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D E C I S I O N
of 21 March 2002

Case Number: J 0004/99 - 3.1.1

Application Number: 94201445.7

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:

Apparatus for applying a fluorocarbon coating to a substrate

Applicant:

DUNFRIES INVESTMENTS LIMITED

Opponent:

-

Headword:

Late divisional application/DUNFRIES INVESTMENTS LTD

Relevant legal provisions:

EPC R. 51(4), 25(1), 51(6)

Keyword:

"Conditional approval under R 51(4) EPC in respect of the filing of a divisional application (no)"

"Legitimate expectations from J 11/91 (no)"

"Second communication under R 51(4) EPC required when later requested amendments are accepted (no)"

"retrospective application of the latest version of R 25(1) EPC (no)"

Decisions cited:

J 0012/99, J 11/91, J 4/96, J 0014/95, J 0015/95, J 0016/95,
J 24/95, J 25/95, G 10/92

Catchword:

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Case Number: J 0004/99 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 21 March 2002

Appellant: DUNFRIES INVESTMENTS LIMITED
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St. Helier
Jersey
Channel Islands (GB)

Representative: Jilderda, Anne Ayolt
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Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 8 September 1998 refusing to treat European patent application No. 94 201 445.7 as a European patent application.

Composition of the Board:

Chairman: J.-C. Saisset
Members: J. H. P. Willems
J. C. M. De Preter

Summary of Facts and Submissions

- I. European patent application 89 202 791.3 was filed by the appellant on 6 November 1989.
- II. On 11 April 1994 the Examining Division sent the appellant a communication under Rule 51(4) EPC regarding this application, requesting the appellant to give its approval within four months after that communication.
- III. In a letter from its representative of 26 April 1994, the appellant stated:

"In reply to your Communication under Rule 51(4) EPC, dated April 11, 1994, we herewith state our approval of the text specified."

- IV. On 24 May 1994, the appellant filed application No. 94 201 445.7 as a divisional application from application 89 202 791.3.
- V. On 25 July 1994, the Receiving Section sent the appellant a communication noting a loss of rights pursuant to Rule 69(1) EPC, stating that application 94 201 445.7 would not be treated as a European divisional application because it was filed after approval had been given for the earlier pending European patent application in accordance with Rule 51(4) EPC. Referral was made to Rule 25(1) EPC, then reading:

"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 application on the pending earlier European patent application."

- VI. With letter dated 1 August 1994, the appellant proposed amendments to the text of the earlier application 89 202 791.3 and stated:
- "The above includes that we herewith withdraw our earlier approval, sent to you on April 26, 1994, and that we submit the amended text for additional examination."
- VII. By a communication of 14 March 1995 the Examining Division allowed the requested amendments.
- VIII. On 8 September 1998 the Receiving Section decided not to treat application 94 201 445.7 as a divisional application and to refuse the request of the appellant to set aside the notification pursuant to Rule 69(1) dated 25 July 1994.
- IX. By a letter of 7 November 1998, received by the Office on 9 November 1998, the appellant filed an appeal against this decision.
- X. The grounds for the appeal were filed on 18 January 1999 and will be discussed under the Reasons for the Decision.
- XI. With the summons to the oral proceedings dated 5 December 2001, the Board sent a communication to the appellant, with a copy of the decision of the Board of 16 March 2001 in the case J 0012/99.
- XII. On 21 March 2002 oral proceedings were held, where the appellant filed a summary of his oral argumentation.

Reasons for the Decision

1. The appeal is admissible.
2. The text of Rule 25(1) EPC has been amended by decision of the Administrative Council of 18 October 2001 and now reads as follows:

"The applicant may file a divisional application relating to any pending European patent application."

Contrary to what is argued by the appellant, this new text cannot be applied retrospectively to the case under appeal. That would be clearly in conflict with Article 2(1) of the Decision of the Administrative Council (OJ EPO 2001/11, page 490), reading:

"Rule 25(1) EPC as amended by this decision shall enter into force on 2 January 2002."

Therefore the applicable text of Rule 25(1) is that cited above under V.

3. The appellant has argued that his approval of 26 April 1994 was made on the condition that a divisional application would be filed and accepted.

This argument cannot succeed.

The Board is of the opinion that such a condition, if possible at all, should at least be made explicitly. There is however nothing in the text of the letter of 26 April 1994 in this regard. The Board points out that, although the possibility of filing a divisional application was mentioned in the letter of the appellant of 19 July 1993 and in the communication dated 10 January 1994, no clear intention of the

appellant to file such a divisional application was ever mentioned.

Moreover even if that intention had been expressed, that would not have been sufficient to construe the filing of a divisional application as a condition that had to be met before the later approval became effective. (J 14-15-16/95 and J 24-25/95, comp. also J 4/96).

4. Further the appellant has argued that the principle of good faith would be contravened if the EPO could be allowed "to contradict its earlier conduct in the proceedings".

The Board does not see anywhere in the file anything that could have given rise to the assumption that a divisional application would be allowed after the approval pursuant to Rule 51(4) EPC.

Therefore this argument of the appellant cannot succeed either.

Insofar as the appellant refers to J 11/91 in this respect, the following has to be observed:

First, Rule 25(1) EPC in its 1988 version is clear and was always applied in its literal meaning. The decision in cases J 11/91 and J 16/91 of 25 March 1992 was the only occasion on which a Board has taken the view that Rule 25(1) EPC is incompatible with Article 76(1) EPC and does not represent the final date by which a divisional application on a pending earlier European patent application must be filed.

Second, before that decision was published in the Official Journal of the EPO (1994, 28) it had already been mentioned in the Official Journal of the EPO

(1993, 6) that the question "until when may an applicant file a divisional application on the pending earlier European patent application" had been referred to the Enlarged Board.

Moreover, when decision J 11/91 was published, the attention was drawn to that referral in a footnote. Therefore it must have been clear from the outset that this divergent decision was questioned so that it could not be taken as a basis for legitimate expectations.

5. The appellant has further argued that the opinion G 10/92 of the Enlarged Board of Appeal cannot be invoked against it because it was not made public before the publication in OJ EPO 9/1994, 633.

This argument can also not be followed because what is being applied is not opinion G 10/92 but Rule 25(1) as in force since 1 October 1988.

If the appellant decided to deviate from the text of Rule 25(1) EPC on the basis of J 11/91 (notwithstanding the aforementioned publications), it clearly did so at its own risk.

6. A further argument of the appellant is that at the time of the filing of the application 94 201 445.7 (24 May 1994) the deadline for filing a divisional application was not clear to the EPO itself, and that it would not be fair to hold that lack of clarity against the appellant.

However the Board considers that this argument works against rather than for the appellant: a normally careful and diligent applicant who is of the opinion that a certain issue is not clear should take the safer course.

7. Finally the appellant has argued that in refusing to treat application 94 201 445.7 as a divisional application, the interests of the appellant are not rightly balanced against those of the public.

The appellant in making this argument has not taken into account that it is not the Receiving Section in the decision under appeal that has to balance those interests but the Administrative Council in formulating Rule 25(1) EPC. Once enacted, this rule has to be applied.

In its opinion G 10/92 the Enlarged Board has dealt with this matter and has come to the conclusion that the Administrative Council has not transgressed the general authorisation given by Article 76(1) EPC to lay down the procedure for filing European divisional applications.

8. During the oral proceedings the representative of the appellant argued that in Rule 25(1) EPC "Up to the approval" should be construed as "up to the final approval" and not as "up to the first approval".

It is true that the opinion G 10/92 of the Enlarged Board of Appeal says, in point 7 of the reasons, that it is the final approval of the appellant that is decisive. However, the Enlarged Board stated this in the context that, "if the examination proceedings are reopened by the Examining Division" it is the last approval of the appellant that is decisive for the application of Rule 25(1).

The Enlarged Board also stated (point 5) that a withdrawal of a given approval - although in principle possible - does not mean that the appellant who withdraws its approval then acquires the right to file a divisional application.

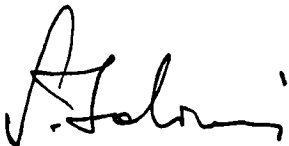
In the case at hand there was no re-opening of the examination proceedings because the Examination Division accepted without further discussion the amendments requested by the appellant in its letter of 1 August 1994. Even if the appellant had requested such reopening of the proceedings, there would have been no obligation on the Examining Division to do so as the amendments were accepted without any need for such a reopening. It is true that the appellant approved its own amendments but such an approval was not given within the framework of Rule 51(4) EPC as required by Rule 25(1) EPC (see J 12/99).

Order

For these reasons it is decided that:

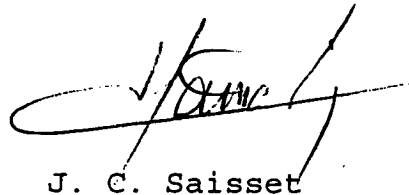
The appeal is dismissed.

The Registrar:



S. Fabiani

The Chairman:



J. C. Saisset

