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D E C I S I O N
of 20 August 1997

Case Number: J 0014/95 - 3.1.1

Application Number: 94106785.2

Publication Number:

IPC: B60J 1/00

Language of the proceedings: EN

Title of invention:

An elongate compressible cushion

Applicant:

SILVESTRE, Jean

Headword:

Divisional application/SILVESTRE

Relevant legal provisions:

EPC Art. 76

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

Keyword:

"Application to be treated as divisional application - (no)"

"Legitimate expectations - (no)"

Decisions cited:

G 0001/84, G 0005/88, G 0003/91, G 0009/91, G 0010/92,

G 0005/93, G 0007/93, G 0009/93, J 0006/79, J 0011/90,

J 0011/91, J 0016/91, J 0003/92, J 0027/94, J 0029/95,

T 0905/90

Catchword:

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Case Number: J 0014/95 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 20 August 1997

Appellant: SILVESTRE, Jean
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Decision under appeal: Decision of the Receiving Section of the European
Patent Office dated 13 January 1995 refusing to
treat European patent application
No. 94 106 785.2 as divisional application

Composition of the Board:

Chairman: J.-C. Saisset
Members: R. E. Teschemacher
G. Davies

Summary of Facts and Submissions

- I. European patent application No. 94 106 785.2 was filed on 29 April 1994 as a divisional application of European patent application No. 89 870 134.7. At that time the applicant had already given his approval, received on 9 December 1993, to the text intended for grant of the earlier application pursuant to Rule 51(4) EPC.
- II. In a communication dated 27 June 1994, noting a loss of rights pursuant to Rule 69(1) EPC, the Receiving Section informed the applicant that the application would not be treated as a European divisional application because it was filed after approval had been given in respect of the text of the pending earlier European patent application.
- III. On 25 August 1994 the applicant requested a decision in accordance with Rule 69(2) EPC. He submitted that, according to decision J 11/91 and J 16/91 (OJ EPO 1994, 28, hereinafter referred to as J 11/91, headnote in OJ EPO 1-2/1993, V) the filing of a divisional application was possible up to the decision to grant a European patent. On the date of filing this application, the opinion of the Enlarged Board of Appeal G 10/92 had not yet been issued. In accordance with the principle of good faith and the protection of the legitimate interests of the users of the EPO as acknowledged by the Enlarged Board of Appeal in G 5/88 (OJ EPO 1991, 137), he submitted that the EPO could be considered to be bound by J 11/91. Attention was also drawn to decision G 5/3 of the Enlarged Board of Appeal (OJ EPO 1994, 447) according to which, following a change in the interpretation of the law, the old law continued to apply up to the publication of the decision which changed the law.

IV. On 13 January 1995, the Receiving Section issued a decision refusing to treat the application as a divisional application of the earlier application on the following grounds:

- (1) According to Rule 25(1) EPC, as amended with effect from 1 October 1988, divisional applications may only be filed up to approval of the text of the parent application pursuant to Rule 51(4) EPC. This had been confirmed by the Enlarged Board of Appeal in opinion G 10/92 (OJ EPO 1994, 633, headnote in OJ EPO 7/ 1994, IX). The Receiving Section was not bound to apply decision J 11/91 since an individual decision of a Board of Appeal only binds the first instance in the individual case and does not have to be applied to every case.

- (2) The Receiving Section did not share the applicant's opinion that the divisional application should be allowed on the basis of the principle of the protection of the legitimate expectations of users of the EPO. According to this principle, measures taken by the EPO should not disregard the reasonable expectations of the parties to the proceedings (G 5/88). At the date of filing this application, it was apparent that no harmonised practice existed. The President's referral of the question until when a divisional application may be filed was published in the same issue of the Official Journal in which the headnote of J 11/91 was published. From this, it should have been clear to any applicant that there was at least some uncertainty and that J 11/91 could not be regarded as reflecting the general practice of the EPO. Therefore, there was no reasonable expectation on which an applicant could rely, when filing a divisional application after

giving its approval under Rule 51(4) EPC.

Furthermore, the headnote of decision G 10/92 had already been published at the date of filing this divisional application.

V. On 13 March 1995 the applicant filed a notice of appeal against this decision, paying the appeal fee on the same day. The statement of grounds of appeal was filed on 10 May 1995.

VI. The appellant contended that the Receiving Section was legally bound to follow J 11/91 pursuant to Article 111(2) EPC. The provision specified that in so far as the facts were the same, the department whose decision was appealed was bound by the *ratio decidendi* of the decision. Since the facts of the present case were the same as in J 11/91, the Receiving Section was bound to follow that decision.

Furthermore, he submitted that, on the basis of the information available when the text of the earlier application was approved, there was a legitimate and reasonable expectation that a divisional application could be filed up until the date of the decision to grant. Users of the EPO habitually, and rightly, considered the published decisions to determine what likely future practice would be. The EPO had not only published the headnote of J 11/91 and the question referred by the President of the EPO to the Enlarged Board of Appeal in OJ EPO 1-2/1993, but also the full text of the decision J 11/91 in OJ EPO 1994, 28. Referring to decision T 905/90 (OJ EPO 1994, 306), the appellant argued that these publications had to be regarded as an appropriate source of legitimate expectations since they contained an official statement

of general applicability. The publication of headnotes was made in order to inform the applicants that they could make use of this information in their own cases. In addition, J 11/91 was confirmed by two further decisions of the Legal Board of Appeal.

The pending referral of G 10/92 could not be said to have informed EPO users that the President of the EPO did not agree with the position taken in J 11/91. By submitting the question "Until when may an applicant file a divisional application?" the President did not make clear that he objected to the possibility of filing a divisional application after approving the text of the earlier application. There was no cross reference between the publication of the question and the publication of the headnote of J 11/91 which would have indicated to applicants that they could not rely on J 11/91.

Referring to decision G 5/88, G 5/93 (above) and G 9/93 (OJ EPO, 1994, 891), the appellant took the view that he could expect to be allowed to continue proceedings in the divisional application which he had embarked on in good faith.

VII. In a communication dated 18 July 1995, the Board drew the appellant's attention to decision J 27/94 (OJ EPO 1995, 831) in which it was stated that the department of first instance was not obliged by the principle of good faith to allow the filing of divisional applications after approval of the text intended for grant on the basis of J 11/91 until such time as opinion G 10/92 had been made available to the public.

In his reply and in the oral proceedings which took place on 5 June 1997, the appellant argued that in J 27/94 the filing of a divisional was allowed. The

fact that in J 27/94 the applicant, when approving the text, had declared that he would file a divisional application did not amount to a significant difference from the facts of the present case. This declaration was nothing more than an indication that the applicant would take advantage of an already existing right. Therefore, J 27/94 did in fact follow J 11/91. Also previous decisions had allowed the late filing of divisional applications. It would be contrary to the principle of good faith to decide in this case otherwise.

The oral proceedings in this case were held in common with oral proceedings in cases J 15/95, J 16/95, J 17/95, J 24/95 and J 25/95. Since the appellants in these various cases referred to each others' submissions, also here reference is made to the decisions in these cases.

VIII. The appellant requested that the present application be treated as a divisional application of application No. 89 870 134.7. Alternatively, he requested that the following question of law be referred to the Enlarged Board of Appeal:

"The recently published decision G 7/93 set out the principle that 'An approval of a notified text submitted by an applicant pursuant to Rule 51(4) EPC does not become binding once a communication in accordance with Rule 51(6) EPC has been issued'. The same decision mentions 'that neither approval of the notified text by the applicant, nor issue of a Rule 51(6) communication by the EPO '**binds**' either the applicant or the EPO in the **true** meaning of this word'. The question is now: Is there, in view of what had been decided by G 7/93, not a conflict with G 10/92, setting the time limit for filing a divisional application?"

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 decision was based on opinion G 10/92 of the Enlarged Board of Appeal, stating that, according to Rule 25(1) EPC, an applicant may only file a divisional application on the pending earlier application up to the approval of the text notified under Rule 51(4) EPC. The appellant filed the application in suit as a divisional application after having approved the text intended for grant with respect to the earlier application on 9 December 1993. He submits that the filing of a divisional application at this stage of the proceedings was nevertheless possible for various reasons.
2. At the outset it has to be determined whether a valid approval under Rule 51(4) EPC has been given.
 - 2.1 In J 27/94 the Board was faced with the situation that the applicant, referring to decision J 11/91, declared in the same letter as that in which he approved the text intended for grant that he intended to file a divisional application for subject-matter deleted from the application. The Board concluded that these two declarations were inconsistent and that the Examining Division should not have treated the letter as a valid approval. In the present case, a declaration concerning a divisional application was not made.
 - 2.2. The Board cannot agree with the appellant that both cases have to be dealt with in the same way. In J 27/94 it was clear to the Examining Division when receiving the applicant's letter that the applicant wanted his approval to take immediate effect but also that the

applicant still wanted to file a divisional application on the basis of Rule 25 EPC as interpreted in J 11/91. Both intentions existed at the same time but could not be realised in parallel. If the approval was considered valid, the filing of a divisional was no longer possible. Therefore, the applicant's declaration in J 27/94 was more than an indication that the applicant would take advantage of an already existing right. Rather, the inconsistency of the declarations made was a reason not to consider the approval as valid. Such inconsistency of declarations by the applicant did not exist in the present case. Hence, there was no reason to doubt the validity of the approval.

3. Therefore, the decision in the present case hinges on the answer to the question whether the Receiving Section was bound to follow J 11/91.
- 3.1 The Board cannot follow the appellant's submission that Article 111(2), first sentence, EPC is applicable in this case. The provision refers to the situation that a case is remitted by the Board to the first instance for further prosecution. This makes evident that the effect of *res judicata* can only arise in the individual case which is remitted back and not in other cases in which a decision by the Board has not been given (J 27/94, Reasons 3).
- 3.2 Neither did the publication of J 11/91 create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. The Legal Board of Appeal was already faced with this question in decision J 27/94 where it was stated 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

until such time as opinion G 10/92 was made available to the public. The appellant's argumentation against the decision of the first instance gives no reason to deviate from decision J 27/94.

- 3.3 The case law of the Enlarged Board of Appeal referred to by the appellant concerns quite different situations.
- 3.3.1 In G 5/88 the question was decided whether documents intended for the EPO could be validly filed with the German Patent Office on the basis of an Administrative Agreement concluded between the EPO and the German Patent Office in 1981. The Enlarged Board considered the relevant provision outside the proper scope of the Agreement for the period before the filing office of the EPO in Berlin was established in 1989. In respect of the legal effect of the publication of the Agreement in the Official Journal in 1981, the Enlarged Board stated that the users of the EPO were entitled to rely upon what the Agreement promised: namely that documents intended for the EPO and received by the German Patent Office in Berlin would be treated by the EPO as if it had received them directly.
- 3.3.2 In G 5/93 the Enlarged Board, confirming decision G 3/91 (OJ EPO 1993, 8), decided that re-establishment of rights was excluded under Article 122(5) EPC for the time limits for paying the filing, designation and claims fees when entering the regional phase of a Euro-PCT application. Previous practice following i.a. decision J 6/79 (OJ EPO 1980, 225) had considered re-establishment in Euro-PCT cases available, although the corresponding time limits in European applications were excluded from re-establishment. In respect of pending cases, the Enlarged Board referred to the "Information for PCT Applicants", published in the Official Journal, stating that the applicant in case of a loss of rights

could have them re-established. The Board concluded that the EPO was bound by its own published interpretation and applicants were entitled to expect that the EPO should apply this interpretation up to the date on which decision G 3/91 was made available to the public.

3.3.3 In case G 9/93 the Enlarged Board, considering the concept of opposition proceedings developed in G 9/91 and G 10/91 (OJ EPO 1993, 408, 420), decided that G 1/84 (OJ EPO 1985, 299), ruling that a proprietor may oppose his own patent, could no longer be followed. The Board stated that, in principle, any interpretation by the Enlarged Board meant that the law had always been in conformity with that interpretation. In pending cases, relying on G 1/84 which had been followed for many years, proprietors had every reason to expect that self opposition would be considered admissible. It would be inequitable to prevent them from continuing proceedings they had embarked on in good faith (Reasons 6.1).

3.3.4 The first two cases have in common that there was a long-lasting practice laid down in publications from the EPO for the purpose of advising applicants about details of EPO procedure. Whereas in the first case no case law of the Boards of Appeal at all was relevant for the EPO practice, the practice in the second case was caused by a series of decisions of the Legal Board of Appeal. In applying the principle of legitimate expectations, the Enlarged Board referred, however, not to the decisions of this Board but to the published information addressed to PCT applicants. It may be concluded therefrom that such publications from the EPO are of particular importance for the application of the principle of legitimate expectations. The third case concerns a modification by the Enlarged Board of Appeal of its own earlier interpretation of the law.

The users' confidence in the continuity of a practice based on a decision of the Enlarged Board may be considered particularly legitimate since all Boards of Appeal are expected to follow the Enlarged Board's interpretation of the EPC. This is why Rule 16 of the Rules of Procedure of the Boards of Appeal provides for a further referral, should a Board consider it necessary to deviate from a previous interpretation of the EPC by the Enlarged Board.

- 3.4 In the opinion of this Board, this does, however, not mean that legitimate expectations can only be derived from situations covered by the above decisions of the Enlarged Board. Already in J 27/94 (Reasons 5) the Board said that there may be cases in which the public has a legitimate expectation that the first instance will not deviate from the established case law of the Boards of Appeal.
- 3.5 This raises the question whether one may speak of **established** case law in circumstances where a single decision of a Board of Appeal is overturned by the Enlarged Board of Appeal before it had either been confirmed by other decisions or become part of the practice of the first instance. Reference has been made to two other decisions of this Board confirming J 11/91, ie J 11/90 and J 3/92 (both dated 6 August 1992 and not published). These decisions date from the day after J 11/91 and the reasons given therein are largely based on those of J 11/91. Hence there is no confirming decision in which a second look was taken at the problem.
- 3.6 In decision T 905/90, Technical Board of Appeal 3.3.1 summarized the extensive relevant case law (see also Case Law of the Boards of Appeal of the EPO, 2nd ed. 1996, VI.A.1) in stating that, so far, the decided

cases showed the source of legitimate expectations to be confined to two categories of information: the first made by departments of the EPO within the framework of an individual case, eg in the form of a communication to the party, and the second, information contained in an official statement of general applicability (eg Guidelines) and published in the Official Journal. Board 3.3.1 added that legitimate expectations could also properly arise from the actual general conduct or established practice of departments of the EPO. For completeness, the decisions of the Enlarged Board of Appeal should be added, the special rôle of which has already been mentioned (see pt. 3.3, above).

3.7 This Board is however not aware of any case in which legitimate expectations, justifying a deviation from the law in its correct interpretation, have been accepted only on the basis of the publication of a single decision of a Board of Appeal. There is no need for the Board to decide this question in the present case since the appellant, on the basis of the information published in OJ EPO, should have been aware of the fact that decision J 11/91 was contested. The appellant's submissions give, however, rise to the observation that decisions of the Boards of Appeal are not published because the EPO wants to announce that its users can rely on them in future cases. Rather, the Boards themselves decide to publish certain decisions because they consider them to be of general interest in respect of the development of the case law.

3.7.1 Reading the text of J 11/91, it should have been clear to the appellant that there were two positions with regard to the validity of Rule 25(1) EPC as amended with effect from 1 October 1988: the conclusion of the Legal Board of Appeal that the provision was incompatible with Article 76 EPC (Reasons pt. 2.3.6) and the position of the President of the EPO that the

provision was binding (Facts and Submissions, pt. VII). Needless to say, the Administrative Council of the EPO may also be assumed to have considered the amendment to the Implementing Regulations as compatible with the Convention. On the basis of this knowledge, the appellant should have taken note of the footnote to the heading of the text of the decision "See referral to the Enlarged Board of Appeal pending under Ref. No. G 10/92 (OJ EPO 1993, 6)" guiding him to the publication of the question referred to the Enlarged Board of Appeal under Article 112(1)(b) EPC "Until when may an applicant file a divisional application on the pending earlier application?". Any careful reader would have seen from this information that there had been a referral because of conflicting decisions in relation to J 11/91 and should have envisaged that the Enlarged Board might determine the last date for filing a divisional differently from J 11/91.

- 3.7.2 In summary it has to be concluded that the application of the principle of the protection of legitimate expectations would require that the appellant could expect that a consistent practice to allow divisional applications also after the approval under Rule 51(4) EPC in the earlier application would continue to be applied also in his case. This cannot be accepted on the facts of the case. The appellant did not even have a reasonable ground to assume that such a practice had ever existed. This is not to be regarded as a retroactive application of opinion G 10/92. Rather, this opinion determined how Rule 25(1) EPC should always have been interpreted (see G 9/93, Reasons 6.1) and, having knowledge of the referral, the appellant could not take it for granted that the Enlarged Board would decide in the way which he expected. If there was any doubt whether an established practice in this

respect existed, it was up to the appellant to seek clarification by means of an enquiry to the EPO (T 905/90, Reasons 6) which would have revealed quickly that the first instance did not apply J 11/91.

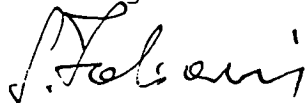
4. The referral to the Enlarged Board of Appeal of the question of law formulated by the appellant is not justified. Apparently, the appellant sees a conflict between the statement that the approval of the text notified under Rule 51(4) EPC is not binding and the further statement that the filing of a divisional application is no longer possible after approval. An inconsistency could be argued to exist if the applicant had the right to have the communication under Rule 51(4) EPC repeated at his discretion. This would require a further approval and open another possibility to file a divisional application with the consequence that the restriction in Rule 25(1) EPC would be meaningless. The opportunity to file amendments after approval of the text does, however, not imply the right to have a further communication under Rule 51(4) EPC. As this Board has explained in J 29/95 (OJ EPO, 1996, 489, Reasons 3), the filing of amendments after the communication under Rule 51(4) EPC does not prevent the Examining Division from establishing the applicant's approval, taking account of the requested amendments under Rule 51(6) EPC. In this situation, a further communication under Rule 51(4) EPC does not issue and the inconsistency alleged by the appellant does not exist.

Order

For these reasons it is decided that:

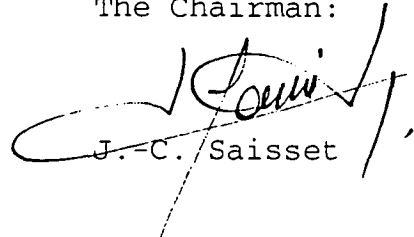
1. The request for referral of a question to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:



J.-C. Saisset

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