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D E C I S I O N  
of 3 September 1997

Case Number: J 0029/96 - 3.1.1

Application Number: 95119959.5

Publication Number: -

IPC: C12N 15/62

Language of the proceedings: EN

Title of invention:

Tumor necrosis factor-alpha and -beta receptors

Applicant:

N.N.

Opponent:

-

Headword:

Divisional/ N.N.

Relevant legal provisions:

EPC Art. 76(3)

EPC R. 25

Keyword:

"Withdrawal of consent to text of parent application solely for the purpose of filing divisional - not effective"

Decisions cited:

G 0010/92, T 0186/84

Headnote:

Where consent has been given to the text of an earlier application pursuant to Rule 54(1) EPC, then withdrawal of this consent for the sole purpose of filing a divisional is not effective to re-open the period in which a divisional application can be filed.



Case Number: J 0029/96 - 3.1.1

D E C I S I O N  
of the Legal Board of Appeal 3.1.1  
of 3 September 1997

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 29 May 1996 deciding that application No. 95 119 959.5 will not be treated as a divisional application.

Composition of the Board:

Chairman: J.-C. Saisset  
Members: S. C. Perryman  
B. J. Schachenmann

## Summary of Facts and Submissions

- I. Application 95 119 959.5 was filed by the Appellant on 18 December 1995, purportedly as a divisional of application 903 098 754 of 10 September 1990 ("the earlier application").
- II. A notice under Rule 51(4) EPC on EPO Form 2004 dated 16 February 1995 had been sent the Appellant informing it of the text on which the Examining Division intended to grant a patent on the earlier application, and the appellant had indicated its approval of this text by letter.
- III. By letter of 14 December 1995 to the European Patent Office on the earlier application the appellant wrote:
- "We write to withdraw our approval of the text specified in the Official Communication under Rule 51(4) EPC dated 16 February 1995, in order that we can file a divisional application. In the event that the filing of this divisional application is not allowed, we request our previous approval (dated 31 May 1995) of the text specified in the Official Communication under Rule 51(4) EPC dated February 1995 stands."
- By a communication dated 27 December 1995 on the earlier application the appellant was told that in this case the filing of a divisional application was not allowed any more.
- IV. By a communication dated 25 March 1996 noting a loss of rights pursuant to Rule 69(1) EPC, the appellant was informed that the application in suit 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 in accordance with Rule 51(4) EPC (Rule 25(1)EPC). The Opinion of the Enlarged Board of Appeal G 10/92, was referred to. The appellant asked for a formal decision. This issued on 29 May 1996 stating that it had been decided that the application will not be treated as a divisional application as according to Rule 25(1) EPC a divisional can be filed up to the approval of the text in accordance with Rule 51(4) EPC in the parent application. This was confirmed by the Enlarged Board of Appeal in the opinion G 10/92.

V. The Appellant appealed by letter dated 16 July 1996, paying the appeal fee and submitting Grounds of Appeal received 24 September 1996. The Board issued a summons to oral proceedings dated 9 June 1997 accompanied by a communication. The appellant made further submissions in letters dated 1 July 1997 and 4 August 1997. In the latter letter an additional request was made that the following questions be referred to the Enlarged Board:

- "1. Are the remarks in Paragraph 5 of the Decision of the Enlarged Board in G 10/92 as to subsequent withdrawal of approval by the applicant under Rule 51(4) to be regarded as ratio decidendi (and consequently binding in future cases) or merely obiter dicta (and consequentially not binding)?
2. If the remarks are merely obiter dicta, then under what circumstances may an applicant withdraw an existing approval given under Rule 51(4) in order to file a divisional application ?"

VI. Oral proceedings took place on 3 September 1997. On the issues remaining relevant at the oral proceedings, the arguments submitted in writing and at the oral proceedings were essentially that:

- The matter of the last date for a divisional is a matter of very great importance to applicants. The appellant, a US corporation, were under the impression that as under US patent law a divisional could be filed until the date of grant of the parent patent. By giving consent to the text for grant of the earlier application the appellant did therefore not intend to preclude the possibility of filing a divisional.
  
- The effect of withdrawal of approval was not covered explicitly by the Convention or the Rules. There was no prohibition as such on withdrawal of approval. This was in contrast to the prohibition on withdrawing the European patent application provided by Rule 14 EPC where a third party has shown that he has commenced proceedings concerning entitlement. Only a positive prohibition against withdrawal of approval should prevent approval being withdrawn and there was none. Accordingly such withdrawal should be effective, and the position would be as if no approval had been given. Accordingly on withdrawal of the approval on 14 December 1995, the appellant was free to file a divisional.
  
- Such a withdrawal would admittedly be a procedural device, but decision T 184/84 (OJ. EPO 1986, 73), relating to a request by a proprietor that his patent be revoked, showed that such procedural devices were acceptable and performed a useful function.
  
- The sentence in point 5 of opinion G 10/92 "The mere fact that approval can be withdrawn does not however mean that the applicant who withdraws approval then acquires the right to file a divisional application" was not good law, the

topic had only been partially considered by the Enlarged Board. Before deciding against the present appellant the matter should be referred to the Enlarged Board.

- VII. The Appellant requested that the decision under appeal be set aside and the European patent application No. 95 119 959.5 be treated as a divisional application; and as an ancillary request to refer to the Enlarged Board of Appeal the questions set out in the letter dated 4 August 1997 (see point V, supra).

### Reasons for the Decision

1. The appeal is admissible.
2. In the answer in Opinion G 10/92 (OJ EPO 1994, 633) to the question put, the Enlarged Board said:

"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 in accordance with Rule 51(4) EPC."

This confirmed (see point 4 of Opinion) that Rule 25 EPC was compatible with Article 76(3) EPC, and that the setting in this rule of a deadline could not be reproached on legal grounds. In point 5 the Enlarged Board went on to say:

"The point made in decision J 11/91 and J 16/91 that the approval of the text of an application pursuant to Rule 51(4) EPC is not an irreversible event cannot be faulted from the legal point of view. Giving approval is a procedural statement and - like any other

procedural statement - may be withdrawn, provided the law allows this. The mere fact that approval can be withdrawn does not however mean that the applicant who withdraws approval then acquires the right to file a divisional application. Nor can the applicant, by withdrawing the approval, alter the fact that it was once given."

3. This Board wholly adopts the view there stated. The withdrawal of consent to the text of the earlier application solely, as in this case, for the purpose of allowing a divisional to be filed outside the deadline laid down by Rule 25 EPC, is not effective for this purpose. Whereas there may be occasions when a procedural device is legitimate, here to permit the withdrawal to re-open the period for filing a divisional would be contrary to the explicit meaning and purpose of Rule 25 EPC, and so cannot be permitted.

4. European patent law and US patent law differ in numerous respects. That practice as regards the last day for filing a divisional is one of these differences, is not a reason for interpreting Rule 25 EPC differently to its explicit wording, nor is it a reason for allowing Rule 25 EPC to be circumvented by a procedural device.

5. *Questions to Enlarged Board*

5.1 Article 16 of the Rules of Procedure of The Boards of Appeal states that "Should a Board consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal." This article demonstrates that there is no opinion or decision of the Enlarged Board which is

strictly binding on a Board of Appeal. A Board of Appeal would always be free to refer the question anew to the Enlarged Board. Question 1 that this Board has been asked to refer to the Enlarged Board concerning the binding nature of the remarks in point 5 of the opinion G 10/92 is answered by this Article 16.

- 5.2 This Board would thus be free to ask the second question relating to the circumstances under which an applicant may withdraw an existing approval given under Rule 51(4) EPC in order to file a divisional application. However, fully in line with Opinion G 10/92, in this Board's judgement the withdrawal of consent to the text of the earlier application for the sole purpose of filing a divisional is not effective. That is the only question which arises in this case, and the Board will not speculate on conceivable situations, not arising in the present case, where withdrawal might be effective. In the Board's judgement therefore there is no need for any reference of any question to the Enlarged Board of Appeal.



**Order**

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

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

The Registrar:

The Chairman:

M. Beer

J.-C. Saisset