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D E C I S I O N
of 6 June 1997

Case Number: J 0030/95 - 3.1.1

Application Number: 93 ...

Publication Number: -

IPC: C07C 69/76

Language of the proceedings: EN

Title of invention:
Fluoroalkane derivative

Applicant: N.N.

Opponent:
-

Headword:
Divisional application

Relevant legal provisions:
EPC Art. 76
EPC R. 25(1), 51(4)

Keyword:
"Application to be treated as divisional application - (no)"
"Res judicata"
"Referral to the Enlarged Board of Appeal - (no)"
"Good faith"

Decisions cited:
G 0010/92, J 0011/91, J 0016/91, T 0092/85, T 0830/91,
T ... G 0007/93, J 0027/94, J 0003/95

Catchword:
-



Case Number: J 0030/95 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 June 1997

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 17 May 1995 refusing to treat European patent application No. 93... 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 ... was filed on 15 October 1993 as a divisional application of European patent application No. 87 ... At that time the applicant had already given its approval, received on 9 November 1990, to the text intended for grant of the parent application pursuant to Rule 51(4) EPC.
- II. In a communication, dated 30 November 1993, the applicant was informed by the Receiving Section of the EPO that the President of the EPO had referred a question to the Enlarged Board of Appeal on the point of law until when may an applicant file a divisional application on a pending earlier European patent application (G 10/92, for referral, see OJ EPO 1993, 6). In order not to prejudice the decision of the Enlarged Board, the Receiving Section stated that current official practice, according to which a divisional application could not be filed after approval under Rule 51(4) EPC, would provisionally be maintained and that the opinion resulting from G 10/92 would form the basis for further processing regarding the application. Any decision of the Receiving Section at that stage would therefore be negative.

In a communication dated 20 February 1995, 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 indicated in respect of the pending earlier European patent application. Reference was made to the opinion of the Enlarged Board of Appeal G 10/92 (OJ EPO 1994, 633).

III. On 19 April 1995 the applicant 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) the filing of a divisional application was possible up to the decision to grant a European patent. It might be correct that, according to the latest opinion of the Enlarged Board of Appeal G 10/92, the filing of a divisional application is now only possible up to the approval according to Rule 51(4) EPC. However, since the headnote of G 10/92 was published after the filing of the divisional application, the applicant was entitled to expect that the filed documents would be treated by the EPO as a divisional application on the basis of the earlier valid decision J 11/91.

IV. On 17 May 1995, the Receiving Section issued a decision refusing to allow the application as a divisional application of the patent 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 (cf. also Guidelines for Examination in the EPO, A-IV. 1.1.2). In the present case, the divisional application was filed after approval had been given to the text of the parent application pursuant to Rule 51(4) EPC. After this point the Office had no discretion to allow the filing of a divisional application.
- (2) Furthermore, the Receiving Section did not share the applicant's opinion that the EPO should follow the legal interpretation enunciated in J 11/91. In view of the divergence existing between the decisions J 11/91 and T 92/85 (OJ EPO 1986, 352),

the President of the EPO had referred the point of law to the Enlarged Board of Appeal. In G 10/92 of 28 April 1994 (OJ EPO 1994, 633), the Enlarged Board of Appeal confirmed that, under the amended version of Rule 25 EPC in force since 1 October 1988, an applicant may only file a divisional application on the pending earlier European patent application up to the approval of the text thereof in accordance with Rule 51(4)EPC.

V. On 18 July 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 18 September 1995.

VI. The appellant submitted that the present case was closely related to the legal situation which had emerged during the proceedings relating to the parent application. The examination proceedings in the parent application had been completed by decision T ... of 3 August 1993, where, concerning the parent application, the Technical Board of Appeal refused to admit separate claims for Spain under the provisions of Article 167(2)(a) EPC. These claims had been filed after the approval of the text intended for grant pursuant to Rule 51(4) EPC. In the appellant's view, the Technical Board of Appeal acted against the clear earlier practice to allow late-filed separate claims for Contracting States. Later, on referral of the parallel case T 830/91 (OJ EPO 1994, 728), the Enlarged Board of Appeal decided 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 (G 7/93, OJ EPO 1994, 775). The Enlarged Board gave a clear example of an exceptional case where it may be appropriate to allow amendment at a late stage. This is when the applicant requests a separate set of claims to

be substituted in respect of designated states which have made reservations under Article 167(2)(a) EPC. Therefore, the appellant was right to file amendments by providing a new set of claims for Spain. Thus, the Technical Board acted against the principle of protection of legitimate expectation, also because it reached a decision while being aware of the referral of an identical legal question to the Enlarged Board of Appeal.

Since the examination proceedings in the parent application had been completed by decision T ... , J 11/91 (headnote published in OJ EPO 1-2/1993) opened the procedural possibility for a European divisional application to be validly filed after the approval in accordance with Rule 51(4) EPC. In reliance on the decision of the Legal Board of Appeal, a divisional application was filed on 15 October 1993. In the appellant's opinion, it could be expected, on the basis of the protection of legitimate expectations that the European patent application should be treated as a divisional application.

VII. In a communication dated 18 June 1996 accompanying a summons to oral proceedings, the Legal Board of Appeal drew the appellant's attention to decision J 27/94 (OJ EPO 1995, 831) in which it was decided 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 J 11/91 until opinion G 10/92 was made available to the public.

VIII. The appellant requested that the present application be treated as a divisional application of application No. 87 In the alternative, the appellant requested that the question whether it was possible, within the time period starting with the publication of

the headnote of the decision J 11/91 and ending with the publication of the headnote of the opinion G 10/92, to validly file a divisional application after the approval of the text under Rule 51(4) EPC be referred to the Enlarged Board of Appeal. The original auxiliary request for oral proceedings was withdrawn on 25 October 1996.

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 an applicant may only file a divisional application on the pending earlier application up to the approval of the text notified in accordance with 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 November 1990. It is submitted that the filing of a divisional application at this stage of the proceedings was possible until opinion G 10/92 of the Enlarged Board of Appeal was made available to the public.

2. The Legal Board of Appeal was already faced with this question in decision J 27/94 (OJ EPO 1995, 831) 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 (OJ EPO 1994, 28) until opinion G 10/92 (OJ EPO

1994, 633) was made available to the public. The appellant's argumentation based on the principle of legitimate expectations against the decision of the first instance gives no reason to deviate from decision J 27/94.

2.1 First, in the present case at the date of approval under Rule 51(4) EPC decision J 11/91 had not yet been taken. Therefore, it cannot be said that the appellant believed in the correctness of decision J 11/91 at a time when they were still in a position to validly file a divisional application on the earlier application in accordance with Rule 25(1) EPC and the opportunity to file the application in due time was not missed in consequence of any information received from the EPO. Rather the applicant saw an opportunity, relying on decision J 11/91, to file a separate application for subject-matter which decision T 830/91 had already finally refused to admit by way of amendment in the parent application. The principle of good faith governing relations between the EPO and applicants does not require the EPO to provide such an opportunity.

2.2 Moreover, the headnote to decision J 11/91 was published in the same issue of OJ EPO as the referral of the point of law in question to the Enlarged Board of Appeal. Taking this information into account, there was no reason to believe that the first instance would follow J 11/91 in future cases. On the contrary, the Guidelines for Examination in the EPO, A-IV, 1.1.2, remained unchanged, which fact gave reason to expect that the practice based on them would not be changed either. For the rest, reference is made to the reasons of decision J 27/94. Therefore, Rule 25 EPC, in the interpretation given by the Enlarged Board of Appeal, is applicable to this case.

3. The *ratio decidendi* of decision T ... has become *res judicata*. This principle which is generally accepted in the Contracting States prevents a matter being considered a second time in judicial proceedings after it has been judicially determined in a final manner by a court of competent jurisdiction where the issues of fact are the same and the parties as well as their legal capacities are the same (see in detail J 3/95 and T 167/93, with further references, both to be published in OJ EPO).

In the present case, the finding that the late-filed separate claims for Spain under the provisions of Article 167(2)(a) EPC were not admitted was made by a court of competent and final jurisdiction. The fact that another Technical Board referred this question to the Enlarged Board in a parallel case and that the Enlarged Board took a different legal position in that case is not an appropriate reason to examine in these proceedings before the Legal Board of Appeal the appellant's allegation that its rights were violated by decision T ... of the Technical Board of Appeal.

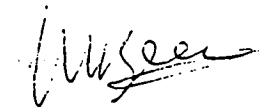
4. The present findings of this Board are in conformity with the case law of the Boards of Appeal. Therefore, it is not necessary, in order to ensure uniform application of the law, to refer any question to the Enlarged Board of Appeal. Nor does the present case raise an important point of law which would justify a referral to the Enlarged Board of Appeal. For this reason, the appellant's request to refer the issue in suit to the Enlarged Board of Appeal cannot be allowed.

Order

For these reasons it is decided that:

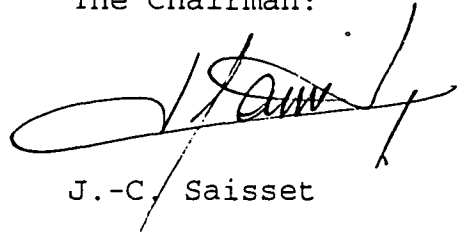
1. The request for referral of a question to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset