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

**Case Number:** J 0017/95 - 3.1.1

**Application Number:** 94101929.1

**Publication Number:** -

**IPC:** C07C 31/22

**Language of the proceedings:** EN

**Title of invention:**  
Trimethylolheptane tri(meth)-acrylates

**Applicant:**  
KURARAY Co., Ltd.

**Headword:**  
Divisional application/KURARAY

**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 0013/90, J 0011/91, J 0016/91, J 0003/92, J 0027/94,  
J 0029/95, T 0905/90

**Catchword:**  
-



Europäisches  
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des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0017/95 - 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:**

KURARAY Co., Ltd.  
1621 Sakazu  
Kurashiki City  
Okayama Prefecture 710 (JP)

**Representative:**

Rucker, Ernst, Dr., Dipl.-Chem.  
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**Decision under appeal:**

Decision of the Receiving Section of the European  
Patent Office dated 28 March 1995 refusing to  
treat European patent application  
No. 94 101 929.1 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. 94 101 929.1 was filed on 8 February 1994 as a divisional application of European patent application No. 89 107 060.9. At that time the applicants had already given their approval, received on 7 February 1994, to the text intended for grant of the earlier application pursuant to Rule 51(4) EPC.
  
- II. In a communication dated 17 March 1994, the Receiving Section informed the applicant of the fact that the question until when a divisional application may be filed had been referred to the Enlarged Board of Appeal and that no decision would be taken in this case until the Enlarged Board had delivered its decision. In a further communication dated 20 February 1995, noting a loss of rights pursuant to Rule 69(1) EPC, the Receiving Section, referring to opinion G 10/92 (OJ EPO 1994, 633, headnote in OJ EPO 7/1994, IX), informed the applicants that the application would not be treated as a European divisional application because it had been filed after approval had been given in respect of the text of the pending earlier European patent application.
  
- III. On 27 February 1995 the applicants requested a decision in accordance with Rule 69(2) EPC. In its decision dated 28 March 1995, the Receiving Section refused to treat the application as a divisional application of the earlier application on the following grounds:

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. In accordance with the practice adopted by the first instance following the amendment of the rule, there was no

discretion for the EPO to allow the filing of a divisional application after this date. The practice of the first instance had been confirmed by the Enlarged Board of Appeal in opinion G 10/92. The Receiving Section was not bound to apply 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) 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.

- IV. On 23 May 1995 the applicants filed a notice of appeal against this decision, paying the appeal fee and submitting the statement of grounds of appeal on the same day.
- V. The appellants argued that, according to decision J 11/91 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, it was submitted that the divisional application had been validly filed since the filing was in accordance with the practice of the EPO on the filing date. In the case where wrong information from the EPO, on which the applicant could rely, entailed a legal disadvantage, the applicant should be protected on the basis of the relevant case law (J 13/84, OJ EPO 1985, 34; J 22/86, OJ EPO 1987, 280; T 130/82, OJ EPO 1984, 172; T 2/87, OJ EPO 1988, 264).
- VI. In a communication dated 26 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.

VII. In their reply and in the oral proceedings which took place on 5 June 1997, the appellants further submitted that the considerations of this Board in J 27/94 did not exclude the possibility that in the present situation their good faith should be protected. A legitimate expectation that the first instance would not deviate from the established case law existed not only when the case law had become part of the Guidelines or of a Legal Advice or Notice from the EPO. Referring to J 13/90 (OJ EPO 1994, 456), they argued that the EPO had an obligation to give an explicit warning that it did not intend to follow case law. The mere fact that the question referred to the Enlarged Board had been published in the same issue of the Official Journal as the headnote of J 11/91 did not remove the appellants' good faith in respect of this decision since the publication gave the impression that the first instance would bow itself to the decision and did not want to act against it on its own authority.

From decision J 29/95 they concluded that also this Board had taken the position that for an interim period the Receiving Section had to follow J 11/91. There, it was stated that it was a proper course of action not to take a negative decision as long as there was the possibility that the Enlarged Board would confirm J 11/91 (J 29/95, OJ EPO 1996, 489, Reasons 11).

They also drew the Board's attention to the file of the earlier application. In their letter dated 16 September 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. When receiving the declaration

of approval of the text intended for grant, the EPO should also take into consideration the previous declaration that a divisional application would be filed. Therefore, the declaration of approval should not be understood in such a way that it included an abandonment of the divisional application, in particular because the filing of a divisional was still possible on the basis of J 11/91. The intention to file a divisional had been repeated within the time limit under Rule 51(4) EPC when the approval was declared, although the latter declaration obviously was received one day earlier. By not objecting to the approval, the Examining Division accepted the applicants' position that the filing of a divisional application was still possible. If there was an inconsistency between both declarations the EPO was obliged to clarify the applicants' true intention. At least the letter dated 16 September 1993 should have induced the EPO to send a warning.

Finally, they took the position that Rule 25 EPC, in the amended version, was an arbitrary restriction of the right to file a divisional application as laid down in the Paris Convention.

VIII. The oral proceedings in this case were held in common with oral proceedings in cases J 14/95, J 15/95, J 16/95, 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.

IX. The appellants requested that the present application be treated as a divisional application of application No. 89 107 060.9.

## 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 one day after having approved the text intended for grant with respect to the earlier application on 7 February 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 16 September 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. The letter dated 7 February but filed on 8 February 1994, in which the applicants expressly reserved the right to file a divisional application, was received only after the letter of approval had been received and taken effect. It was not available at the relevant date so as to enable the declaration of approval to be interpreted. Hence, there



was neither a reason to doubt the validity of the approval nor was there a reason to send a warning to the applicants.

3. The Board cannot follow the appellants' submission that Rule 25 EPC as amended is an arbitrary restriction of the right to file a divisional application under the Paris Convention. In this respect it is sufficient to refer to G 10/92 (Reasons 9, 10). It may be added that the amendment to Rule 25(1) EPC removed the previous much more restrictive requirement, according to which, following an objection of non-unity, a divisional had to be filed within two months of the limitation of the earlier application.

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 case law of the Enlarged Board of Appeal, applying the principle of protection of legitimate expectations when decisions changed an existing practice, concerns quite different situations.

4.2.1 In G 5/88 (OJ EPO 1991, 137) 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 (OJ EPO 1994, 447) 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 (OJ EPO 1994, 891) 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 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.

- 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 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.
- 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. The decisions cited by the appellants belong to these categories. Board 3.3.1 added that legitimate expectations could 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. 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 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 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.

4.6.3 The appellants alleged that this Board accepted in J 29/95 that the Receiving Section had to follow J 11/91 for an interim period. This is a mistaken conclusion from point 11 of the Reasons for that decision. There, the Board dealt with an alleged procedural violation due to an unjustifiable delay in the processing of the case. The Board accepted that it was legitimate for the Receiving Section not to take a negative decision on the filing date so long as there was the possibility that the Enlarged Board would confirm J 11/91. This in no way implied that the Receiving Section had to give a positive decision. It

seemed only reasonable, in agreement with previous case law, to keep the case pending until the matter was settled by the Enlarged Board of Appeal.

4.6.4 Finally, the appellants' allegation that other late-filed divisional applications had been treated differently and had been given the filing date of the earlier application was not substantiated. The Board has received no evidence that this was the case. Therefore, it has not been shown that there has been a breach of the principle of equal treatment.

**Order**

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

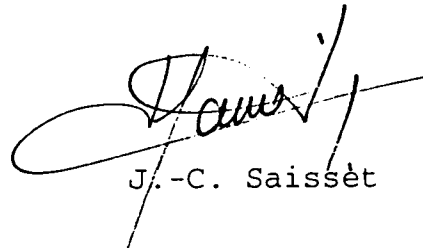
The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:



J.-C. Saissèt

