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

Case Number: J 0016/95 - 3.1.1

Application Number: 94112037.0

Publication Number: 0696744

IPC: G01R 35/00

Language of the proceedings: EN

Title of invention:

Nuclear magnetic resonance (NMR) imaging with multiple surface coils

Applicant/Patentee:

GENERAL ELECTRIC COMPANY

Headword:

Divisional application/GENERAL ELECTRIC

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 0011/90,

J 0011/91, J 0016/91, J 0003/92, J 0027/94, T 0905/90

Catchword:

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Case Number: J 0016/95 - 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: GENERAL ELECTRIC COMPANY
1 River Road
Schenectady, NY 12345 (US)

Representative: Pedder, James Cuthbert
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 24 January 1995
refusing to treat European patent application
No. 94 112 037.0 as a 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. 94 112 037.0 was filed on 2 August 1994 as a divisional application of European patent application No. 89 900 995.5. At that time the applicants had already given their approval, received on 4 July 1994, to the text intended for grant of the earlier application pursuant to Rule 51(4) EPC.

- II. In a communication dated 30 August 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 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 6 October 1994 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. On the date of filing this application, the opinion of the Enlarged Board of Appeal G 10/92 had not been published in the Official Journal of the EPO. In accordance with the principle of good faith, it was submitted that the divisional application had been legitimately filed. Attention was drawn to decision G 5/93 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 24 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, 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.

- V. On 21 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 24 May 1995.
- VI. The appellants agreed with the Receiving Section that opinion G 10/92 determined what the correct interpretation of Rule 25 EPC was deemed always to have been. They further agreed that the departments of first instance are not legally bound to follow decisions of the Legal Board of Appeal beyond the limits of Article 111(2) EPC.

They submitted, however, 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. It was entirely reasonable for a user of the EPO to conclude that this official publication of the decision was a considered action by the EPO to bring the attention of its users to what the EPO, at that time, regarded as the current practice as regards filing divisionals after approving the text of the earlier application.

The pending referral of G 10/92 could not be said to have unambiguously warned EPO users (or indeed warned them at all) that there was a problem of harmonization in this area. Decision J 11/91 was not submitted for "clarification" but for "uniform application of the law". An EPO user could reasonably conclude that the EPO had moved to harmonize its practice by officially publishing decision J 11/91 and would reasonably expect that this harmonization of practice would be made binding on the EPO by the subsequent opinion of the Enlarged Board of Appeal. If the pending nature of referral G 10/92 allowed another interpretation, then it was in the interest of fair dealing with the EPO that the appellant should be given the benefit of the doubt and be able to proceed on the understanding that decision J 11/91 reflected the current practice of the EPO until such time as the Enlarged Board of Appeal determined the matter one way or the other by confirming or overturning that decision. It was not unreasonable for the users of the EPO to share the confidence of the Legal Board in their conclusions in J 11/91, in which case the President of the EPO had given his comments and the Board, nevertheless, had been prepared to allow the divisional application filed after approval and had not seen any need to refer the question to the Enlarged Board of Appeal.

Referring to decision G 5/93 (above) and G 9/93 (OJ EPO, 1994, 891), the appellants took the view that the users of the EPO could not be assumed to have been properly informed of opinion G 10/92 before the publication of the full text in OJ EPO. The opinion should not be applied retrospectively. Third party rights could not be affected thereby since the only decision available at the relevant point of time was J 11/91.

VII. 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 such time as opinion G 10/92 had been made available to the public.

In their reply and in the oral proceedings which took place on 5 June 1997, the appellants further submitted that under principles of natural justice or good faith or the protection of legitimate expectations, a person could rely on the case law of the Boards of Appeal until the law was changed. In the absence of opinion G 10/92, the Receiving Section would either follow J 11/91 or would be forced to follow it on appeal. Although the divisional application had been filed after publication of the headnote of G 10/92, the headnote did not constitute a publication of the decision and, therefore, the decision could not become binding before its text was published.

They also drew the Board's attention to the file of the earlier application. In their letter dated 12 May 1993, when restricting the claims in reply to an objection of non-unity, they had expressly declared that they intended to file a divisional application in respect of these claims. This declaration had never been withdrawn and, therefore, remained in force when the text of the earlier application had been approved. Hence, the situation was the same as in J 27/94, the only difference being that the two different declarations appeared in two separate letters. The inconsistency between these declarations was apparent and the EPO therefore had had an obligation to clarify what the real intention of the applicants was.

Furthermore, the appellants argued that Rule 25 EPC was not applicable to the procedural situation arising in this case. In their opinion the provision stipulated only when a divisional application could be filed. However, it did not prescribe that after the relevant date a divisional application could not be filed. According to a general principle of the EPC, provided there was no prohibition on taking a procedural act at a given time there was at least a discretion for the responsible body to allow it. This principle had been applied eg in relation to filing amendments after the reply to the first communication of the Examining Division or when the priority document was not filed within the time limit pursuant to Rule 38(3) EPC. Therefore, the Board should exercise its discretion and allow the application to proceed as a divisional on this basis.

The oral proceedings in this case were held in common with oral proceedings in cases J 14/95, J 15/95, 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 appellants requested that the present application be treated as a divisional application of application No. 89 900 995.5.

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 4 July 1994. 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.
 - 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 applicant had actually filed a divisional application or whether he 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 12 May 1993 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. Nor did it contain any reference to J 11/91 which could have made the Examining Division aware of the fact that the applicants intended to file a divisional application on a legal basis which the EPO was not willing to accept. Hence, there was no reason to doubt the validity of the approval.

3. The Board cannot follow the appellants' submission that a divisional application may be allowed after approval of the earlier application at the discretion of the EPO. In this respect, it seems sufficient to refer to opinion G 10/92 which states that a divisional application may **only** be filed up to the approval in accordance with Rule 51(4) EPC. The arguments put forward by the appellants give no reason to discuss the interpretation of Rule 25(1) EPC again in detail. The specific procedural situations from which they seek to derive a general principle according to which acts which are not performed within the prescribed time

limit can also be performed afterwards are the subject of specific provisions (Rule 86(3), 2nd sentence, EPC for amendments; Article 91(1)(d) in connection with Rule 41(1) EPC for the filing of priority documents) which do not exist for the filing of divisional applications.

4. 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.

4.1 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.

4.2 The decisions of the Enlarged Board of Appeal referred to by the appellants concern quite different situations.

4.2.1 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.

4.2.2 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.

4.2.3 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).

4.2.4 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 resulted from 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.

4.3 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.

4.4 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 by the Enlarged Board 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.

4.5 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, 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 point 4.2, above).

4.6 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.

4.6.1 Reading the text of J 11/91, it should have been clear to the appellants 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 point 2.3.6) and the position of the President of the EPO that the provision was binding (Facts and Submissions, point 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 appellants 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 them 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.

4.6.2 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

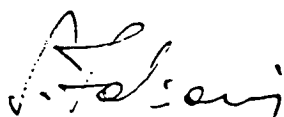
applied also in their case. This cannot be accepted on the facts of the case. The appellants did not even have a reasonable ground to assume that such a practice had ever existed. This is not to be regarded as a retroactive application of opinion G 10/92. Rather, this opinion determined how Rule 25(1) 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.

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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