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**D E C I S I O N
of 4 October 1996**

Case Number: J 0013/94 - 3.1.1

Application Number: 93203407.7

Publication Number: -

IPC: G10L 3/00

Language of the proceedings: EN

Title of invention:
Speech processor

Applicant:
BRITISH TELECOMMUNICATIONS public limited company

Opponent:
-

Headword:
Divisional application/BRITISH TELECOMMUNICATIONS

Relevant legal provisions:
EPC Art. 108
EPC R. 25(1), 51(4), 85

Keyword:
"Application to be treated as divisional application - (yes)"
"No clear and unambiguous approval of the text"
"Unclear which text was approved by the applicant"

Decisions cited:
G 0010/92, J 0027/94, J 0029/95

Headnote:
If it remains unclear, on an objective basis, with which text the Examining Division intends to grant a patent, no valid approval can be given by the applicant (following decision J 0029/95).



Case Number: J 0013/94 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 4 October 1996

Appellant: BRITISH TELECOMMUNICATIONS public limited
company
81 Newgate Street
London EC1A 7AJ (GB)

Representative: Roberts, Simon Christopher
BT Group Legal Services
Intellectual Property Department
120 Holborn
London EC1N 2TE (GB)

Decision under appeal: Decision of the Receiving Section of the European
Patent Office dated 8 February 1994 refusing to
treat European patent application
No. 93 203 407.7 as a divisional application.

Composition of the Board:

Chairman: J.-C. Saisset
Members: B. J. Schachenmann
S. C. Perryman

Summary of Facts of Submissions

- I. The appellants filed European patent application No. 93 203 407.7 on 3 December 1993. According to the request for grant it should be treated as a divisional application on the earlier European patent application No. 87 304 793.0 (parent application) of the appellants.

- II. As concerns the parent application the first communication of the Examining Division was a communication under Rule 51(4) EPC. According to this communication dated 24 September 1990 the Division intended to grant a patent on the basis of the originally filed text with amendments proposed to the description and to claim 1. In response thereto the appellants by letter of 20 March 1991 indicated that they wished to amend the claims originally limited to device claims, through the addition of several method claims, and solicited a replacement communication under Rule 51(4) EPC. Upon this request the examination was resumed, as indicated in official communications of 3 July 1991 and 14 April 1992, on the basis of the application "as originally filed" and the new method claims. On 18 June 1993 oral proceedings took place before the Examining Division. At the end of these proceedings the chairman declared that the Examining Division intended to grant a patent on the parent application. A communication under Rule 51(6) EPC was issued on 29 June 1993, to which the appellants did not respond until 11 January 1994, at the same time requesting further processing under Article 121 EPC.

- III. With respect to the divisional application the Receiving Section informed the appellants on 10 January 1994 that a question up to which time a divisional application may be filed had been referred to the

Enlarged Board. Pending an answer by the Enlarged Board the then current official practice would be maintained, according to which the application was filed too late. If the appellants requested an appealable decision, it would therefore be decided that the application could not be filed as a divisional application, as it was filed after approval under Rule 51(4) EPC had been given to the text of the parent application.

- IV. On 13 January 1994 the appellants applied for a decision pursuant to Rule 69(2) EPC concerning their divisional application. They submitted that in the circumstances of the present case there had been no express approval of the text of the parent application.
- V. In its decision of 8 February 1994 the Receiving Section refused to treat application No. 93 203 407.7 as a divisional application since there was no discretion available to the EPO to allow a divisional application to be filled after the point referred to in amended Rule 25(1) EPC. The intention of the amendment of this Rule was, together with Rule 51(4) EPC, 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 is sought is agreed upon.
- VI. On 25 February 1994 the appellants filed a notice of appeal against this decision and paid the appeal fee. The statement setting out the grounds of appeal was received on 21 June 1994.
- VII. The appellants argued essentially as follows:
- (i) The decision under appeal refers to the approval of the text on "22.06.1993". There was no such approval. The relevance of the date is unknown.

- (ii) Rule 25(1) EPC does not exclude the filing of a divisional application even after the approval under Rule 51(4) EPC.

- (iii) There was in any case no **express** approval of the text of the parent application either during the oral proceedings or subsequently. If Rule 25(1) EPC indeed precluded the filing of divisional applications after the approval of the text, this should only apply where there is express approval.

- (iv) If the EPO considers amendments requested after the Rule 51(4) EPC communication to be allowable but still has objections to the amended text, the applicant should be requested to rectify the deficiencies and "to communicate his approval of the amended text" (Guidelines for Examination - C.VI.15.1.4). However, in the present case there was no such request from the EPO and it was therefore wrong to issue the Rule 51(6) EPC communication.

- (v) According to the decision under appeal and the opinion G 10/92 of the Enlarged Board of Appeal, it is one of the objectives of Rule 25(1) EPC to set a clear point in time allowing applicants to determine this point themselves and to identify it in advance by giving approval in accordance with Rule 51(4) EPC. However, the operation of Rule 25(1) EPC referred to above did not apply to the present case where the approval was deemed to have been given implicitly during the oral proceedings after significant exchange of correspondence between the EPO and the appellants.

- (vi) The question of filing a divisional application was raised by the primary examiner during the oral proceedings. The representative replied by saying something like: "Strangely enough we are considering filing at least one divisional application". The Examining Division, by implicit acceptance of the appellants' position, created the legitimate expectation that the filing of a divisional application would not be objected to. To deny the appellants this opportunity would exhibit lack of good faith on behalf of the EPO.

VIII. The appellants requested that the decision under appeal be set aside and European patent application No. 93 203 407.7 be allowed to continue as divisional application. Oral proceedings were requested in the event that the Board was minded to reject the appeal. The appellants further requested that the problem of deemed approval under Rule 51(4) EPC during oral proceedings be referred to the Enlarged Board of Appeal.

Reasons for the Decision

1. The present appeal complies with Articles 106 and 107 EPC and Rules 1(1) and 64(b) EPC. However, with respect to the requirements under Article 108 EPC the question arises whether the time limit for filing the statement setting out the grounds of appeal has been complied with. The four month period here referred to would normally have expired on Monday 20 June 1994, whereas the statement of the grounds of appeal was not filed until 21 June 1994.

However, according to the notice of the President of the EPO of 8 July 1994 concerning extension of time limits according to Rule 85 EPC (OJ EPO 1994, 583), all time limits expiring between 28 May and 6 July 1994 were extended, due to a general interruption of the postal service, to 7 July 1994.

Thus, in the circumstances of the present case, the time limit for filing the statement of the grounds of appeal was extended to 7 July 1994. Since the statement of grounds was received at the EPO before that date, the time limit referred to above has been complied with. The appeal is therefore admissible.

2. The appeal lies from the decision of the Receiving Section refusing to allow the filing of application No. 93 203 407.7 as a divisional application. The decision was based on the ground that the appellants had given their approval to the text of the parent application before the divisional application was filed. According to the decision under appeal it was given on 22 June 1993. However, the oral proceedings before the Examining Division took place already on 18 June 1993, whereas 22 June 1993 is the date on which the members of the Examining Division signed the internal EPO form 2035 detailing the documents for grant of patent. The fact that the appealed decision referred to the later date is thus due to an obvious error which had no bearing on the outcome of the decision under appeal. The decision cannot therefore be reversed for this reason alone.

3. Rule 25(1) EPC provides that a divisional application may be filed on a pending earlier European patent application up to the approval of the text, in accordance with Rule 51(4) EPC, in which the European patent is to be granted. According to the opinion G 10/92 of the Enlarged Board of Appeal (OJ EPO 1994,

633) this Rule sets a deadline for the filing of divisional applications, with the effect that the right to file divisional applications lapses on expiry of this deadline (see point 4 of the opinion).

4. Any approval of the text, in accordance with Rule 51(4) EPC, may thus have serious procedural consequences for applicants. Hence, according to the jurisprudence of the Legal Board of Appeal, declarations of applicants should only be treated as a valid approval under Rule 51(4) EPC if they are clear and unambiguous which, in particular, implies that:

- the approval is not subject to any condition (J 27/94, OJ 1995, 831);
- it is clear to which text the applicant has given his approval (J 29/95, OJ 1996, 489).

5. The main issue to be examined is therefore whether or not, in the circumstances of the present case, there was a clear and unambiguous approval in accordance with the jurisprudence referred to above. In particular, if the appellants are to be assumed to have indicated their approval during the oral proceedings of 18 June 1993, this requires that it was clear at that time which text they had approved.

When examining this question it is important to note that in the communication under Rule 51(4) EPC of 24 September 1990 the Examining Division indicated its intention to grant a patent on the basis of the filed text **with amendments proposed by itself** to page 5 of the description and to claim 1. A copy of the amended text was annexed.

Subsequently, when resuming substantial examination due to the appellants' request for adding new method claims, the Examining Division indicated that the examination was carried out on the pages 1 to 10 of the description and claims 1 to 8 **"as originally filed"** and the new method claims (see communications of 3 July 1991 and 14 April 1992). Thus, the Examining Division no longer adhered to the amendments proposed in its Rule 51(4) communication.

6. During the oral proceedings of 18 June 1993 the discussion was only about the new method claims and a corresponding adaptation on page 2 of the description. As follows from the minutes, the other parts of the application were neither referred to by the Examining Division nor by the appellants. Moreover, it cannot be derived from the minutes or the file that the appellants had the opportunity to check any of the possible versions of the application documents as a complete set.

Thus, the discrepancy between the communication under Rule 51(4) EPC and the subsequent communications was not resolved during the oral proceedings and it remained unclear, on an objective basis, whether the Examining Division intended to grant a patent with page 5 of the description and claim 1 amended as proposed in the communication under Rule 51(4) EPC or "as originally filed" in accordance with its subsequent communications.

7. According to the minutes of the oral proceedings the applicants requested the grant of a patent "based on the claims as amended". Obviously, this statement refers to the new method claims which alone were discussed during the oral proceedings. However, even if this statement is understood as an implicit approval of

all other parts of the parent application on file, it is in any case not clear which of the two texts on file was approved by the applicants.

The internal EPO form 2035.3 indicates the version with the amendments mentioned in the communication under Rule 51(4) EPC as being the text for grant. However, this form was prepared and signed by the Examining Division four days after the oral proceedings (see point 2, supra). It is therefore not relevant in the present context.

8. Thus, the appellants cannot be assumed to have given, prior to the filing of the divisional application, their approval, in accordance with Rule 51(4) EPC, to the text in which the parent application was to be granted. The provisions of Rule 25(1) EPC do not therefore preclude the patent application in suit from being treated as a divisional application.

9. In view of this finding in favour of the appellants, there is no need for the Board to consider the other arguments and requests of the appellants. In particular, it can remain open whether implicit approval during oral proceedings before the Examining Division is to be treated as a valid approval under Rule 51(4) EPC, and no decision is required on the appellants' request for referral of this point of law to the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

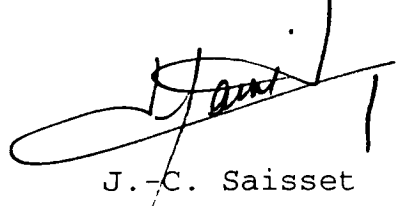
1. The decision under appeal is set aside.
2. The European patent application No. 93 203 407.7 is to be treated as divisional application on the earlier application No. 87 304 793.0.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset