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Veröffentlichung im Amtsblatt	J/Nein
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Aktenzeichen / Case Number / N^o du recours : T 92/85

Anmeldenummer / Filing No / N^o de la demande : 80 200 295.6

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 017 300

Bezeichnung der Erfindung: Sealing body for a pipe connection

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : F 16 L21/02

ENTSCHEIDUNG / DECISION

vom / of / du 28 January 1986

Anmelder / Applicant / Demandeur : WAVIN B.V.

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Belated division and amendment/WAVIN

EPÜ / EPC / CBE Rules 25(1)(a), 86(3)

Leitsatz / Headnote / Sommaire

SUMMARY OF FACTS AND SUBMISSIONS

- I. European patent application No. 80 200 295.6 was filed in the name of the appellants on 28 March 1980, claiming priority from a national application filed in the Netherlands on 30 March 1979 (hereinafter referred to as "the corresponding Dutch application").
- II. The European patent application was published on 15 October 1980. As published, it included a set of ten claims, each relating to a sealing body for a pipe connection.
- III. By a Communication dated 18 February 1981, the Examining Division informed the appellants that the European patent application did not meet the requirements of the European Patent Convention as each of the first seven claims respectively lacked either novelty or inventive step. The features of Claim 8, however, seemed not to be known from or to be suggested by the state of the art as set out in the search report. Therefore, the features of that claim could form, together with essential features of previous claims, the basis of a new Claim 1. Claims 9 and 10 could be accepted if they were dependent from an acceptable Claim 1.
- IV. In a letter dated 29 June 1981, sent in response to this Communication, the appellants' representative stated that the suggested restriction to the original Claim 8 could not be accepted for the time being and was considered to be unnecessary, for reasons given, in view of the cited prior art. A set of ten amended claims (Claim 2 of which corresponded substantially to the original Claim 8) was submitted with the letter.



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If the Communication under Rule 51(4) and (5) EPC has been sent out and there are no circumstances which can properly be regarded as exceptional, The Examining Division may (in view of the state of the proceedings) (1) refuse to allow the filing of a divisional application in the exercise of its discretion under Rule 25(1)(a) EPC and (2) refuse its consent to the making of a further amendment pursuant to Rule 86(3) EPC.



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Case Number : T 92 /85

DECISION
of the Technical Board of Appeal 3.2.1
of 28 January 1986

Appellant : WAVIN B.V.
Hindellaan 251
NL-8031 EM Zwolle (NL)

Representative : Van der Veken, Johannes Adriaan
EXTERPATENT
Willem Witsenplein 4
NL-2596 BK's-Gravenhage (NL)

Decision under appeal : Decision of Examining Division 118 of the European Patent Office dated 24 Oct 84 refusing European patent application No 80 200 295.6 pursuant to Article 97(1) EPC

Composition of the Board :

Chairman : C. Maus
Member : P. Ford
Member : C. Wilson

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- IV. In a letter dated 29 June 1981, sent in response to this Communication, the appellants' representative stated that the suggested restriction to the original Claim 8 could not be accepted for the time being and was considered to be unnecessary, for reasons given, in view of the cited prior art. A set of ten amended claims (Claim 2 of which corresponded substantially to the original Claim 8) was submitted with the letter.

- V. In a second Communication dated 10 September 1981, the Examining Division stated that the set of amended claims did not yet appear to be allowable, on various grounds, and offered the applicants' representative the opportunity to discuss the matter either with the primary examiner in an informal interview or with the Examining Division in oral proceedings. It was requested that any new claims for discussion should be submitted beforehand.
- VI. With a letter dated 20 January 1982, the applicants' representative submitted a set of eight claims directed to a retaining ring and asked for an informal interview with the primary examiner.
- VII. As appears from the file of the case, during the course of an informal interview with the primary examiner, on 13 May 1982, after the applicants' representative had explained the invention and its advantages and after the primary examiner had expressed his opinion that there was no inventive step in the newly presented Claim 1, the appellants' representative proposed to limit the application to the embodiment of Figure 6 which had been the subject-matter of the original Claim 8. He agreed to file new claims so limited and he did so with a letter dated 1 October 1982.
- VIII. In a further Communication dated 12 April 1983, the Examining Division stated that the subject-matter of these claims appeared to be patentable with respect to the prior art. A modification to Claim 1, for reasons of clarity, was put forward for agreement and the appellants were invited to file a new Claim 1 accordingly and to adapt the description and the drawings to the new claims.

- IX. In response, the appellants' representative filed an amended claim, description and single Figure drawing with his letter dated 21 June 1983.
- X. Advance notice of the Communication pursuant to Rule 51(4) and (5) EPC, in which the text proposed for the European patent application was set out, was sent to the applicants' representative on 25 October 1983.
- XI. By letter dated 30 December 1983, the appellants' representative informed the European Patent Office that the proposed amendments were acceptable and requested that the Communication pursuant to Rule 51(4) and (5) EPC should be sent. That Communication was duly sent to him on 17 January 1984.
- XII. By letter dated 17 April 1984, the appellants' representative informed the Office that the appellants considered that they should be allowed a much broader protection than that provided by the claims mentioned in the Communication pursuant to Rule 51(4) and (5) EPC. Arguments in support of broader protection were advanced in the letter and a set of amended claims and an amended description were submitted with a further letter dated 25 April 1984.
- XIII. The Examining Division replied, in a communication dated 16 May 1984, that further examination of the European patent application had revealed that it did not meet the requirements of the European Patent Convention and that, if the deficiencies indicated were not corrected, the application might be refused pursuant to Article 97(1) EPC. The Communication stated that no further amendments could be allowed, since the appellants had requested a

full re-examination of the application after receipt of the Communication pursuant to Rule 51(4) and (5) EPC. Furthermore, the filing of a divisional application would not be allowed once that Communication had been sent out.

XVI. By letter dated 26 July 1984, the appellants' representative requested reconsideration of the matter. He asserted that agreement to the text on which a patent could be granted had been based on a wrong interpretation of the prior art and that results of recent research by the appellants had shown that the grant of a patent on the basis of the agreed text would be insufficient to provide adequate protection of the invention. Reconsideration of the amended application would not require any additional search: alternatively, the appellants should be allowed to file a divisional application for the subject-matter of the latest amended description and claims. If division was not allowable, examination of the application should be resumed, pursuant to Rule 51(4) EPC.

XV. On 24 October 1984, the Examining Division issued the Decision under appeal, refusing the European patent application according to Article 97(1) EPC on the grounds that there was no agreement on a text for a patent and that the appellant had had enough opportunity to carefully study the prior art, taking into account the number of notifications and letters and the personal consultation. The argument that the results of recent research justified disagreement with the agreed text could not be accepted, since there was a period of five years between the priority date and the research. Furthermore, new prior art brought forward by the appellants (their own patent NL-A-7 412 324) could not

justify continuation of the procedure as it could not be regarded as prior art of which the applicant had only just become aware. The request to be allowed to file a divisional application was also refused, since it was not made until after the Communication under Rule 51(4) and (5) had been sent out.

XVI. By letter dated 20 December 1984, the appellants' representative filed a notice of appeal requesting cancellation of the whole Decision. The appeal fee was duly paid.

XVII. In the Statement of Grounds of appeal, dated 4 March 1985, the appellants contended that they were entitled to:

(I) allowance of the European patent application on the basis of the text proposed in the Advanced Notice (re-submitted with the Statement of Grounds) coupled with allowance of a divisional application on the basis of claims submitted with the Statement of Grounds; or

(II) re-opening of the examination procedure on the basis of the text filed with the letter dated 25 April 1984.

A third request was subsequently withdrawn.

XVIII. In a Communication of the Technical Board of Appeal, dated 5 June 1985 the rapporteur invited the appellants to submit further written arguments as the requests made did not appear to be justified. Such arguments were submitted by letter dated 15 October 1985.

- XIX. In a Communication dated 22 November 1985 sent with a summons to oral proceedings, it was indicated that the Board was still not satisfied that the appellants' requests were justified. The appeal was unlikely to succeed unless the appellants could satisfy the Board that the Examining Division wrongly exercised its discretion to refuse to allow amendment at such a late stage in the examination proceedings. Allowance of division at such a late stage was also discretionary. The appellants had argued *inter alia* that the action of the Netherlands Patent Office in allowing division from the corresponding Dutch application should be persuasive in their favour but they had not shown that the procedural circumstances were the same or what reasons had been given (if any) for allowing amendment in the national proceedings. If they wished the situation in those proceedings to be considered further they should file copies of all relevant documents and provide translations into an official language of the EPO, well in advance of the date set for the oral proceedings. (The appellants duly filed such copies and translations).
- XX. At the oral proceedings held on 28 January 1986, the appellants' representative confirmed the appellants' main and auxiliary requests. He stated that the appellants were primarily interested in being allowed to file a divisional application which would relate to an aspect of the invention the importance of which had not been sufficiently appreciated by the appellants' patent department at the time when the appellants had agreed to the limitation of the scope of their claims. It appeared that it had taken some time to solve the problems of mass production of articles in accordance with the invention. The solution to these problems proved to be matter that had in fact been disclosed and claimed in the European

patent application as originally filed. Its practical importance, however, had not been explained to the patent department until 1984. The representative submitted that its inventive significance could be appreciated by comparison with the appellants' earlier Dutch patent NL-A- 7 412 324. He argued that there had been no abandonment by the applicants of this aspect of the invention. Although the claims of the present application had been restricted, nevertheless there was still reference to it in the text of the description. He further relied on the fact that the Application Department of the Netherlands Patent Office had permitted division of the corresponding Dutch application at what he argued was a comparable stage in the procedure.

REASONS FOR THE DECISION

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. The appellants' main request is for a European patent to be granted on the basis of the claims, description and figure re-submitted with the Statement of Grounds of Appeal, which is identical with the text proposed by the Examining Division in the Advanced Notice of the Communication under Rule 51(4) and (5) EPC, provided that the appellants are at the same time allowed to file a divisional application on the basis of the text for it also filed with the Statement of Grounds.
3. The Examining Division was prepared to grant a European patent on the basis of the text now before this Board but was not prepared to allow the filing of a divisional application since, in accordance with the Guidelines for Examination C VI 9.3, the filing of a divisional application will not be allowed when a Communication under Rule 51(4) and (5) EPC has been sent out.

4. It is made clear in the introduction to the Guidelines for Examination that they may be departed from in exceptional cases but that, in general, they will be followed by examining staff of the Office.
5. Rule 25(1)(a) EPC provides that a European divisional application may be filed after receipt of the first communication from the Examining Division only within the period prescribed by that communication or after that period if the Examining Division considers the filing of a divisional application to be justified. On the facts of the present case, therefore, the Examining Division had a discretion, which it exercised against the appellants, in accordance with the Guidelines for Examination, in view of the state of the proceedings.
6. This Board considers that the Examining Division was right to refuse to allow the filing of a divisional application, in all the circumstances of the case.
 - 6.1 In the oral proceedings before the Board, the appellants' representative sought to rely upon the fact that there had been a problem of lack of communication between the appellants' production department and patent department as a result of which the latter had been unaware until 1984 of the importance of obtaining broader protection than that given by the text proposed in the Advanced Notice. In answer to a question from the Board, the representative agreed that nothing in the correspondence with the Examining Division dealt with this problem. Even if the Examining Division had known about it, however, this could not have constituted a reason justifying departure from the general rule according to the Guidelines for Examination.

On the one hand, the appellants are one legal person and knowledge of one department of their organisation is

knowledge of the appellants. On the other hand, even if separate persons had been involved, there was plenty of time and opportunity for the patent department to make internal enquiries as to the value of a patent limited to the scope of the original Claim 8 which, as the facts show, was a limitation under active consideration by the appellants' representative and the Examining Division from February 1981 until June 1983 and finally approved by the appellants' representative as late as 30 December 1983.

- 6.2 In their appeal, the appellants have also sought to rely on the decision of the Application Department of the Netherlands Patent Office allowing division from the corresponding Dutch application at a very late stage. They submit that, since the Dutch patent law and practice is in all relevant respects the same as the European patent law and practice, the European Patent Office should act in the same way.

According to the Official Announcement LX published in the Bijblad bij de Industriële Eigendom 1978, p. 194, paragraph 5, consent to late filing of divisional applications will only be given in special cases when the examiner has started to treat the request for grant, and good arguments must be presented showing why the request had not been filed within the period of six months from filing the request for grant. Furthermore, it has to be shown that the subject-matter of the proposed divisional application cannot be judged for patentability in the normal way at the stage reached with the parent application.

Following notification to the appellants by the Netherlands Patent Office that the corresponding Dutch patent application could be published, the appellants requested two findings of non-unity of invention and

leave to file two divisional applications. Such findings and leave were given in a Decision dated 27 December 1984 but this Decision does not refer to any of the criteria for giving consent to late filing set out in Official Announcement LX. It refers only to a letter from the appellants in which technical advantages of two "objects of invention" were set out.

The papers produced to this Board from the file of the Dutch case do not, therefore, show the grounds upon which consent was given to late filing of the divisional applications in question. It follows that, whatever the reasons may have been, this Board cannot consider that the question of consent to late filing was dealt with in such a way that it provides a precedent to be followed in the European procedure. Consequently, even if the Examining Division had known about the history of the corresponding Dutch application, that could not have been of assistance to the appellants.

7. It is clearly too late for division to be allowed in the present case and, therefore, the appellants' main request must be refused.
8. The appellants' auxiliary request for re-opening of the examination procedure on the basis of the text submitted on 25 April 1984 was refused by the Examining Division in the exercise of its discretion in accordance with Rule 86(3) EPC, second sentence. The reason was that the appellants had already agreed on a version of the text on the basis of which a patent could be granted (cf. Guidelines for Examination C VI, 4.7-4.8). For reasons already discussed in paragraph 6.1 above, the appellants cannot rely on failures of communication within their organisation to justify reopening of the examining procedure on the basis of a text submitted after the Communication pursuant to Rule 51(4) and (5) EPC had been sent out.

The Board is unable to find any other basis on which it would be proper to allow re-opening of the examination procedure in accordance with the auxiliary request. It must, therefore, be refused.

ORDER

For these reasons,

it is decided that:

The appeal against the Decision of the Examining Division dated 24 October 1984 is dismissed.

The Registrar

B .A. Norman

The Chairman

C. Maus