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D E C I S I O N
of 14 June 1999

Case Number: J 0029/97 - 3.1.1

Application Number: 96117250.9

Publication Number: 0756957

IPC: B60J 10/02

Language of the proceedings: EN

Title of invention:
A windshield molding for vehicles

Applicant:
TOKAI KOGYO KABUSHIKI KAISHA

Opponent:
-

Headword:
Divisional/TOKAI KOGYO

Relevant legal provisions:
EPC Art. 67(4), 76(1)
EPC R. 25

Keyword:
"Designation of states in divisional application - void"
"Designation in parent withdrawn before filing divisional"
"Referral to Enlarged Board of Appeal - no"

Decisions cited:
J 0015/85, J 0022/95, J 0019/96,

Catchword:
Designation of states in a divisional application is void where the designation of these states was withdrawn in the parent application before the filing of the divisional.



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Boards of Appeal

Chambres de recours

Case Number: J 0029/97 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 14 June 1999

Appellant:

TOKAI KOGYO KABUSHIKI KAISHA
1, Nagane-cho 4-chome
Ohbu-shi
Aichi 474 (JP)

Representative:

Haley, Stephen
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal:

Decision of the Receiving Section of the European Patent Office dated 27 May 1997, that the designation of the Contracting States Germany, France, Great Britain and Italy is void.

Composition of the Board:

Chairman: J.-C. Saisset
Members: S. C. Perryman
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. This appeal lies against the decision of the Receiving Section that in the divisional application the subject of this appeal the designation of the Contracting States Germany, France, Great Britain and Italy is void.
- II. On application 92 907339.3 from which the application the subject of this appeal is a divisional, the designation fees for DE, FR, ES, GB, IT, NL and SE were paid. However in the letter of the representative of 24 January 1996 on that parent application it was stated:
- "We herewith withdraw the designations of the states of DE, FR, GB and IT for this application."
- III. The present divisional application was filed on 28 October 1996 designating the seven states DE, FR, ES, GB, IT, NL and SE, and the designation fees were paid.
- IV. Following communications from Receiving Section and responses from the appellants, the decision under appeal issued. The grounds for considering the designations void were *inter alia*:
- According to Article 76(2) EPC, the divisional application shall not designate states which were not designated in the parent application. The interpretation given by the EPO to this provision was that the designated states must still be effectively designated in the parent application when the divisional is filed.

- Germany, France, Great Britain and Italy had been designated in the parent application and the designation fees had been paid, but the designations were withdrawn in the parent application before the date of filing of the divisional.

 - The withdrawal had been confirmed by the primary examiner in his communication pursuant to Article 96(2) and Rule 51(2) EPC. The withdrawal had been published in the European patent register and the possibility of obtaining patent protection in these States had been surrendered and could not be revived by filing a divisional application at a later date.

 - The practice of the EPO that the designated States must still be effectively designated in the parent application when the divisional is filed thereon was confirmed by textbook commentaries, namely the "Münchener Gemeinschaftskommentar" on Article 76 EPC and the "Europäisches Patentübereinkommen" "Comments" by Singer, A-iv 1.3.4, Article 76, page 239.
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- V. The appellants on 23 June 1997 filed a notice of appeal and paid the appeal fee, filed Grounds of Appeal on 22 July 1997, requesting that the decision of 27 May 1997 to reject the appellants' request for the designation of the states DE, FR, GB and IT be overturned.
- VI. In a communication, the Board drew the appellant's attention to decision J 22/95 (in particular points 2.6 and 6) and to the Referral of 5 October 1998 by the President of the EPO of a point of law to Enlarged Board of Appeal, now pending as case G 4/98 before the Enlarged Board.

VII. In a response the appellants asked that if the legal board was not prepared to allow the appeal directly some questions should be referred to the Enlarged Board of Appeal.

VIII. The written and oral submissions of the appellant during the proceedings were essentially as follows:

- On the wording of Article 76 EPC the appellant was entitled in the divisional application to designate all states that had been originally designated in the parent application. Article 76(2) simply referred to designations in the originally filed application, which "were not designated in the earlier application." It did not refer to this designation being at the time of filing of the divisional application, and particularly having regard to the French text, referring to "demande initiale", it was the original designations and not the designations at the time of filing of the divisional which governed what states could be designated in the divisional. If the Board did not accept this interpretation of Article 76(2) EPC, the question of its correct interpretation should be referred to the Enlarged Board of Appeal.
- Article 67(4) EPC was not relevant to what a divisional could be filed for, as it related only to rights conferred on publication in relation to Article 64 EPC.
- There were clear distinctions between the circumstances of the present case and those in J 22/95. Here there was no doubt that the four states whose designation had been refused in the divisional had been originally designated in the parent.

- It was totally incorrect to state that the designation of these states was considered never to have existed as a result of the withdrawal in the parent. It was clear, for example that these designations would be effective in respect of the parent application forming part of the prior art with respect of Article 54(3) and 54(4).

- For the sake of equity the interpretation of Article 76(2) should be such that the designations allowable in the divisional application should be those that were designated in the originally filed parent application, not those of the parent application at a later date. The designations were withdrawn on the parent application at the insistence of the substantive examiner and in order to satisfy the requirements of Articles 54(2) and 54(3) EPC. The requirement that the states be withdrawn was believed to be so that so-called double patenting should not occur for the subject matter of the claims on file. Withdrawal of such designations affecting the applicant's right to file divisional applications for subject matter not covered by the claims of the parent application, the interpretation of the Receiving Section, clearly prejudiced the applicant's right to be able to obtain protection for published subject matter contravening the principles of Article 82 EPC.

- Third parties would not be adversely affected. A third party monitoring the status of the case would appreciate that only double patenting in relation to the claims then on file was to be avoided by the withdrawal of the designations, and this third party would note that protection of subject matter not covered by the claims would still be available to the applicant up until

approval of the Rule 51(4) text. Allowing a divisional application to be filed covering subject matter not covered by the parent claims and designating those withdrawn states, would not therefore adversely affect a third party.

- Furthermore any inspection of the register by a third party at the time of publication of the parent of this application would have provided adequate indication of the states that had been validly designated, and the designation fees that had been paid. An inspection of the published document would have provided adequate indication of the subject matter that was capable of protection in the parent application. This would not have been the case in the application which was the subject matter of decision J 22/95.
- The withdrawal of the designations on the parent application had been at the insistence of the Examining Division, who, it is believed, would not have accepted any withdrawal other than one which was unconditional and unlimited. To treat this withdrawal of designations in the parent as preventing designation of these states in the divisional would have extremely harsh consequences for the applicant, particularly harsh as the applicant was only acting on the comments made by the Examining Division.
- The withdrawal of the designations in the parent should be considered analogous to the removal of subject matter from an application during examination and the right to subsequently file a divisional application. The reasoning refusing the designations in the divisional would be in conflict with the reasoning in numerous Board of Appeal cases on divisionals (which cases were not

individually identified). If the Board did not agree with this view, a question on this should be referred to the Enlarged Board of Appeal.

IX. Oral proceedings took place on 14 June 1999, at which the appellant asked:

- as main request that the decision under appeal be set aside and that the matter be remitted to the first instance with the order to continue prosecution on the basis that the States Germany, France, Great Britain and Italy were validly designated in the present divisional application, and
- as auxiliary request that the following questions be referred to the Enlarged Board of Appeal:
 - (1) Is the withdrawal of designated states during examination analogous to the removal of subject matter?
 - (2) If so, is it acceptable for the Examining Division to accept conditional withdrawal of a designation subject to the right to file a divisional application?
 - (3) If not, how should the wording of Article 76(2) EPC be interpreted in respect of designations on a parent at the date of filing of a divisional application?

Reasons for the Decision

1. The appeal is admissible.
2. By an unequivocal and unconditional statement the appellant withdrew the designations of the Contracting States Germany, France, Great Britain and Italy in the parent application by letter of 24 January 1996. This withdrawal was published in the European Patent register. Irrespective of what retroactive effective the withdrawal may or may not have had, the parent application at that stage no longer covered the states Germany, France, Great Britain and Italy, and this was something third parties were entitled to rely on.
3. Article 76 EPC governs the filing of divisional applications. A divisional application by its very nature implies that it is a part of something that is in existence when the divisional is filed. At the time of the filing of the present divisional application the parent application did not designate the four states in question, and so the divisional application could not designate these.
4. The conditions in Article 76 EPC that a divisional may be filed only in respect of subject matter which does not extend beyond the content of the earlier application as filed, and that it shall not designate Contracting States which were not designated in the earlier application are necessary conditions that must be fulfilled for the filing of a divisional, but cannot be treated as the sole conditions to be fulfilled. This would be to ignore the word "divisional" and its equivalents in the other official languages. Article 76 EPC does not state explicitly that the earlier application has to be pending at all at the time of filing of the later application, but this too is

implicit in the term "divisional". Filing of a divisional under Article 76 EPC can have no resurrectionist effect for something that no longer existed at the time it was filed.

