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D E C I S I O N
of 8 April 2002

Case Number: J 0007/01 - 3.1.1

Application Number: 99...

Publication Number: -

IPC: ...

Language of the proceedings: EN

Title of invention:

...

Applicant:

N.N.

Opponent:

-

Headword:

Late divisional application/N.N.

Relevant legal provisions:

EPC Art. 97(2) (a)

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

Keyword:

"A second communication under Rule 51(4) EPC is required when amendments requested after the approval under Rule 51(4) EPC are accepted by the Examining Division which makes additional amendments of its own motion"

Decisions cited:

G 0010/92

Catchword:

-



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Boards of Appeal

Chambres de recours

Case Number: J 0007/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 8 April 2002

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 25 October 2000 refusing to treat European patent application No. 99 ... as a European divisional application.

Composition of the Board:

Chairman: J.-C. Saisset
Members: J. C. M. De Preter
S. U. Hoffmann

Summary of Facts and Submissions

- I. The European patent application No. 99 ... was filed on 22 September 1999 as a divisional application on the earlier application No. 93
- II. As to the latter application, following a communication under Rule 51(4) EPC of the Examining Division dated 3 July 1998, the applicant had informed said Division by letter of 21 October 1998 that it disapproved the text as proposed but that it would be prepared to approve the text with amendments.

By a communication of 4 November 1998 under Rule 51(6) EPC, the Examining Division gave its approval to the requested amendments.

By letter of 4 February 1999 the applicant filed the translations of the claims and authorised the EPO to debit the appropriate fee from its deposit account.

In a further letter dated 2 March 1999 the applicant explained why it had to disapprove the text accompanying the communication under Rule 51(6) and requested that the Examining Division exercises its discretion under Rule 86(3)EPC to allow new amendments.

By a communication under Rule 51(6) dated 17 June 1999 the Examining Division allowed the requested amendments and enclosed the amended pages.

By letter of 23 September 1999 the applicant noted that the Examining Division had made unrequested amendments to claim 18 on page 22, of which it disapproved, proposed new amendments to said claim 18 and enclosed the translations of the claims, including the proposed amendment to claim 18. It also waived its right to the

issuance of a further communication under Rule 51(6) EPC assuming that the Examining Division would approve the proposed amendments to claim 18.

By a communication of 1 March 2000 the applicant was informed by the Examining Division that the requested amendments had been allowed and that the procedure would be continued by the issuance of a decision to grant.

- III. On 19 October 1999 the Receiving Section issued a "Noting of loss of rights" pursuant to Rule 69(1) EPC informing the applicant that the application No. 99 ... would not be treated as a divisional application because it had been filed after approval had been given in respect of the pending parent application in accordance with Rule 51(4) EPC.
- IV. By a letter of 26 November 1999 the applicant applied for a decision under Rule 69(2) EPC. In its further letter of 21 December 1999 the applicant set out *inter alia* that in no way could it be said that it had approved the final text of the parent application by 22 September 1999, the date of filing of the divisional application, because amendments made by the Examining Division of which the applicant did not approve were still outstanding.
- V. On 25 October 2000 the Receiving Section decided on the basis of Rule 25(1) EPC that European application No. 99 ... would not be treated as a divisional application as it had been filed after approval of the pending earlier application in accordance with Rule 51(4) EPC. In its reasons for the decision the Receiving Section stated *inter alia* that the request for amendments as made by the applicant on 21 October 1998 following the communication under Rule 51(4) EPC had been accepted by the Examining Division. As the

applicant had informed that Division that it would be prepared to approve the text if the amendments were accepted, the condition for giving the approval had been fulfilled so that the approval was given retroactively with effect from 21 October 1998. Therefore the last day for filing a divisional application was 21 October 1998.

The Examining Division further referred to Opinion G 10/92, stating that the fact that the applicant had disapproved the text of the earlier application by letter of 2 March 1999 did not give it the opportunity to file a divisional application.

- VI. On 27 December 2000 the applicant lodged an appeal against the decision of the Receiving Section and paid the appeal fee on the same day. It requested that the decision under appeal be set aside, that the communication under Rule 69(1) EPC dated 19 October 1999 be set aside and that European patent application No. 99 ... be treated as divisional application.
- VII. In its statement setting out the grounds of appeal filed on 21 February 2001 the appellant stressed that the Receiving Section had not taken into consideration that in the annex of the communication under Rule 51(6) EPC dated 17 June 1999 unrequested amendments to claim 18 had been made by the Examining Division which the appellant had disapproved by letter of 23 September 1999. However, Rule 51(4) EPC provides that before the Examining Division decides to grant a European patent it should inform the applicant of the text in which it intends to grant the patent and should request the applicant to indicate its approval of the text notified. It follows that, in accordance with Article 97(2)(a) EPC a further communication under Rule 51(4) EPC should have been issued. In the present case the appellant's approval was not obtained even

notionally until 23 September 1999, which is later than the filing date of the divisional application.

The appellant also requested that the appeal fee be refunded and that oral proceedings be arranged in the event that the Board of Appeal was minded to refuse the appeal.

VIII. In its second communication in response to the appellant's letter of 26 November 2001, the Board observed that it had been found on the basis of the original file of the initial application that contrary to what had appeared from the copies of the file the Board had at its disposal and on which the first communication had been based, page 22 of the specification annexed to the communication under Rule 51(4) EPC dated 3 July 1998 differed from page 22 of the specification annexed to the communication under Rule 51(6) EPC dated 17 June 1999 and that the amendments to claim 18 in the latter specification seemed to have been made by the Examining Division of its own motion. As the intention of the Board was to issue a favourable decision, the oral proceedings arranged for 26 February 2002 were cancelled.

Reasons for the Decision

1. The appeal is admissible.
2. By its second communication under Rule 51(6) EPC dated 17 June 1999 the Examining Division allowed the amendments requested by the appellant. However it appears from the annex to that communication containing the amended pages that claim 18 was amended, even though the appellant had never requested any amendment of that claim since receipt of the communication under

Rule 51(4) EPC dated 3 July 1998.

That amendment essentially consisted in replacing the words "characterised by" by the words "wherein" in the fourth line of claim 18 and inserting the words "characterised by" at the end of the sixth line of said claim. The Examining Division did not deny that it had made that amendment of its own motion when the appellant drew its attention to it by letter of 23 September 1999 and disapproved that amendment. Therefore it has to be taken as granted that the Examining Division had made an amendment to claim 18 which had not been requested and without even giving the appellant notice thereof.

Thus, as the Examining Division decided to amend claim 18 it must be considered that the proceedings had been reopened so that a new communication under Rule 51(4) EPC should have been sent informing the appellant of the text in which the Examining Division intended to grant the European patent (cf. Opinion G 10/92, OJ EPO 1994, 633, point 7 of the reasons).

As such a communication, which would have superseded the first communication under Rule 51(4) EPC, was not sent, the appellant was entitled to file the present divisional application since it had not even had the opportunity to approve the text in which the European patent was to be granted in accordance with Rule 51(4) EPC which prescribes a certain form in which an approval has to be established, in particular a communication to the applicant with a specified time limit which also sets a deadline for filing divisional applications (cf. Rule 25(1) EPC).

3. In its letter of 21 December 1999 to the Receiving Section the appellant had referred to its letter of 23 September 1999 to the Examining Division and had stressed that unrequested amendments had been made by the Examining Division as appeared from the annex of the communication under Rule 51(6) EPC dated 17 June 1999. Nevertheless the Receiving Section omitted to mention that fact in the "Summary of facts and submissions" and did not take that relevant argument into consideration. Such conduct amounts to a substantial procedural violation which justifies the reimbursement of the appeal fee according to Rule 67 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The European patent application No. 99 ... is to be treated as a divisional application.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset