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D E C I S I O N
of 9 June 1999

Case Number: J 0009/97 - 3.1.1

Application Number: 92118031.1

Publication Number: -

IPC: G08/B 13/24

Language of the proceedings: EN

Title of invention:
Magnetic devices

Patentee:
Esselte Meto International GmbH

Opponent:
-

Headword:
Divisional/ESSELTE METO

Relevant legal provisions:
Paris Convention Art. 4(G)(2)
EPC Art. 76(3), 91(3), 112(3), 116(2)
EPC R. 25(1), 41(1), 51(4), 69(1)(2)

Keyword:
"Application filed on pending application after Rule 51(4) EPC approval had been given not accepted as divisional application"
"Enlarged Board of Appeal opinion to be applied - yes"
"Referral to Enlarged Board of Appeal - no"

Decisions cited:
G 0010/92, G 0005/93, G 0009/93, J 0011/90, J 0011/91,
J 0016/91, J 0003/92, J 0027/94, J 0014/95, J 0015/95,
J 0016/95, J 0017/95, J 0024/95, J 0025/95, J 0030/95,
J 0029/96, T 0092/85, T 0001/92

Catchword:
-



Case Number: J 0009/97 - 3.1.1

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D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 June 1999

Appellant: Esselte Meto International GmbH
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Westerwaldstrasse 3-13
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 15 November 1996 on European patent application No. 92 118 031.1 refusing the requests for oral proceedings and to set aside the communication of 28 June 1994 and deciding that the application will not be treated as a divisional application.

Composition of the Board:

Chairman: J.-C. Saisset
Members: A. C. G. Lindqvist
S. C. Perryman

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Summary of Facts and Submissions

- I. European patent application No. 92 118 031.1 was filed on 21 October 1992 as a divisional application on European patent application No. 88 305 134.4. At that time the applicant had already given its unconditional approval, received on 5 October 1992, to the text of the earlier application pursuant to Rule 51(4) EPC.

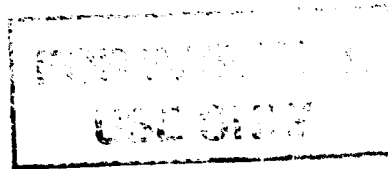
- II. In a communication dated 16 December 1992, the applicant was informed by the Receiving Section of the European Patent Office that the President of the Office had referred a question to the Enlarged Board of Appeal on the point of law "until when may an applicant file a divisional application on a pending earlier application" (case G 10/92, see OJ EPO 1993, 6). The applicant was further informed that no decision would be taken by the Receiving Section until the Enlarged Board of Appeal had delivered its opinion.

- III. In a further communication of 28 June 1994 the applicant was informed that the Enlarged Board of Appeal had issued its opinion in case G 10/92 that an applicant may only file a divisional application on a pending earlier application up to the approval of the text thereof in accordance with Rule 51(4) EPC. On the same day the applicant was sent EPO form 1044, Noting of Loss of rights pursuant to Rule 69(1) EPC.

- IV. With letter of 29 July 1994 the appellant requested a decision in accordance with Rule 69(2) EPC. In the letter it was mentioned that the applicant had spoken with a formalities officer of DG2 prior to filing the divisional application and that the applicant had been told that it was not possible to withdraw the approval pursuant to Rule 51(4) EPC concerning the earlier application, but that it was possible to file a

divisional application after the approval in view of recent decisions J 11/91 and J 16/91. In a further letter the applicant requested oral proceedings before the Receiving Section.

- V. In the decision pursuant to Rule 69(2) EPC issued on 15 November 1996, the request for oral proceedings and the request to set aside the communication of 28 June 1994 noting the loss of rights were both refused and it had been decided that the application would not be treated as a divisional application.
- VI. On 13 January 1997, the appellant filed a notice of appeal against this decision, having paid the appeal fee on 9 January 1997. The statement of grounds was filed on 19 March 1997. The Board issued a summons to oral proceedings dated 29 January 1999, accompanied by a communication.
- VII. Oral proceedings took place on 9 June 1999. The appellant requested as main request that the communication under Rule 69(1) EPC of 28 June 1994 be set aside and that the present application be accorded divisional status, as first auxiliary request that the matter be remitted to the Receiving Section with the order to hold oral proceedings, and as second auxiliary request that the following questions be referred to the Enlarged Board of Appeal.
- (i) Is it permissible for the various departments of the European Patent Office to apply the Case Law of the Boards of Appeal retrospectively? In particular, is it permissible for a department of first instance to use case law developed subsequent to the time of a given action to interpret the validity or otherwise of that action?



- (ii) Article 4(G)(2) of the Paris Convention (Stockholm Text) states that:

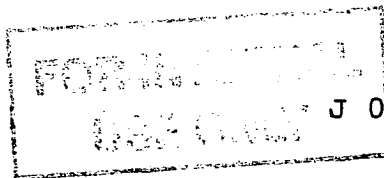
"The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any" (emphasis added).

Given that a period of time often in excess of six months, and occasionally in excess of one year, may elapse between normal expiry of the term under Rule 51(4) and the date of grant, why is it that an applicant is denied the right to file a divisional application after initial approval of the text of the parent application, but well before the date of grant?

- (iii) What is to be understood by the expression "published" when applied to decisions of the Boards of Appeal? In particular, does a decision published in the Official Journal of the EPO carry more weight than one which is simply made available to the public, and if so, how much more weight does such a decision carry?"

VIII. The arguments submitted in writing and at the oral proceedings were essentially the following:

- The ruling of G 10/92, that an applicant may only file a divisional application on an earlier pending European patent application up to the approval in accordance with Rule 51(4) EPC, is irrelevant to the present application. The application was filed before the question of the time limit for divisional applications was



referred to the Enlarged Board of Appeal. When the Receiving Section supported its decision concerning the patent application now at issue on the Enlarged Board of Appeal decision, it made an improper retrospective use of the Board's decision. As the law stood at the filing date of the application, decisions J 11/91 and J 16/91 had unambiguously set out that the last date for filing a divisional application was on the date the decision to grant in respect of the parent application was posted to the applicant.

- The principles of protection of legitimate expectations and of good faith must be observed. On 21 October 1992, after approval of the text under Rule 51(4) EPC had been given, but before the end of the normal term for giving such approval, the appellant asked an EPO formalities officer whether it was possible to withdraw an approval of the text following the Rule 51(4) EPC communication so as to permit the filing of a divisional application. The reply was that a withdrawal was not possible but that some recent decisions held that a divisional application might still be filed after the approval had been given. Decisions J 11/91 and J 16/91 were sent to applicant as a confirmation. This advice was directly responsible for two things: the applicant did not seek to cancel the previous approval of the text under Rule 51(4) EPC, and the divisional application was filed.

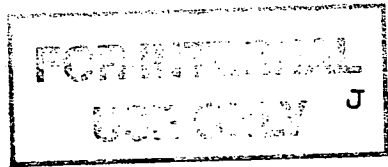
- The decision in T 1/92 states clearly that the applicants's approval of the text is only binding if it is still unambiguously present at the expiry of the Rule 51(4) EPO period, which in the present case was on 20 December 1992. Although approval

had already been given, the subsequent filing of a divisional application on 21 October 1992 was a clear indication that the approval was no longer unambiguous.

- Oral proceedings: Although the refusal by the Receiving Section to grant divisional status to the application may technically be only a loss of rights pursuant to Rule 69(1) EPC the direct consequence of this loss of rights will be the eventual refusal of the application. The applicant should therefore have been accorded the right to oral proceedings pursuant to Article 116(2) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. Before filing the present application as a divisional on its own earlier pending European application, the Appellant had approved the text in which the earlier pending application was to be granted. The obstacle to the present application being treated as a divisional is Rule 25(1) EPC in force since 1 October 1988, in the version as amended by the decision of the Administrative Council of 10 June 1988, providing that: "Up to the approval of the text, in accordance with Rule 51, paragraph 4, in which the European patent is to be granted, the applicant may file a divisional on the pending earlier European patent application."
3. The established interpretation of the meaning of this rule is that given in point 2 of the opinion of the Enlarged Board of Appeal in case G 10/92 (OJ EPO 1994, 663) namely that "... The wording of Rule 25 EPC is thus unequivocal on the point of law referred to the

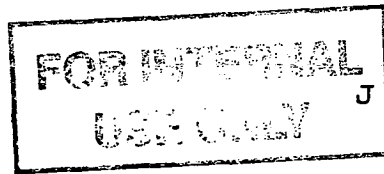


Board: the approval by the applicant of the text in which the patent is to be granted marks the point up to which a divisional application may be filed. A divisional application may not be filed after this date..". This interpretation has been accepted in legal board decisions J 27/94 (OJ EPO 1995, 831), and J 14/95, J 15/95, J 16/95, J 17/95, J 24/95, J 25/95) all of 20 August 1997, and J 30/95 of 6 June 1997. For the reasons given in G 10/92 and these other cases, the present board agrees that this is the correct interpretation of Rule 25 EPC, and that the making of this rule was intra vires the powers of the Administrative Council.

4. As to the Appellant's submission that the filing of the divisional application itself made the approval of the text of the earlier application ambiguous, and that therefore the approval should be regarded as no longer valid, or withdrawn, the approval marks a point in time after which no divisionals can be filed. If the approval was unambiguous at the time when made subsequent events are irrelevant, see Opinion G 10/92 (in particular point 5) and decision J 29/96 (OJ EPO 1998, 581).
5. The general rule is that a legal provision, here Rule 25 EPC, is to be applied by a tribunal, here this board, on the interpretation it considers correct, to all situations arising during the time the legal provision is in force. The main request of the Appellant must thus fail, unless some special exception derived from the principle of the protection of legitimate expectations exists from which the Appellant could benefit.
6. The appellant's argument that the opinion of the Enlarged Board of Appeal in case G 10/92 is irrelevant because the application now at issue preceded it does

not take account of the fact that laws and other statutes can be retroactive, affecting a legal situation which existed before the law was created. Similarly, the opinions of the Enlarged Board of Appeal are interpretations of the law as the law should always have been construed (G 9/93, OJ EPO 1994, 891 section 6.1) They are not in the true sense retroactive; they just explain authoritatively what had until then to a greater or lesser degree been uncertain. The decision normally takes effect immediately. An applicant therefore runs the risk that his own, and possibly the Boards' former interpretation of the law, is found to be wrong while the case is pending.

If, however, and as the now appealed decision states, there exists an established case law which has become part of a consistent practice, maybe published in the Guidelines for Examination in the European Patent Office, Legal advice from the EPO or Notices from the EPO, the public can legitimately expect the Office not to deviate from this practice. In some decisions by the Enlarged Board of Appeal special consideration is given to this. In G 9/93 (deciding that a European patent cannot be opposed by its own proprietor) it is stated (point 6.1) that as patent proprietors had for years been relying on a previous Enlarged Board of Appeal decision it would be inequitable to prevent them from continuing proceedings they had embarked on in good faith. The law as interpreted in G 9/93 should therefore not be applied on pending cases. - In G 5/93 (OJ EPO 1994, 447) the Enlarged Board of Appeal finds (point 2.3 and Order) that notwithstanding the Board's new interpretation of the law, re-establishment of rights is possible where it was applied for before the date on which a certain previous decision was made available to the public.



But in the situation of case G 10/92, the Enlarged Board did not overturn any existing constant practice, but rather confirmed the existing constant practice, exemplified in the 1992 Guidelines A-IV, 1.1.2 which simply paraphrased Rule 25 EPC. The Enlarged Board in case G 10/92 gave no indication that their interpretation should not apply for the whole time present Rule 25 EPC has been in force. Nor does this Board see the conditions of an exception in favour of the Appellant on this basis of an overturned constant practice as met.

The Appellant has sought to rely on the existence of decisions J 11/91 and J 16/91 ((OJ EPO 1994, 028) decided together on 5 August 1992), as well as cases J 11/90 and J 3/92 also decided in August 1992, in which it was concluded that Rule 25 EPC was in conflict with Article 76 EPC, and so was ultra vires the powers of the Administrative Council. However these cases brought about no constant practice favourable to the Appellant. Rather the conflict between the reasoning of these cases and earlier case T 92/85 (OJ EPO 1986, 352) caused the President of the European Patent Office on 28 October 1992, within months of the issuance of these decisions to refer a question of law for the opinion of the Enlarged Board of Appeal, which resulted in Opinion G 10/92 disapproving the view of the law taken in J 11/91 and J 16/91. Finally, the Receiving Section maintained its then constant practice of applying Rule 25 EPC as it stood.

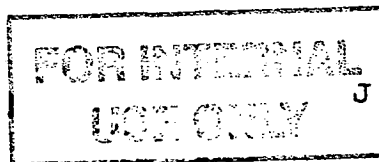
It should be noted that the mere existence of cases taking a view of the law favourable to the Appellant is irrelevant. Neither the European Patent Convention, nor the jurisprudence of the Boards of Appeal recognizes any doctrine of binding precedent. A decision in a case is binding only to the extent provided for in Articles 111(2) EPC, namely "If the Board of Appeal

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remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same. If the decision which was appealed emanated from the Receiving Section, the Examining Division shall be similarly bound by the ratio decidendi of the Board of Appeal", and Article 112(3) EPC, namely "The decision of the Enlarged Board of Appeal referred to in paragraph 1(a) shall be binding on the Board of Appeal in respect of the appeal in question." Only if a Board should consider it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier decision or opinion of the Enlarged Board of Appeal, would it be obliged by Article 16 of the Rules of Procedure of the Boards of Appeal to refer the question to the Enlarged Board of Appeal. Only the organs of the European Patent Office actually dealing with an application can give a binding decision, but at no level are they bound to apply the reasoning of any earlier board decision in another matter. Isolated decisions of the legal board or the technical boards cannot be relied on by applicants as establishing a constant practice.

7. The principles of protection of legitimate expectations and of good faith cited by the Appellant may involve situations where a party has had reasons to rely on the practice of the Office and should therefore not suffer the effects of an unexpected change which contravenes his legitimate expectations. This situation is not at hand here, as explained at point 6 above.

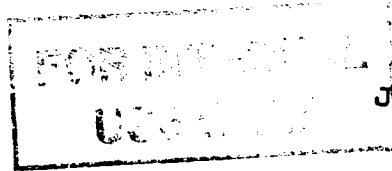
Another situation occurs when a party has suffered some loss as a result of having been given incorrect information by an EPO official, information which he had reason to rely and act on in good faith. Regardless of whether the Appellant had reason to accept the legal



position as described by the EPO official mentioned in the appeal, it must, however, be concluded that the element of loss as a consequence of this information is lacking. Both by following the information, and by neglecting it, the Appellant would have failed to achieve a divisional application. Had he withdrawn his approval of the text under Rule 51(4) EPC - as he could in fact have done - he would not have acquired the right to file a divisional application (see G 10/92, point 5). And by following the information that it was not too late to file the application he did not incur a loss, as this possibility did not exist (see G 10/92, conclusion).

8. As to the Appellant's submission that the filing of the divisional application made the approval of the text ambiguous, and that the approval should be regarded as no longer valid, or withdrawn, the following may be remarked. Even if one of those alternatives had been convincingly argued the Appellant would not have achieved the purpose of validly filing a divisional application. Opinion G 10/92 (see in particular point 5) makes it clear that although the procedural statement of giving approval of the text may be withdrawn the possibility of filing a divisional application is still no longer open once the approval has been given. See also J 29/96 (OJ 1998, 581).

9. In the decision under appeal it is correctly stated that the Receiving Section has to allow an applicant's request for oral proceedings only if it envisages refusing the European patent application; oral proceedings can also be held if the Receiving Section considers this to be expedient (Article 116(2) EPC). In the present case the Receiving Section did not consider refusing the application pursuant to Article 91(3) EPC, that refers to the exhaustive enumeration of deficiencies made earlier in the Article which, if not

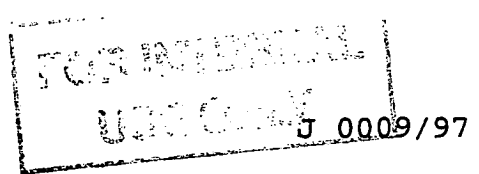


corrected in accordance with Rule 41(1) EPC, shall lead to the refusal of the application. Instead the Receiving Section was concerned with deciding whether the application should be treated as a divisional application or not. When opinion G 10/92 had been issued, the Receiving Section notified the Applicant of its loss of rights pursuant to Rule 69(1) EPC in consequence of having filed the application after approval had been given of the text of the earlier application. In this situation the applicant had no absolute right to an oral hearing. It may also be noted that the applicant had been given ample opportunity to argue his case in writing and that an oral hearing cannot have been expedient.

10. *Questions to the Enlarged Board of Appeal*

10.1 The answers to the questions suggested for reference (see VII) in so far as the questions are relevant at all are clear, and no reference is needed. A reference of the first question is irrelevant as indicated in point 5 above, as it is the general rule that legislative provisions are to be applied at all times on the interpretation adopted by the tribunal giving the ruling at the time of giving the ruling, on the view that this is what the law always meant, subject only to the above discussed exceptions relating to an overturned constant practice or to a mistake induced by misinformation.

10.2 The second question suggested for reference ignores the fact that the Paris Convention does not apply as such to the European Patent Office. Instead the matter of Article 4(G)(2) is governed by Article 76 EPC. Further the suggested question fails to cite the second sentence of Article 4(G)(2) reading "Each country of the Union shall have the right to determine the conditions under which such division shall be



authorized." The equivalent in the European Patent Convention is Article 76(3) EPC reading "The procedure to be followed in carrying out the provisions of paragraph 1, the special conditions to be complied with by a divisional application and the time limit for paying the filing, search and designation fees are laid down in the Implementing Regulations." Opinion G 10/92, in particular in point 10 sets out detailed reasons why Rule 25 EPC is a valid exercise of the powers given under Article 76(3) EPC and why it is appropriate to deny the applicant an opportunity to file a divisional after the text of the earlier application has been approved. The Board agrees with this reasoning and sees no grounds for referring this second question to the Enlarged Board, as the answer is already clear.

- 10.3 The third set of suggested questions is not relevant for anything to be decided in this appeal. The conclusions reached by this Board depend on the view of Rule 25 EPC adopted by it, following opinion G 10/92, and the fact that there has never been any constant practice to allow divisionals to be filed after approval of the text of the earlier application.

- 10.4 There is thus no need for any questions to be referred to the Enlarged Board of Appeal, and the appeal must be dismissed.

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Order

For these reasons it is decided that:

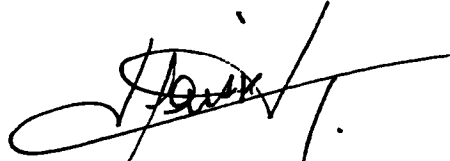
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset