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**D E C I S I O N**  
**of 20 March 1996**

**Case Number:** J 0012/95 - 3.1.1

**Application Number:** 94106046.9

**Publication Number:** -

**IPC:** A61K 31/55

**Language of the proceedings:** EN

**Title of invention:**

Central cholecystokinin antagonists for treatment of  
psychiatric disorders

**Applicant:**

MERCK SHARP & DOHME LTD.

**Opponent:**

-

**Headword:**

Divisional application/MERCK

**Relevant legal provisions:**

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

**Keyword:**

"Application to be treated as divisional application (yes)"

"Validity of procedural declaration (no)"

"Fax transmitted contrary to the order of the representative"

**Decisions cited:**

G 0010/92, J 0011/91; J 0016/91, J 0027/94

**Catchword:**

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Case Number: J 0012/95 - 3.1.1

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.1**  
**of 20 March 1996**

**Appellant:** MERCK SHARP & DOHME LTD.  
Hertford Road  
Hoddesdon  
Hertfordshire EN11 9BU (GB)

**Representative:** Thompson, John Dr.  
Merck & Co., Inc.  
European Patent Department  
Terlings Park  
Eastwick Road  
Harlow, Essex CM20 2QR (GB)

**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 17 January 1995 refusing to treat European patent application No. 94 106 046.9 as divisional application.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** R. E. Teschemacher  
S. C. Perryman

### **Summary of Facts and Submissions**

- I. European patent application No. 94 106 046.9 was filed on 19 April 1994. In box 35 of the request form it was indicated that the application was a divisional application from the earlier application No. 90 114 993.0.
- II. In a communication dated 26 July 1994, noting a loss of rights pursuant to Rule 69(1) EPC, the Receiving Section informed the Applicants that the application would not be treated as a divisional application because it was filed after approval had been indicated in respect of the earlier pending application in accordance with Rule 51(4) EPC. Opinion G 10/92 of the Enlarged Board of Appeal (later published in OJ EPO 1994, 633), confirming that under Rule 25(1) EPC a divisional application on the pending earlier application may only be filed up to the approval in accordance with Rule 51(4) EPC, was annexed to the communication.
- III. In reply, the Applicants applied for a decision on the matter under Rule 69(2) EPC. They submitted that this application was filed before opinion G 10/92 had been handed down. It would be contrary to the well-established principle of good faith to apply the opinion retrospectively to the Applicants' detriment. Rather, the principles prevailing at the filing date laid down in J 11/91 and J 16/91 (OJ 1994, 28) had to be applied according to which a divisional application could still be validly filed after the approval in accordance with Rule 51(4) EPC.

- IV. On 17 January 1995, the Receiving Section issued a decision stating that the application would not be treated as a divisional application. In the reasons, the Receiving Section held that neither the principle of good faith nor the protection of legitimate expectations obliged the EPO to apply decisions J 11/91 and J 16/91 (above) in the present case. In the same issue of the Official Journal (OJ EPO 1-2/1993) in which the headnotes of decisions J 11/91 and J 16/91 were published the referral by the President of the EPO of a question of law to the Enlarged Board of Appeal following decisions J 11/91 and J 16/91 was also published. From this information, it should have been clear for an applicant that there was at least some uncertainty and that obviously decisions J 11/91 and J 16/91 were not accepted as a general practice.
- V. On 23 February 1995, the Applicants filed a notice of appeal against this decision, paying the appeal fee the same day. The statement of grounds of appeal was filed on 7 April 1995.
- VI. The Appellants disagreed with the Receiving Section's position. In their opinion, a reasonable practitioner would legitimately have expected on the filing date that full reliance could realistically be placed on the ruling in decision J 11/91 and J 16/91 (above). Furthermore, it was submitted that the Board should exercise its discretion in their favour since the application had been filed within one single day of receipt by the EPO of the approval of the text intended for grant in the earlier application. The rights of third parties could not possibly be adversely affected because the approval, whilst lodged on 18 April 1994, was not actually due until 2 May 1994 at the earliest. Finally, the Appellants produced a copy of form 1037 (acknowledgement of receipt for subsequently filed

documents) in which the EPO acknowledged that the approval had been filed on 19 April 1994. They requested that, under the exercise of the Board's discretion, the date of receipt of the approval should be deemed to be the same date as that shown by the receipt stamp on the return copy of form 1037.

VII. The Board informed the Appellants of decision J 27/94 (OJ EPO 1995, 831) in which it was decided that the department of first instance was not obliged by the principle of good faith to allow the filing of divisional applications after the approval of the text intended for grant on the basis of decision J 11/91 (above) until opinion G 10/92 (above) was made available to the public. Furthermore, the Board obtained the file of the earlier application from the first instance and informed the Appellants that the file revealed that the approval had been received by fax on 18 April 1994 and as a confirmation copy on 19 April 1994. This explained why the Applicants had received the acknowledgement confirming the receipt of the letter of approval on 19 April 1994.

VIII. In response, the Appellants submitted that the transmission of the approval by fax on 18 April 1994 was contrary to their representative's true intentions and occurred in contravention of his express instructions. Statutory declarations of the Authorised Representative and of the person who sent the fax were produced. From these, it becomes evident that the Representative received on 15 April 1994 from the Applicants' corporate patent counsel the instruction to approve the text intended for grant in application No. 90 114 993.0 and to file a divisional application on the same application. In order to comply with the time limit in Rule 25(1) EPC, he instructed on 18 April 1994, the next working day, the staff associate responsible for the

preparation and despatch of approval letters under Rule 51(4) EPC to prepare the documents for the divisional application and to prepare the letter of approval under Rule 51(4) EPC and to place both documents in the same envelope for despatch to the EPO by courier service. The documents were duly prepared by the staff associate and signed by the representative. Before placing the letter of approval in the envelope, the staff associate transmitted the letter of approval to the EPO by fax and stamped the original "Confirmation". The transmission by fax was contrary to the standard procedure applied in the office to send approvals by courier service only. Both, the representative and the staff associate were aware of the time limit and its calculation and knew that it could be reasonably ensured that the letter would arrive by courier service at the EPO well before the 2 May 1994 deadline. They also knew that there was no need to fax the letter of approval to the EPO since there was in any case the possibility of further processing if for some unforeseeable reason the consignment was not received in due time by the EPO. The staff associate cannot remember why she, contrary to standard practice and contrary to the instructions in the individual case, transmitted the approval by fax.

- IX. The Appellants requested that the decision under appeal be set aside. Their submissions imply the request that the present application be treated as a divisional application of application No. 90 114 993.0.

## Reasons for the Decision

1. The admissible appeal lies from the decision of the Receiving Section refusing to treat the present application as a divisional application. The Board cannot agree with the Appellants' objections based on the principles of good faith and legitimate expectations against the decision of first instance. The Board has made clear its position in this respect in decision J 27/94 (above) and the Appellants' arguments give no reason to deviate from it.
  
2. In addition to their previous submissions, the Appellants have submitted in second instance that the fax of 18 April 1994 was not authorised by the representative. This raises the question whether this fax can be regarded as a valid procedural declaration of the Applicants.
  - 2.1 For such a declaration it was not only necessary that it was set down in writing and signed, it also required communication to the EPO in order to become valid. In the present case, the transmittal was not effected by the appointed Authorised Representative but by a staff associate in his office. In a normal case, it has to be assumed that the person entitled to act by signing a declaration addressed to the EPO expresses his intent to the responsible clerical staff that the declaration be transmitted to the EPO. He cannot allege later on that the transmittal of the declaration was against his will. In the application in suit, the declaration was transmitted by two different routes, by fax and by courier service. According to the intention of the staff associate, the fax transmission should take legal effect whereas the hard copy should only serve as a confirmation copy which is in this situation normally

not necessary and without legal effect (Rule 36(5) EPC in connection with the Notice from the EPO concerning the filing of patent applications and other documents, pt. 4, OJ EPO, 1992, 306). According to the Authorised Representative, the hard copy was intended to be the only copy to be transmitted to the EPO. Since this was, according to the Appellants' submissions, not only a mere intention but a positive order to the responsible staff member, the representative could not be expected to envisage that the declaration would be transmitted by fax. Whereas the content of the declaration was his declaration, the fax transmission is not attributable to him.

- 2.2 In the interest of legal security, the validity of procedural declarations may be challenged only on the basis of clear and convincing evidence. It may be expected that the fact that a declaration received by the EPO was transmitted against the authorised person's will should be submitted immediately after this person has got knowledge of the transmittal. In the present case, this submission was only made in appeal proceedings in reply to a communication of the Board. Nevertheless the Board considers these submissions to be credible: First, the Applicants tried to base their case in first instance on a line of argument which also other applicants in the same situation regarded to be promising. This may have contributed to the fact that the validity of the declaration transmitted by fax was not pursued. Second, the facts submitted in the two statutory applications establish a course of events which is as a whole consistent and based on verifiable details. Considering the fact that normally the late receipt of documents may endanger the applicants' rights, whereas an earlier receipt by the EPO by fax normally has no ill effects, the Board can accept as probable and proven that the employee concerned sent the



approval by fax as an unauthorised and misguided precaution to exclude any possibility of missing the time limit, without being conscious that this addition to what she had been asked to do, namely sending the approval and divisional at the same time by courier, could in these special circumstances have the effect that the divisional application would be received by the EPO a day later than the approval, and thus too late.

3. In these circumstances, the Board has come to the conclusion that the letter of approval was transmitted by fax against the express order of the Authorised Representative and cannot, therefore, be treated as a valid approval. The approval of the text in the earlier application was not declared until the receipt of the hard copy on 19 April 1994, the date of receipt of this application. Hence, this application has been filed within the time limit laid down in Rule 25(1) EPC.

### Order

#### For these reasons it is decided that:

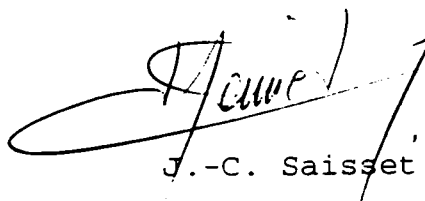
1. The decision under appeal is set aside.
2. The application is to be treated as a divisional application of application No. 90 114 993.0.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset

