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

Case Number: J 0015/95 - 3.1.1

Application Number: 93105018.1

Publication Number: -

IPC: F16D 25/14

Language of the proceedings: EN

Title of invention:

Apparatus for controlling hydraulic pressure for clutch

Applicant:

KABUSHIKI KAISHA KOMATSU SEISAKUSHO

Headword:

Divisional application/KOMATSU

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 0009/93, J 0006/79, J 0015/85, J 0002/87,

J 0011/90, J 0011/91, J 0016/91, J 0003/92, J 0027/94,

J 0029/95, T 0905/90

Catchword:

-



Case Number: J 0015/95 - 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:

KABUSHIKI KAISHA KOMATSU SEISAKUSHO
3-6, Akasaka 2-chome
Minato-ku
Tokyo 107 (JP)

Representative:

Selting, Günther, Dipl.-Ing
Patentanwälte von Kreisler
Selting, Werner
Postfach 10 22 41
D-50462 Köln (DE)

Decision under appeal:

Decision of the Receiving Section of the European
Patent Office dated 13 January 1995 refusing to
treat European patent application
No. 93 105 018.1 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. 93 105 018.1 was filed on 26 March 1993 as a divisional application of European patent application No. 87 907 829.3. At that time the applicants had already given their approval, received on 9 March 1993, to the text intended for grant of the earlier application pursuant to Rule 51(4) EPC.
- II. In a communication dated 6 May 1993, 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 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 24 June 1993 the applicants requested a decision in accordance with Rule 69(2) EPC. It was 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. Even if the Enlarged Board of Appeal came to a different result in G 10/92, this would have an effect only for future cases. Reference was made to J 2/87 (OJ EPO 1988, 330) according to which the EPO should apply the procedural provisions it has established equally to all cases even when these provisions were clearly contrary to the Convention. Furthermore, the applicants argued that they had already declared, when submitting restricted claims in

the earlier application, that the claims were only directed to a part of the original disclosure, and that it was intended to file divisional applications for the other embodiments within the term of Rule 25 EPC.

IV. Having been informed by the Receiving Section that the current practice would be maintained for the time being and that the opinion resulting from the pending referral G 10/92 would form the basis for further proceedings, the applicants declared that they preferred to wait for the outcome of G 10/92 before any decision in this case be taken.

V. After opinion G 10/92 was issued, the applicants maintained their request for a decision. They submitted that it could not be expected that J 11/91 would later be overruled. It was not evident from the publication of the headnote that the decision would be brought before the Enlarged Board of Appeal. On the basis of the principle of good faith, the users of the EPO should have been able to rely on the published decision until it was overruled.

VI. 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 applicants' 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, OJ EPO 1991, 137). 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.

- VII. On 10 March 1995 the applicants 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 12 May 1995.
- VIII. The appellants referred to the case law of the Enlarged Board of Appeal which had acknowledged in G 5/88 the principle that the legitimate expectations of the users of the EPO are to be protected. This was confirmed in G 5/93 (OJ EPO 1994, 447) and G 9/93 (OJ EPO 1994,

891). According to both decisions a new ruling, changing EPO practice, should not be applied to requests made before the new decision was published. Knowledge of a referral to the Enlarged Board had no effect with respect to the good faith. This was evident from case G 5/93 which also changed the practice after a referral.

- IX. There were further reasons of equity why the present application should be allowed to proceed as divisional application. Whereas opinion G 10/92 stated that the way shown in J 11/91 for filing a late divisional application was inadmissible under the Convention, it showed at the same time how the same result could be achieved in another way. It allowed the applicant to withdraw his approval under Rule 51(4) EPC and the Examining Division had to proceed either by issuing a new communication under Rule 51(4) EPC or by refusing the application, with the right for the applicant to file an appeal. In both situations the applicant could file a divisional application. In the result, the possibility of filing a late divisional application existed on the basis of G 10/92 as well as on the basis of J 11/91. It would be inequitable to leave those applicants without protection who had to file their divisional applications in the intermediate term.
- X. In a communication dated 18 July 1995, the Board drew the appellants' 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

opinion G 10/92 had been made available to the public. Furthermore, the appellants were made aware of the fact that G 10/92 did not require the Examining Division to reopen examination after each request for an amendment.

In their reply and in the oral proceedings which took place on 5 June 1997, the appellants pointed to their letter dated 16 October 1991. The declaration that they intended to file divisional applications had to be seen in connection with the declaration of approval, received on 9 March 1993. Hence, the approval was not clear and unequivocal. By the implicit acceptance of the applicants' position that a divisional application would not be objected to, the Examining Division created the legitimate expectation that a divisional application could be filed in accordance with J 11/91.

In respect of the information given to the users on J 11/91, decision J 27/94 came to wrong conclusions. The appellants were misled because there was no cross-reference between the headnote of J 11/91 and the referral of the case to the Enlarged Board of Appeal by the President of the EPO. Nor was there any indication that a future decision of the Enlarged Board of Appeal could have a retroactive effect on J 11/91. Even the publication of the full decision did not make it clear that there was any risk in following J 11/91.

XI. The oral proceedings in this case were held in common with oral proceedings in cases J 14/95, 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.

XII. The appellants requested that the present application be treated as a divisional application of application No. 87 907 829.3.

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 appellants 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 March 1993. The appellants submit 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 with respect to the earlier application.

- 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. By contrast, the applicants in the present case declared their intention to file a divisional application at an earlier stage, when they restricted the earlier application.

2.2 The Board cannot agree with the appellants that the declarations in the two cases have to be interpreted 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. The situation in the present case is quite different. The intention to file a divisional application was declared at the time the application was restricted, whereas the approval did not contain any such indication. In this situation, the Examining Division had no reason to investigate whether the applicants had actually filed a divisional application or whether they still intended to file it. The decision whether or not to file a divisional application for deleted subject-matter is dependent on circumstances completely outside the grant procedure. The applicants had no reason whatsoever to inform the EPO if they dropped their intention to file a divisional application. The letter dated 16 October 1991 declared only what the intention was at that time, presumably in order to avoid the impression that the applicants intended to abandon the subject-matter definitively (see J 15/85, OJ EPO 1986, 395). The letter neither stated nor implied that this intention should persist until some future stage of the proceedings. The applicants even expressly referred to the term of Rule 25 EPC. Hence, there was no reason to assume that they intended to file a divisional application after the end of this time limit and to doubt the validity of the approval.

3. Therefore, the decision in the present case hinges on the answer to the question whether the publication of J 11/91 created a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant.

3.1 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 appellants' argumentation against the decision of the first instance gives no reason to deviate from decision J 27/94.

3.2 The decisions of the Enlarged Board of Appeal referred to by the Appellants concern quite different situations.

3.2.1 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.

3.2.2 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.

3.2.3 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).

3.2.4 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.

- 3.3 In the opinion of this Board, the analysis of the relevant case law of the Enlarged Board of Appeal should not give rise to the conclusion 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) this 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.
- 3.4 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 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.

3.5 In decision T 905/90 (OJ EPO 1994, 306), 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 (see J 2/87, referred to by the appellants), 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. 3.2, above).

3.6 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 appellants, 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

appellants' 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.

- 3.6.1 The appellants filed this application shortly after the publication of the headnote to J 11/91. It is true that this publication did not expressly refer to the publication of the referral to the Enlarged Board of Appeal in the same issue of the Official Journal. This lack of a cross-reference, however, did not entitle the appellants to ignore additional relevant information when they decided to act according to the headnote of J 11/91. An applicant who wishes to rely on the principle of good faith based on information from the EPO cannot pick out the piece of information on which he intends to base his legal position and ignore other official information going in a different direction. It was clear from the corresponding terminology in the headnote to J 11/91 and in the question referred to the Enlarged Board that both publications related to the same legal problem. Furthermore, the publication of the referral made apparent that the reason for the referral was a divergency in the case law. This should have alerted the appellants. Since the legal situation was obviously not clear, they were at least expected to use all information at their disposal and to obtain a copy of the complete decision which was available at the time. Reading the text of J 11/91, it should have been clear to them 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. Any careful applicant would have envisaged that the Enlarged Board might determine the last date for filing a divisional differently from J 11/91.

3.6.2 In summary it has to be concluded that the application of the principle of the protection of legitimate expectations would require that the appellants 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 their case. This cannot be accepted on the facts of the case. The appellants 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 appellants could not take it for granted that the Enlarged Board would decide in the way which they expected. If there was any doubt whether an established practice in this respect existed, it was up to the appellants 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.

3.7 The appellants invoke the principle of good faith for the further reason that the Enlarged Board had indicated another possibility to file a divisional after approval by allowing the applicant to withdraw his approval and to file further amendments. Although G 10/92 acknowledged that amendments may be requested at this stage, this does not mean that the previous approval is deemed not to have been declared (pt. 5 of

the Reasons). The opportunity to file amendments after approval of the text does 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 is not issued. Furthermore, the Examining Division, in exercising its discretion pursuant to Rule 86(3) EPC, may decide not to allow an amendment. This shows that the applicant is not entitled to receive a further communication under Rule 51(4) EPC. The position advocated by the appellants would make the deadline set by Rule 25(1) EPC meaningless and would give the applicant unlimited control over the time when to put an end to the grant procedure. It is also against the explicit intention expressed in G 10/92 to give effect to the sanction laid down in Rule 25(1) EPC.

Order

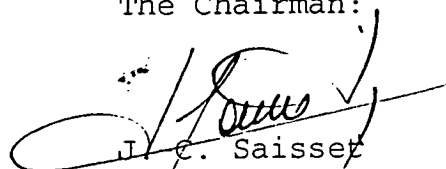
For these reasons it is decided that:

The appeal is dismissed.

The Registrar:


S. Fabiani

The Chairman:


J. C. Saisset

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