, the Examining Division of the European Patent Office issued a communication under Rule 51(4) EPC on 8 June 1988. By letter of 5 August 1988, the Appellant filed a separate set of claims for Austria, asking for acceptance of this amendment.
- II. On 20 September 1988 a communication under Rule 51(6) EPC was sent to the Appellant, notifying him that the Examining Division had accepted the set of claims for Austria.
- III. In a letter of 12 October 1988, received by the European Patent Office on 13 October 1988, the Appellant declared his approval of the text in which the Examining Division intended to grant the patent, and, at the same time, filed a divisional application according to Rule 25(1) EPC. Pursuant to Rule 69(1) EPC, the Appellant was informed that the new application could not be treated as divisional application since it was filed after he had given his approval of the parent application. The Appellant considered this finding inaccurate and requested a decision according to Rule 69(2) EPC.
- IV. By decision of 17 August 1989, the Receiving Section of the EPO held that the filing of application No. 88 117 008.8 as divisional application of the parent application No. 85 400 719.2 was not allowed. The reasons given were that by the communication under Rule 51(4) EPC, the Appellant was informed of the text in which the patent would be granted. If he then filed amendments in response to this communication, it was logical for the Examining

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Division to assume that the originally submitted text was approved by him, otherwise, there would have been no point in his filing such amendments. This interpretation was confirmed by Notice of the Vice-President of Directorate-General 2 of the European Patent Office, dated 20 September 1988, which, contrary to the Appellant's opinion, was applicable to the present case. A further relevant circumstance was that EPO Form 2005.1.12.87 contains two little boxes, one referring to "your approval of the text to be used as the basis for grant has been duly received" and the other to "the Examining Division has accepted your proposed amendments, received on ..." and that in the communication of 20 September 1988 to the Appellant only the latter one was ticked. The non-ticking of the first box, however, could not be accepted as proof that the Appellant did not approve the text of the patent to be granted.

- V. The Appellant filed an appeal against that decision on 12 October 1989. In his Statement of Grounds, received on 15 December 1989, he argued essentially that the time limit for filing a divisional application was not clear at the time when he filed his application. This lack of clarity was confirmed by the Form of the former communication under Rule 51(6) EPC, itself comprising two distinct boxes to be marked separately by the Formalities Officer. In the present case, only the box corresponding to the acceptance of the amendments, consisting of the set of claims for Austria, had been ticked, whilst the box referring to the approval of the text of the patent to be granted was not marked. This approval needed to be given separately according to the EPO practice in force at that time. Consequently, his approval (in the letter of 12 October 1988) was the only effective one and, therefore, the filing of a divisional application was legitimate. The Notice of the Vice-President of Directorate-General 2 cited

by the Receiving Section was not applicable to the present case, since it was published in the Official Journal only on 2 February 1989. For these reasons, the Appellant requested that the decision of 17 August 1989 be cancelled, the application No. 88 117 008.8 be allowed as a divisional application and the appeal fee be reimbursed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. The new version of Rule 25(1) EPC, which entered into force on 1 October 1988, raises some legal questions which do not need to be decided in the present case. These relate to the fact that it is meant to be impossible to file a European divisional application from a time when the subject-matter, which has been divided out of the earlier European application (parent application), is still pending before the EPO, i.e. is still legally viable. That instant in time may be several months before the end of the period of pendency, i.e. before the grant of a patent in respect of the parent application (which binds the EPO). Apart from the fact that no reason seems to justify such an early time limit, it appears doubtful whether Article 76(3) EPC can be interpreted as giving any kind of authorisation for generally prohibiting the filing of divisional applications from the time when the subject-matter divided out from the parent application is still pending before the EPO. Moreover, the "approval" referred to in Rule 51(4) EPC is not an irreversible occurrence in the proceedings relating to the parent application. If the Examining Division has occasion and is so disposed, it may reopen these examination proceedings - a step it could have taken in the present case. In the end, the circumstances of each

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particular case will decide what is to be understood by the term "approval" within the meaning of Rule 51(4) or Rule 25(1) EPC. If this notion is to have the effect of precluding a right, then it must be interpreted narrowly, which will mean adopting the more unambiguous of two statements by the applicant. Given the peculiarities of the present case, it would have been justifiable - as can be seen from what follows - to regard only the applicant's explicit approval as precluding such a right.

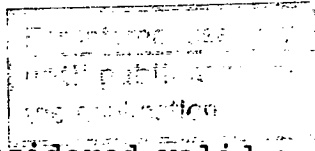
3. The Board agrees with the opinion of the Receiving Section that the communication pursuant to Rule 51(4) EPC clearly expressed the intention to grant the patent on the basis of the text sent to the Appellant. On the other hand, the communication explicitly requested the Appellant to state his approval within the given time limit. The subsequent communication issued by the Examining Division under Rule 51(6) EPC merely confirmed the acceptance of the new set of claims for Austria, but did not refer to an approval of the whole text of the patent to be granted; on the contrary, the special box provided for such an approval in EPO Form 2005.1.12.87 was not marked. In spite of the fact that the latter communication contained several indications as to the intention of the Examining Division to grant the patent in the amended form (for instance, request of the grant, printing and claims fees), the Appellant himself could have had the impression conveyed to him that the Examining Division was still waiting for his final approval and would not, therefore, take a decision before extension of the time limit set in the communication of 8 June 1988.

4. In the Board's view, furthermore, a certain ambiguity with regard to the term "approval" in Rules 25(1) and 51(4) EPC has to be considered. The interpretation given in the cited Notice of the Vice-President of Directorate-General 2 seems convincing, particularly from the aspect of accelerating

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the granting procedure. It does not, however, follow strictly from the wording of the respective Rules. Without taking a final standpoint on that question, it should be noted that a different interpretation cannot be excluded. Based on the principle of finding out the Appellant's true intention, it seems obvious to make a clear distinction between the filing of amendments on the one hand, and approval of the whole text of the patent to be granted on the other hand. In the present case, the latter interpretation was suggested to the Appellant by the above mentioned different boxes in the communication of 20 September 1988.

5. This Board has already stated several times that the principles of good faith governing the relations between the European Patent Office and applicants for European patents require communications to the applicant to be clear and unambiguous (J 3/87, OJ EPO 1989, 3 and J 1/89, decision of 1 February 1990). In the present case, the two relevant communications of the Examining Division were misleading in that they could, for the above reasons, quite plausibly be interpreted as allowing the Appellant to give his final approval on the text of the patent to be granted up to the extension of the time limit set in the first communication of 8 June 1988. This assumption was not excluded by the said Notice of the Vice-President of Directorate-General 2, even supposing that it reflected the only correct interpretation of Rule 51(4) EPC. The Appellant could take notice of it only at the date of its publication on 2 February 1989, a long time after all relevant time limits in the present case had expired.
6. For the above reasons, the Board finds that it is not justified to let the Appellant bear the whole risk of the ambiguity inherent in the two communications in question. Therefore, his final approval, declared in his letter of



12 October 1988 is the one considered valid and, consequently, the divisional application has been filed within time according to Rule 25(1) EPC.

7. The appeal fee cannot be reimbursed according to Rule 67 because no substantial procedural violation has taken place.

Order

For these reasons, it is decided that:

1. The decision of the Receiving Section of the European Patent Office dated 17 August 1989, refusing the filing of the European patent application No. 88 117 008.8 as divisional application of application No. 85 400 719.2, is set aside.
2. The filing of the European patent application No. 88 117 008.8 as a divisional application of application No. 85 400 719.2 is allowed.
3. The case is remitted to the Receiving Section of the European Patent Office.

The Registrar:

The Chairman:

J. Ruckerl

O. Bossung