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D E C I S I O N
of 6 May 1998

Case Number: J 0021/96 - 3.1.1

Application Number: -

Publication Number: -

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Language of the proceedings: EN

Title of invention:

-

Applicant:

N.N.

Opponent:

-

Headword:

Restitutio/N.N.

Relevant legal provisions:

EPC Art. 122(1)

EPC R. 25(1), 51(4)

Keyword:

"The time restriction for filing a divisional application (Rule 25(1) EPC) is not a time limit within the meaning of Article 122(1) EPC"

Decisions cited:

J 0016/91, G 0010/92

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: J 0021/96 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 May 1998

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 16 July 1996 refusing re-establishment of rights as inadmissible (European divisional application No. 95 ...).

Composition of the Board:

Chairman: J.-C. Saisset
Members: J. C. M. De Preter
B. J. Schachenmann

Summary of Facts and Submissions

I. The appellants filed European patent application No. 92 ... on 29 October 1992. Following a communication of the Examining Division pursuant to Article 96(2) and Rule 51(2) EPC of 22 May 1995 the appellants restricted their application to claims 6 and 11 by letter of 22 September 1995 stating that claims 1 to 3, 4, 5 and 10 were cancelled and that claims 7 to 9 and 12 to 14 were being filed as a divisional application.

A communication pursuant to Rule 51(4) EPC was sent out by the Examining Division on 26 October 1995. In response thereto the appellants approved of the submitted text by letter of 6 November 1995.

As the fees for grant and printing were not paid in due time and as the translation of the claims was not filed in due time either a communication pursuant to Rule 69(1) EPC was sent out on 28 March 1996 stating that the European patent application was deemed to be withdrawn under Rule 51(8) EPC.

II. Meanwhile, as announced by above mentioned letter of 22 September 1995, the appellants filed divisional application No. 95 ... on 23 September 1995 but withdrew it by letter of 14 November 1995.

III. After a new divisional application No. 95 ... was filed by the appellants on 22 December 1995, the Receiving Section sent a communication under Rule 69(1) EPC on 12 March 1996 stating that the application would not be

treated as a European divisional application because it had been filed after approval had been indicated in respect of the pending earlier European patent application in accordance with Rule 51(4) EPC (Rule 25(1) EPC).

IV. In response to the noting of loss of rights the appellants filed a request for re-establishment of rights by letter of 2 May 1996 received on 6 May 1996 in which the representatives of the appellants explained that an erroneous instruction to cancel claims 1 to 3, 4, 5 and 10 had been received on 20 September 1995 and that two days after the approval of the earlier application had been sent to the EPO on 6 November 1995 they received the instruction to file a divisional application with claims 1 to 3 and 10 which was filed on 22 December 1995.

V. In its decision of 16 July 1996 the Receiving Section refused the request for re-establishment of rights as inadmissible so that the application would not be treated as a European divisional application. In the reasons for the decision the Receiving Section referred to Decision J 16/91 (OJ EPO 1994, 28) according to which for re-establishment to be possible there must be a failure to meet a time limit vis-à-vis the EPO i.e. a time limit given specifically to the applicant pursuant to the EPC or by an officer of the EPO within which he must accomplish a certain act. However in this case the last time limit given to the applicant by the EPO was in the communication pursuant to Rule 51(4) EPC and was observed.

As for Rule 25(1) EPC the Receiving Section referred to the Opinion of the Enlarged Board G 10/92 (OJ EPO 1994, 633).

VI. The appellants filed a notice of appeal against this decision and a written statement setting out the grounds of appeal on 16 August 1996. The appropriate fee was paid on the same date. They considered that their request for re-establishment of rights had been refused on the reasons that the application had been filed after approval had been given in respect of the pending earlier European application in accordance with Rule 51(4) EPC and called this a purely formal point of view which did not take into account the ground and reasons filed with the request for re-establishment of rights.

As another application out of the present case (divisional application No. 95 ...) had been filed on 23 September 1995 i.e. before the date of the communication under Rule 51(4) EPC of the earlier application, it was submitted to take the date of that application as starting point in considering the reasons set forth in the request for re-establishment of rights. If the singular error in filing a wrong part of the parent application as a divisional application had not happened, the divisional application would have been filed in time.

VII. In their response to the Board's communication of 18 August 1997 in which the attention of the appellants was drawn to the fact that the request for re-establishment has actually been refused on the grounds of inadmissibility, the appellants argued that in its opinion G 10/92 the Enlarged Board of Appeal had shifted the term for filing a divisional application from a "time limit" within the meaning of Article 122 EPC to the date of sending out the approval of the text of the earlier application and that the reason for this was at least partly "that the filing of a divisional application necessarily affects the version as filed" and that it would be "desirable that, from a certain

point in time onwards, the EPO can rely on the proposed text for grant". However, in the present case the proposed text had not been amended and the earlier application had been abandoned.

Reasons for the Decision

1. The appeal is admissible.

2. Having received the communication of 12 March 1996 pursuant to Rule 69(1) EPC noting the loss of rights resulting from the late filing of divisional application No. 95 ... the appellants did not consider that the finding of the EPO was inaccurate (Rule 69(2) EPC) but filed a request for re-establishment of rights pursuant to Article 122 EPC. This meant that the appellants admitted the loss of rights as noted so that the Receiving Section had only to decide on the request for re-establishment of rights. However, for this to be possible, there must be a failure to meet a time limit vis-à-vis the EPO (Article 122(1) EPC) within which a certain act has to be accomplished. The last time limit given to the appellants in this case by the EPO was in the communication pursuant to Rule 51(4) EPC requesting approval of the text in which the Examining Division intended to grant the patent by a certain date. This time limit was observed by the appellant, and the required approval given (cf. J 16/91). As for Rule 25(1) EPC, it does not lay down a time limit within the meaning of Article 122(1) EPC. It merely identifies a point in the grant procedure after which a divisional application may no longer be filed. This point is decided upon by the applicant when he gives

his approval pursuant to Rule 51(4) EPC. Therefore, in the absence of a time limit to be observed, re-establishment of right is not possible (see also decision J 7/90, OJ EPO 1993, 133; point 3 of the reasons).

Thus the Receiving Section rightly decided that the request for re-establishment of rights was inadmissible. This was the sole reason of the refusal of this request. The consequence thereof was that the Receiving Section could only state in point 2 of its decision what it had already noted in its communication pursuant to Rule 69(1) EPC i.e. that the European patent application No. 95 ... would not be treated as a European divisional application.

3. The appellants' comment to this point 2 of the decision under appeal is irrelevant as, as already mentioned, they did not contest the findings of the EPO in its communication of 12 March 1996 within the period provided for by Rule 69(2) EPC.

For the sake of completeness it has to be noted that in the present case divisional application No. 95 ... - which was filed with other claims than those of divisional application No. 95 ... - together with its filing date was the sole application in suit to be considered by the Receiving Section with regard to the requirements of Rule 25(1) EPC when it sent its communication of 12 March 1996. Furthermore, as stated in Opinion G 10/92 under paragraph 5 the mere fact that the approval of the proposed text in accordance with Rule 51(4) EPC can be withdrawn does not mean that the applicant who withdraws approval then acquires the

right to file a divisional application. Therefore, in analogy, the fact that the earlier application No. 92 ... was abandoned after the approval of the proposed text does not alter the fact that it was once given.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

M. Beer

J.-C. Saisset