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D E C I S I O N
of 16 March 2001

Case Number: J 0012/99 - 3.1.1

Application Number: 98 ...

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:...

Applicant:

N.N.

Opponent:

-

Headword:

Late divisional application

Relevant legal provisions:

EPC Art. 97(2)(a)

EPC R. 25(1), 51(4), 51(6), 86(3)

Keyword:

"No second communication under Rule 51(4)EPC is required when amendments requested after the approval under Rule 51(4) EPC are accepted without reopening of the procedure"

Decisions cited:

G 0010/92, J 0029/95, J 0020/99

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: J 0012/99 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 16 March 2001

Appellant: N.N.

Representative:

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 6 November 1998 refusing to treat European patent application No. 98 ... as a European divisional application.

Composition of the Board:

Chairman: J. C. Saisset
Members: J. C. M. De Preter
M. K. S. Aúz Castro

Summary of Facts and Submissions

- I. The European patent application No. 98 ... was filed on 5 August 1998 as a divisional application based on the earlier application No. 92 ... filed on 28 April 1992.
- II. By a communication under Rule 51(4) EPC dated 16 April 1998 the applicant was informed of the text on which the Examining Division intended to grant a patent on the earlier application. The approval of the applicant was given by letter dated 10 June 1998 which was received by the EPO on 15 June 1998. On 24 June 1998 the Examining Division issued a Rule 51(6) EPC Communication.
- III. By telefax dated 6 August 1998 the applicant withdrew its prior approval and requested amendments, stating its final approval of the text on the assumption that the amendments would be incorporated into the final text to be granted. By Communication dated 9 September 1998 the Examining Division allowed the requested amendments.
- IV. On 11 September 1998 the Receiving Section issued a "Noting of loss of rights pursuant to Rule 69(1) EPC", informing the applicant that the second application would not be treated as a divisional application as it was filed after approval had been given of the earlier patent application in accordance with Rule 51(4) EPC.
- V. By a letter received by the EPO on 18 September 1998 the applicant's representative set out that the applicant had stated its final approval of the text in a letter of 6 August 1998 i.e. after the filing of the divisional application, and requested a decision under Rule 69(2) EPC.

VI. On 6 November 1998 the Receiving Section decided on the basis of Rule 25(1) EPC that European patent application No. 98 ... would not be treated as a European divisional application. The Examining Division stated that it had only given its consent under Rule 86(3) EPC to the requested amendments and that it regarded the applicant's approval of 15 June 1998 as the final approval in accordance with Rule 51(4) EPC. It was only if examination proceedings were reopened by the Examining Division after the approval in accordance with Rule 51(4) EPC because - for whatever reason - the proposed text for grant was to be amended, that rule 51(4) EPC required that an applicant once again be informed of the text in which the Examining Division intended to grant the European patent. However, the proceedings had not been reopened.

VII. On 5 January 1999 the applicant lodged an appeal against the decision of the Receiving Section and paid the appeal fee on 6 January 1999. It requested that the decision under appeal be set aside and that the divisional application be allowed to proceed.

In the grounds of appeal, submitted on 9 February 1999 the appellant essentially set out that the filing and allowance of the amendments submitted with its letter of 6 August 1998 under Rule 86(3) EPC necessarily involved reopening of the examination proceedings by the Examining Division, which must have acquiesced to the applicant's withdrawal of its prior approval and that paragraphs 6 and 7 of the Reasons of Opinion G 10/92 indicated that when the Examining Division reopened the examining proceedings it was possible to file a divisional application prior to the applicant's final approval of the text. Thus, as the divisional application was filed prior the applicant's final approval of the text, the divisional application was filed in due time.

VIII. On 6 November 2000 the Board issued a preliminary opinion pointing out in particular that, as the Examining Division had immediately allowed the amendments requested after the issuing of a Rule 51(6) EPC Communication, no reopening of the examination proceedings was necessary and no new Communication under Rule 51(4) EPC had to be issued so that what the appellant calls its "final approval" was not in fact given in accordance with Rule 51(4) EPC as required by Rule 25(1) EPC. The only approval given by the appellant in accordance with Rule 51(4) EPC was received on 15 June 1998, i.e. before the filing of the present application.

IX. The appellant's representative did not file comments in response to the Board's communication. Oral proceedings were held on 16 March 2001.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 97(2)(a) EPC, if the Examining Division is of the opinion that the application and the invention to which it relates meet the requirements of the Convention, it shall decide to grant the European patent for the designated Contracting States provided that it is established in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in which the Examining Division intends to grant the patent (cf. also Article 113(2) EPC). Hence, in order to establish that

approval, Rule 51(4) EPC provides that, before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it and shall request him to indicate his approval of the text notified.

This approval is a procedural statement and sets a clear point in time for both the EPO and the applicant as Rule 25(1) EPC allows an applicant to file a divisional application only up to the approval in accordance with Rule 51(4) EPC. However, as stated in the Enlarged Board's Opinion of 28 April 1994 (OJ EPO 1994, 633, point 7 of the reasons), "for a Rule 25 to apply it is the applicant's final approval of the proposed text for grant that is decisive. If examination proceedings are reopened by the Examining Division after the approval in accordance with Rule 51(4), because - for whatever reason - the proposed text for grant is to be amended, Rule 51(4) EPC requires that the applicant once again be informed of the text in which the Examining Division intends to grant the European patent. In this case, for Rule 25 to apply, it is the last approval given by the applicant during proceedings that is decisive. Hence a divisional application may always be filed up until the applicant's final approval in accordance with Rule 51(4) EPC i.e. until it is clear that the applicant approves the final text proposed by the Examining Division".

The said words "until it is clear that the applicant approves the final text proposed by the Examining Division" imply that when the applicant files amendments after the approval in accordance with Rule 51(4) EPC, the proceedings are formally reopened for objections made by the Examining Division and that these objections are eventually met by the applicant. In that case a second communication under Rule 51(4)

EPC is required. This is also the case when objections made by the Examining Division to the amendments filed by an applicant in reply to a Rule 51(4) EPC communication are met (cf. J 20/99).

Contrary to the appellant's allegations, allowing amendments after the approval of the proposed text for grant pursuant to Rule 51(4) does not necessarily involve a reopening of the examining proceedings. It is of course true that the Examining Division has to examine the proposed amendments with regard to their allowability. But this examination does not yet imply the formal step of reopening the examining proceedings. If the proposed amendments can be allowed, no reopening is necessary. This happened in the case of the parent application of the application under consideration. Only if the Examining Division had not agreed to the amendments proposed by the appellant with regard to the parent application and had neither merely rejected them but reached the conclusion that objections were still to be met, would a reopening of the examination proceedings have then been necessary. This would have implied a formal communication informing the applicant that the examination proceedings were reopened. Since this was not the case here, no reopening took place.

Therefore, in the present case in which the Examining Division has immediately allowed the amendments requested after the issuing of a Rule 51(6) EPC communication, no reopening of the examination proceedings was necessary and no new communication under Rule 51(4) EPC had to be issued. Such reopening of the proceedings and such communication would have been pointless as the Examining Division could establish the approval of the text intended for grant.

For the same reason no second communication under Rule 51(4) EPC is required when amendments requested by an applicant in reply to a communication in accordance with said Rule can be immediately accepted by the Examining Division (cf. J 29/95 OJ EPO 1996, 489).

Thus, what the appellant calls its final approval was not given in accordance with Rule 51(4) EPC as required by Rule 25(1) EPC. The only approval given by the appellant in accordance with Rule 51(4) EPC was received on 15 June 1998 i.e. before the filing of the present application on 5 August 1998 so that the latter is belated.

As to the appellant's withdrawal of its prior approval, the Examining Division was not required to acquiesce. The Examining Division rightly stated that, by withdrawing this approval, the applicant could not alter the fact that it was once given and correctly regarded the applicant's approval of 15 June 1998 as the only final approval in accordance with Rule 51(4) EPC.

Order

For these reasons it is decided that:

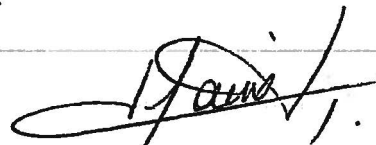
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



J.-C. Saisset