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D E C I S I O N
of 20 May 1994

Case Number: J 0036/92 - 3.1.1

Application Number: 91203007.9

Publication Number: -

IPC: F25B 39/02

Language of the proceedings: EN

Title of invention:

Evaporator with improved condensate collection

Applicant:

Modine Manufacturing Company

Opponent:

-

Headword:

Simultaneous approval of the text of a patent application and filing of a divisional application

Relevant legal norms:

EPC Art. 76

EPC R. 25(1), 51(4)

Keyword:

"Filing of divisional application allowed"

Decisions cited:

J 0013/84

Headnote/Catchword:

Where an Applicant approves the text of a European patent application pursuant to Rule 51(4) and in the same letter states that it has that day filed a divisional application, the filing of the divisional application shall be allowed, whether or not it is actually received by the EPO together with the letter.



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Boards of Appeal

Chambres de recours

Case Number: J 0036/92 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 20 May 1994

Appellant: Modine Manufacturing Company
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Racine, Wisconsin 53401 (US)

Representative: Goodenough, Nigel
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 26 May 1992 refusing to allow European patent application No. 91 203 007.9 to be filed as a divisional application of EP 88 310 955.5.

Composition of the Board:

Chairman: R.L.J. Schulte
Members: G. Davies
M.K.S. Aúz Castro

Summary of Facts and Submissions

- I. European patent application 88 310 955.5 was filed on 21 November 1988. A communication pursuant to Rule 51(4) EPC was sent to the Appellant on 18 July 1991. By a letter dated 18 November 1991 sent to the EPO by facsimile the Appellant gave his approval to the text of the parent application and also stated "We have today filed a divisional application including claims to subject-matter disclosed in the present application as filed, but not covered by the granted claims." In fact, the divisional application 91 203 007.9 was not filed until one day later, 19 November 1991, having been despatched to the EPO by courier on 18 November 1991.
- II. In a communication dated 15 January 1992, pursuant to Rule 69(1) EPC, the Receiving Section found that since the divisional application had not been filed until after approval had been given in respect of the pending earlier European patent application in accordance with Rule 51(4) EPC, it could not be treated as a European divisional application.
- III. By letter filed on 13 March 1992 the Applicant applied for a decision against this finding under Rule 69(2) EPC. On 26 May 1992 the Receiving Section confirmed its opinion that the application could not be treated as a divisional application.

The decision pointed out that the Guidelines for Examination part A Chapter IV-1.1.2 and part C Chapter VI-9.3 state that it is not possible to file a divisional application if the procedure in respect of the parent application has already ended in the grant of a patent. The Receiving Section found that the procedure

in this case had ended on 18 November 1991, the date on which the text of the parent application was approved by the Appellant.

The Receiving Section further found that there is no discretion available to the European Patent Office to allow a divisional application to be filed after the point referred to in Rule 25(1) EPC. In particular, the amendment to Rule 25(1) EPC dated 1 October 1988 was intended to clarify the grant procedure in this respect by indicating a clear point, identifiable in advance by the Applicant, at which the matter for which protection sought is agreed upon. The filing of a divisional application after this point in time would circumvent this objective. Thus, since the divisional application was filed after approval of the text pursuant to Rule 51(4) EPC was given, its filing as a divisional application could not be allowed pursuant to Rule 25(1) EPC.

IV. The Appellant filed an appeal against this decision on 22 July 1992, together with the payment of the appeal fee. The statement setting out the grounds of appeal was filed on 5 October 1992.

V. In support of this appeal the Appellant argued essentially as follows:

The divisional application and the letter approving the text of the parent application had been prepared by the representative on the same day, 18 November 1991. The divisional application had been despatched to the EPO by courier, whereas the letter of approval had been faxed to the EPO as a result of an error. Had it been despatched by ordinary post, it would have been received by the EPO on or after the actual filing date of the divisional application, 19 November 1991.

Upon a correct interpretation of the Implementing Regulations the European Patent Office had a discretion to allow the filing of a divisional application after approval of the text of the parent had been filed. Alternatively, if the European Patent Office had no discretion to permit the filing of a divisional application after the text had been approved, then Rule 25(1) EPC was *ultra vires*, being in conflict with Article 76.

Moreover, the wording of the letter filed on 18 November 1991 approving the text of the parent application was such that the approval should have been deemed to be received on the date of filing of the divisional application even though a facsimile of the letter was received prior to the actual date of filing of the divisional application; the approval of the text was clearly conditional upon the filing of the divisional application.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. Article 76(1) EPC provides for the filing of European divisional applications in respect of subject-matter which does not extend beyond the content of the earlier application as filed. According to Article 76(3) EPC the procedure to be followed and the special conditions to be complied with by a divisional application are laid down in the Implementing Regulations.

Rule 25 EPC, which contains the implementing regulations for the filing of European divisional applications, provides in paragraph (1) that a divisional application

on a pending earlier European patent application may be filed "up to approval of the text, in accordance with Rule 51, paragraph 4, in which the European patent is to be granted".

Rule 25(1) EPC was amended to include this time limit for filing a divisional application with effect from 1 October 1988 (OJ EPO 1988, 290).

The new version of Rule 25 EPC is currently being considered by the Enlarged Board of Appeal in case G 10/92, in connection with the question of the point in time up to which a divisional application may be filed in respect of an earlier pending European patent application. It is not appropriate, therefore, for the Board to comment on this issue or on the Appellant's arguments put forward in this respect; nor is it necessary to do so as this appeal can be decided on different grounds.

3. The reasons given by the Receiving Section for its decision do not withstand examination. In paragraph 2 of its reasons, the Receiving Section considered the fact that the divisional application reached the European Patent Office one day after the Applicant's letter approving the text of the parent application. However, it took no account of the fact that in the same letter the Applicant's representative informed the European Patent Office that he had filed a divisional application on that same day. From the wording of the letter it is apparent that the two pieces of information have to be seen as correlated and mutually dependent on each other (compare decision J 13/84, OJ EPO 1985, 34). In particular, the use of the perfect tense with regard to the filing of the divisional application makes it obvious that the requirements of Rule 25(1) EPC were fulfilled. After the clear statement in the Applicant's

letter "We have today filed a divisional application", it is of no importance that the two letters did not arrive on the same day as a result of the approval having been sent by facsimile and the divisional application having been sent by normal post.

4. Furthermore, the Board considers that the statement made in the first sentence of the Reasons for the decision under appeal, to the effect that it is not possible to file a divisional application, if the procedure in respect of the parent application has already ended in the grant of a patent, while true, is irrelevant to the circumstances of this case. The statement relies on a former version of the EPO Guidelines for Examination and does not constitute a basis for the assertion in the second sentence of the said reasons that the procedure in the present case ended on the date the text of the parent application had been approved by the Applicant pursuant to Rule 51(4) EPC.

For these reasons, the filing of the divisional application is to be allowed.

Order

For these reasons it is decided that:

1. The decision of the Receiving Section dated 26 May 1992 is set aside.
2. The filing of the European divisional application on 19 November 1991 is allowed.

The Registrar:



M. Beer

The Chairman:



R. Schulte

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