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**D E C I S I O N**  
of 30 January 1996

**Case Number:** J 0029/95 - 3.1.1

**Application Number:** 92103552.3

**Publication Number:** -

**IPC:** B23Q 7/14

**Language of the proceedings:** EN

**Title of invention:**

Apparatus for the automatic adjustment of pallet workpiece support members

**Applicant:**

AXIS S.p.A.

**Opponent:**

-

**Headword:**

Divisional application/AXIS

**Relevant legal provisions:**

EPC Art. 76, 113(2)  
EPC R. 25(1), 51(4)(5)(6)

**Keyword:**

-

**Decisions cited:**

G 0010/92, J 0011/91, J 0016/91

**Headnote:**

1. The Examining Division, when allowing amendments submitted by the applicant in reply to the communication under Rule 51(4) EPC, can establish the applicant's approval of the text intended for grant pursuant to Rule 51(6) EPC on the basis of the amendments and of the texts communicated to the applicant to which no amendments have been submitted.

2. A valid approval of the text intended for grant requires that it is clear which text the applicant has approved. This is not the case if the communication under Rule 51(4) EPC refers to an enclosed text which is not actually annexed.



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Boards of Appeal

Chambres de recours

Case Number: J 0029/95 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 30 January 1996

**Appellant:** AXIS S.p.A.  
I-50028 Tavarnelle Val di Pesa  
(Firenze) (IT)

**Representative:** Moir, Michael Christopher  
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100 Grays Inn Road  
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**Decision under appeal:** Decision of the Receiving Section of the European Patent Office dated 25 July 1995 refusing to treat European patent application No. 92 103 552.3 as a divisional application.

**Composition of the Board:**

**Chairman:** R. Schulte  
**Members:** R. E. Teschemacher  
B. J. Schachermann

### Summary of Facts and Submissions

- I. European patent application No. 92 103 552.3 was filed on 2 March 1992. In box 35 of the request form it was indicated that the application was a divisional application from the earlier application No. 89 110 492.9.
- II. In a communication pursuant to Rule 69(1) EPC, dated 24 March 1992, the Receiving Section informed the applicant that the application would not be treated as a divisional application because it was filed after approval had been indicated in respect of the earlier application in accordance with Rule 51(4) EPC.
- III. In his response, received on 8 April 1992, the applicant applied for a decision pursuant to Rule 69(2) EPC. It was submitted that amendments had been requested in the reply of 13 February 1992 to the communication under Rule 51(4) EPC, dated 19 December 1991, in the parent application. These amendments were accepted in the communication of the Examining Division under Rule 51(6) EPC, dated 3 March 1992, i.e. after the filing of the divisional application. Considering decisions J 11/91 and J 16/91 (OJ EPO 1994, 28) and the question referred to the Enlarged Board of Appeal until when a divisional application may be filed, the Receiving Section informed the applicant that no decision would be given in this case until the Enlarged Board had delivered its opinion in case G 10/92.
- IV. Having been informed of opinion G 10/92 (OJ EPO 1994, 633), the applicant maintained his request for a decision, submitting that the proposal of amendments in the letter of 13 February 1992 could not be construed as acceptance of the text. The EPO, after having received

this request for amendments, should have issued a further communication under Rule 51(4) EPC rather than proceeding directly to the communication under Rule 51(6) EPC.

- V. On 25 July 1995, the Receiving Section issued a decision stating that the application would not be treated as a divisional application. In the reasons, it was stated that according to published EPO practice (Notice from the Vice-President of Directorate General 2, dated 20 September 1988, OJ EPO 1989, 43), it was not necessary for the applicant to give an express approval of the documents intended for grant with a request for amendment; the request for amendment, if accepted, was taken as an implicit approval of the text.
- VI. On 25 September 1995, the applicant filed a notice of appeal against this decision together with the statement of grounds of appeal, paying the appeal fee on the same day.
- VII. The appellant submitted that the documents annexed to the communication under Rule 51(4) EPC did not contain page 3 of the description whereas in respect of page 3b of the description the Examining Division proposed an amendment. In the applicant's reply to the communication, the omission of page 3 had been noted. In addition, amendments to pages 3a, 3b, 13, 18, 22 and 23 and to Figures 8 to 15 were proposed. The reply did not contain a statement that the text intended for grant was approved, nor could the letter be construed as implicitly accepting the text, since the applicant had not seen page 3 of the description as proposed by the Examining Division. Furthermore, the applicant's proposals for amendments contained a "counter-offer" to the "offer" made by the Examining Division in the communication under Rule 51(4) EPC. According to

established principles of civil law in the contracting states, a counter-offer was not accepted until the acceptance of the offer was notified to the party making the offer. In the present case, the EPO had accepted the applicant's offer by means of the communication under Rule 51(6) EPC. Hence, the counter-offer became effective only after the filing of the divisional application.

- VIII. The appellant requested that the decision under appeal be set aside. His submissions imply the request that the application be treated as a divisional application of application No. 89 110 492.9.
- IX. In addition, the appellant requested that the appeal fee and his costs be reimbursed in view of the substantial procedural violation in the procedure under Rule 51(4) and (6) EPC and because of the unjustifiable delay of the proceedings by the Receiving Section.

#### **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 the ground that the applicant had given a valid approval to the text intended for grant in the parent application before filing the present application.
2. Pursuant to Rule 25(1) EPC, the applicant may file a divisional application up to the approval of the text, in accordance with Rule 51(4) EPC, in which the patent is to be granted. Contrary to decisions J 11/91 and J 16/91 (supra), the Enlarged Board of Appeal has

confirmed in G 10/92 (supra) that the fixing in Rule 25(1) EPC of the point in time up to which a divisional application may be filed is consistent with Article 76(3) EPC.

3. In the present case, the applicant reacted to the communication under Rule 51(4) EPC with a request for amendments. For this situation, Rule 51(6), first sentence, EPC stipulates expressly that the Examining Division can establish the applicant's approval of the text intended for grant "taking account of any proposed amendment". This means that the Examining Division can proceed on the basis of the amendments and that the documents to which no amendments have been made remain unchanged. Rule 51 EPC does not allow the applicant to take a stance only in respect of a part of the documents communicated to him. Hence, Rule 51(6), first sentence, EPC gives a basis for the Examining Division to establish that the parts of the documents intended for grant, for which no amendments have been submitted, have been agreed to. Only if the applicant files amendments to specific parts of the documents communicated to him together with a declaration that he does **not** approve other parts, is the Examining Division prevented from establishing the applicant's approval. In the latter situation, however, Rule 51(5), first sentence, EPC is applicable and the application shall be refused.
  
4. This course of action is not only clear from the wording of Rule 51(4) to (6) EPC, it is also in the interests of a streamlined procedure. Rule 51(4) EPC provides for a final check of the documents intended for grant. It shall bring the substantive examination of the case to an end. This implies that there should be no opportunity

for the applicant at this stage to call into question the result of the previous examination which was based on his own requests and to leave open his position on the application as a whole.

5. It remains to be examined whether under the specific circumstances of the case the reply to the communication under Rule 51(4) EPC was a valid approval of the text intended for grant.
6. This can only be assumed if it is clear to which text the applicant has given his approval. In this respect, the reply is unambiguous as far as the text communicated to the applicant and the applicant's amendments to this text are concerned, since these documents were annexed either to the communication or to the reply.
7. The missing page 3 of the description is, however, not defined in the same way. On the coverpage of the communication (form 2004), it is indicated as "page 3 received on 22 July 1991 with letter of 19 July 1991" and the only amendment proposed by the Examining Division is indicated for page 3b. The same coverpage mentions that a copy of the relevant documents is enclosed. In this way, the coverpage and the annexed documents are inconsistent, since page 3 was not actually annexed.
8. The practice of transmitting a complete copy of the documents to the applicant to obtain his approval serves the purpose of making it certain beyond any doubt that the patent is granted only in the text to which the applicant has agreed (Article 113(2) EPC). In particular, the applicant is given the opportunity to check the documents as a complete set, without being forced to collect the documents following references in the communication. If in consequence of a clerical error

in the preparation of the communication under Rule 51(4) EPC the documents are not complete, the purpose of the communication is not fulfilled. In a case where the communication is contradictory in itself, it remains unclear to which text the applicant has agreed and it cannot be assumed that agreement has been expressed to a text which had not been transmitted.

9. Neither can the applicant's reply be interpreted as a request to insert page 3 by way of amendment. The applicant has confined himself to making the Examining Division aware of the missing page. He has not requested the inclusion of a specific version of it in the documents intended for grant. Therefore, it was the task of the Examining Division to send a copy of page 3, in the version intended for grant to the applicant and to obtain his approval of this text. Without such a confirmation, the applicant cannot be assumed to have given his approval, as foreseen in Rule 51(4) EPC, and the conditions defined in Rule 25(1) EPC for the point in time up to which divisional applications may be filed were not fulfilled.
10. In view of Rule 67 EPC the reimbursement of the appeal fee as requested is not justified. It may be left undecided whether an alleged procedural violation in the earlier application might give rise to a reimbursement of the appeal fee in this divisional application. The dispatch of the communication under Rule 51(6) EPC after the receipt of the applicant's reply to the communication under Rule 51(4) EPC was based on an interpretation of the applicant's declaration which turned out to be wrong for legal reasons. A wrong application of the law is, however, not sufficient to establish a substantial procedural violation within the meaning of Rule 67 EPC.



11. Neither has the appellant shown that the Receiving Section caused an unjustifiable delay in the processing of this application. On the basis of the legal position of the Receiving Section, the opinion to be given by the Enlarged Board of Appeal in G 10/92 was prejudicial for the treatment of this case. As long as there was the possibility that the Enlarged Board would confirm decisions J 11/91 and J 16/91 (supra), it was a proper course of action not to give a negative decision on this case (cf. T 166/84, OJ EPO 1984, 489). The file does not reveal that the applicant objected to this treatment of the case, of which he had been informed.
  
12. The appellant has not identified which other costs he wants to have reimbursed. Since neither Rule 67 EPC nor Article 104 EPC are a possible basis for the reimbursement of other costs in this case, it was not necessary to investigate this question any further.

**Order**

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

1. The decision under appeal is set aside.
2. The application is to be treated as divisional application on the earlier application No. 89 110 492.9.
3. The request for reimbursement of the appeal fee and of other costs is refused.

The Registrar:



M. Beer

The Chairman:



R. Schulte

Te  
B. Sch.