5. Nor is this a case where the principle of the protection of reasonable expectations might save the appellant. The Examiner may have suggested the withdrawal of the designations as a way of avoiding the prior art, but there is no suggestion that the Examiner was aware of the appellant wishing to file a divisional or in any way misleading the appellant as to the consequences of such action. The appellant was not forced to take the course of action he did. Other courses were open such as filing the divisional earlier, or filing different claims for different Contracting States in the earlier application and waiting to see whether an objection under Article 82 EPC as to lack of unity issued. Nothing resembling a situation requiring the protection of reasonable expectations can be seen here: an examiner cannot be treated as a legal adviser of the appellant who has to consider what possible action the appellant might wish to take.

6. The conclusion of the Board as to the application of Article 76 EPC to this case is wholly consistent with that found in standard textbooks, see for example Singer "The European Patent Convention" (Revised English (1995) edition by Raph Lunzer) in Section 76.05 "... As a divisional application can logically only be based on an existing earlier application, plainly the designation in the earlier application must exist at the relevant time, and not have been withdrawn before the filing of the divisional application" or the passage on Article 76 in the "Münchener Gemeinschaftskommentar" (point 5 on page 45):

"5. Territorial identity (designation of states)

That according to Article 76(2) in the European divisional application only States may be designated, which are designated in the European parent application, is as much to be understood as a matter of course, as that additional designations cannot be made in the parent application at a later stage. Neither would have legal effect. (German: "Beides wäre rechtlich unbeachtlich.") Refusal of a subsequent designation in the European parent application or the European divisional application may be the subject of a decision for the purposes of Article 106(3); but does not amount to a loss of a right within the meaning of Rule 69(1) and cannot be the subject of a decision within the meaning of Rule 69(2).

The use of the past tense in all three texts of Article 76(2) ("which were not designated") might lead to misunderstandings. The relevant factor is not that the designation once existed - this would always be the case for precautionary designations - but the status of the designations on the parent application at the time of filing of the divisional applications. This status determines the territory for which the subject matter of the divisional can be treated as pending (compare Article 67(4) second sentence.)"

7. Following the reasoning of decision J 22/95 (OJ EPO 1998, 569) also leads to the same conclusion. This decision is presently the subject of a referral by the President of the EPO to the Enlarged Board of Appeal for an opinion (under consideration as case G 4/98), but only as regards retroactive effects of a withdrawal or deemed withdrawal, and not as regards any point which would assist the present appellant.

8. Decision J 19/96 of 23 April 1999 in its section 2 gives further exhaustive consideration to the question of the interpretation of Article 76 EPC, and comes to the same conclusion.

9. Of the questions suggested by the appellant, only question 3 takes a form appropriate for a reference to the Enlarged Board of Appeal. However in view of the Board's interpretation of Article 76 EPC being wholly consistent with established EPO practice and jurisprudence, the Board sees no reason to refer the suggested question 3 of the appellant or any other question on the interpretation of Article 76 EPC to the Enlarged Board of Appeal. The question may be one of importance, but the answer is clear.

10. Question 1 of the appellant "Is the withdrawal of designated states during examination analogous to the removal of subject matter?" is unsuitable as a question for referral, because its relationship to the issue to be resolved in this case is too remote. It might be presented as an argument for a particular interpretation of Article 76 EPC, but the Board does not consider the argument to be helpful to the appellant. The reason that removal of subject matter by deletion of claims has in some cases not been considered as a bar to a divisional was that there had been no unequivocal abandonment of the subject matter. However as decision J 15/85 (OJ 1986, 395 see points 4 and 5 of the reasons) makes clear, an unequivocal abandonment of subject matter can lead to the refusal of a divisional. The appellant here has made an unequivocal withdrawal of the designations and must suffer the consequences. To somehow treat a clear withdrawal of designations as an equivocal procedural statement would be to cause confusion where previously all was clear.

11. The second question of the appellant "... is it acceptable for the Examining Division to accept conditional withdrawal of a designation subject to the right to file a divisional application ?" is purely hypothetical, as it has no bearing on the facts of this case. Accordingly a referral of this question to the Enlarged Board of Appeal cannot be considered.

Order

For these reasons it is decided that:

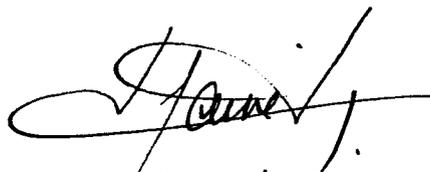
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:


J.-C. Saisset