

Publication in the Official Journal ~~Yes~~ / No

File Number: J 3/92 - 3.1.1

Application No.: 91 106 998.7

Publication No.:

Title of invention: Frying pans

Classification:

D E C I S I O N
of 6 August 1992

Applicant: Meyer Manufacturing Co., Ltd.

Headword: Deadline for filing divisional application/MEYER

EPC Article 76; Rules 25(1), 51(4)

Keyword: "filing of divisional application permitted up to grant of parent patent"



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Patentamt**

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Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : J 3/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 August 1992

Appellant : Meyer Manufacturing Co. Ltd.
382 Kwun Tong Road
Kowloon (HK)

Representative : Lloyd Wise, Tregear & Co.
Norman House
105-109 Strand
London WC2R 0AE (GB)

Decision under appeal : Decision of the Receiving Section of the European Patent Office dated 28 August 1991 refusing to treat the European patent application No. 91 106 998.7 as a divisional application of European patent application No. 87 307 307.6.

Composition of the Board :

Chairman : O.P. Bossung
Members : M.K.S. Aúz Castro
G. Davies

Summary of Facts and Submissions

- I. European patent application No. 87 307 307.6 (the parent application) was filed on 18 August 1987 claiming the priority of a British application filed on 1 September 1986.

A communication pursuant to Rule 51(4) EPC was issued on 21 December 1990 requesting the Appellant to approve the text notified for the grant of a European patent within four months. The approval was given by letter of 23 January 1991. By letter of 15 March 1991 this approval was withdrawn for the reason that it had been given in error. Following receipt of a communication of 27 March 1991 from the Office, stating that a withdrawal of the approval was not possible, the Appellant did not pursue the matter further but informed the European Patent Office of its intention to file instead a divisional application, directed to subject-matter not covered by the claims proposed for grant. The communication under Rule 51(6) of 5 February 1991 requesting payment of the fees for grant and printing as well as the filing of the translations of the claims was complied with on 3 May 1991. The Decision to grant the patent was given on 24 June 1991.

- II. Prior to that date, namely on 30 April 1991, the Appellant had, as announced previously, filed divisional application No. 91 106 998.7.

- III. On 28 August 1991, the Receiving Section, relying on Rule 25(1) EPC, issued a decision refusing to allow the application as a divisional application of the parent application, since the divisional application had been filed after the approval of the text pursuant to Rule 51(4) EPC. The procedure in respect of the parent

application had been concluded on 24 January 1991, the date on which the approval had been received.

- IV. On 29 October 1991 the Appellant's representative filed a notice of appeal, paying the appeal fee on the same day. The Grounds of Appeal were filed on 3 January 1992.

The Appellant argued in particular that approval of a text of a European patent application for the purposes of grant of a European patent did not end the procedure with respect to the European patent application, and that this procedure was only concluded by the grant of a patent. Furthermore, it contended that the refusal by the European Patent Office to accept withdrawal of the approval was a substantial procedural violation of Article 113(2) EPC.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. A divisional application may be filed, according to Article 76(1), second sentence, EPC, in respect of subject-matter which does not extend beyond the content of the earlier application as filed; insofar as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the right to any priority. Article 76(3) provides that the procedure to be followed in carrying out the provisions of paragraph (1), and the special conditions to be complied with by a divisional application are laid down in the Implementing Regulations.

Rule 25(1) EPC which concerns these special conditions, provides that a divisional application may only be filed up to the date of the approval of the text, in accordance with Rule 51(4), of the parent application. This limitation was introduced by the Administrative Council by its decision of 10 July 1988, when Rule 25 EPC was amended. Prior to that amendment, a divisional application could be filed at any time prior to grant if the Examiner considered such filing to be justified.

As explained in detail in the decision in consolidated cases J 11/91 and 16/91 (to be published), to which the Board refers, Rule 25 in its present version creates new substantive law. It thereby exceeds the competence afforded by Article 76(3) EPC. That provision allows only for the Implementing Regulations to lay down matters of procedure and not matters of substantive law taking away rights of the applicant.

For these reasons, the filing of a divisional application, which in this case took place prior to the decision to grant a patent for the parent application, is to be allowed.

3. All other questions arising in connection with a divisional application shall be dealt with in the course of the examination procedure of the divisional application as to substance; this includes, in particular, the question whether the subject-matter of the divisional application extends beyond the content of the earlier application.
4. As far as the contention that a substantial procedural violation occurred is concerned, the Board cannot follow the Appellant's argumentation for the following reasons:

In its communication stating that a withdrawal of the approval was not possible, the Examining Division merely expressed an opinion. Whether that opinion was right or wrong can be left open here. In spite of the opinion, the Appellant could have withdrawn its approval thereby bringing about a decision which it could have appealed, as it did when filing a divisional application. In that case also the Examining Division previously had expressed the opinion in a communication that, after the approval of the text in which a European patent is to be granted in accordance with Rule 51(4) EPC, the filing of a divisional application was no longer possible.

Order

For these reasons, it is decided that:

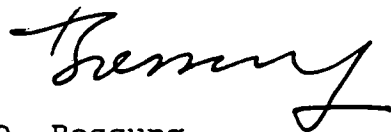
1. The decision under appeal is set aside.
2. The filing of European patent application No. 91 106 998.7 as a divisional application of application No. 87 307 307.6 is allowed.

The Registrar:



M. Beer

The Chairman:



O. Bossung

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