

Publication in the Official Journal ~~Yes~~ / No

File Number: J 38/89

Application No.: 89 100 658.7

Publication No.:

Title of invention: Improvements in a fluid actuated clutch assembly

Classification: F16D 25/08

D E C I S I O N
of 24 July 1991

Applicant: FEDERAL-MOGUL Corp.

Headword: Divisional application/MOGUL

EPC Rule 25(1)(a), former version

Keyword: "Divisional application - retrospectively allowed"

Headnote



**Europäisches
Patentamt**

**European
Patent Office**

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des brevets**

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : J 38/89

D E C I S I O N
of the Legal Board of Appeal
of 24 July 1991

Appellant : FEDERAL-MOGUL Corporation
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Representative : Baillie, Iain Cameron
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Decision under appeal : **Decision of the Receiving Section of the European Patent Office dated 13 July 1989 refusing European patent application No. 89 100 658.7 the status of divisional application No. 83 103 978.9.**

Composition of the Board :

Chairman : O. Bossung
Members : C. Holtz
M. Lewenton

Summary of Facts and Submissions

- I. European patent application No. 83 103 978.9 was filed by the Appellant on 22 April 1983. In a communication issued 18 September 1987 the Examining Division of the European Patent Office raised objections to amendments to the patent application submitted by the Appellant. The Examining Division found Claim 1 to be unacceptable for lack of inventive step, and suggested i.a. that Claim 5 constitute the main claim of the application. Further, referring to Rule 25(1)(a) EPC, it considered a proposal from the Appellant for a divisional application covering Claims 5 to 12 not to be justified, because in its view the same scope of protection could be obtained by the use of only one single independent claim, with dependent claims adapted thereto.

- II. In a letter dated 21 April 1988, the Appellant filed a new set of claims, as well as a separate set of claims for a divisional application, in which i.a. original Claims 1 and 2 would be combined. The Appellant requested an indication from the Examiner approving the restated proposal for securing protection by a divisional application in respect of the subject-matter of the proposed new Claims 1 and 2. In case the Examiner would not agree to this, the Appellant requested to be contacted for the arrangement of oral proceedings. The Examining Division did not respond to these requests.

- III. On 4 August 1988, the Examining Division issued a communication under Rule 51(4) EPC, requesting the Appellant to approve the text specified for the grant of a European patent within four months. No mention was made of the Appellant's request from April 1988.

IV. On 1 October 1988, an amended version of Rule 25 EPC entered into force, by virtue of a decision on 10 June 1988 by the Administrative Council of the European Patent Organisation. The prior version of Rule 25(1)(a) EPC, effective until that date, reads: "A European divisional application may be filed:

(a) at any time after the date of receipt of the earlier European patent application by the European Patent Office, provided that after receipt of the first communication from the Examining Division, the divisional application is filed within the period prescribed in that communication or that after that period, the Examining Division considers the filing of a divisional application to be justified;"

The new version of Rule 25(1) EPC reads: "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."

In the document containing the proposals to the Administrative Council for amendments to the Implementing Regulations to the European Patent Convention, CA/29/88, dated 16.5.1988, the following was noted with regard to the new Rule 25(1):

"7. The new wording of Rule 25(1) EPC simplifies the procedure for both the Office and the applicant and makes for greater legal certainty in divisional proceedings. It is in line with the thinking of those concerned in industry and the patent profession. It should be emphasised that the filing of a divisional application is under no circumstances admissible once the applicant has approved, in accordance with Rule 41(4) EPC, the text in which the patent is to be granted on the parent application.

8. No transitional arrangement is necessary since once the proposed decision has entered into force it will no longer be possible for the Examining Division to disallow filing of a divisional application under Rule 25(1)(a) EPC as it now stands, irrespective of whether the divisional application was filed before or after that date. Only divisional applications already finally declared to be unjustified will be unaffected by the new ruling."

- V. In a letter dated 4 December 1988, the Appellant approved the text for the European patent as requested in the 4 August 1988 communication. He did not refer again to the question of divisional application. On 9 December 1988, the Examining Division issued a communication under Rule 51(6) EPC, confirming the receipt of the approval from the Appellant.

- VI. On 16 January 1989, the Appellant filed divisional application No. 89 100 658.7. In a communication of 31 January 1989 pursuant to Rule 69(1) EPC, the Receiving Section informed the Appellant that it would not treat the application as divisional, on the ground that it had been filed after approval of the text for grant of the parent application had been indicated.

- VII. The Appellant having requested a decision under Rule 69(2) EPC, the Receiving Section in its decision under appeal of 13 July 1989 took the view that the new version of Rule 25 EPC applied to the case at hand. Consequently, it refused the filing of the application as divisional on the ground that it had been filed after approval of the text for the parent application.

VIII. On 12 September 1989, the Appellant lodged an appeal against the decision and paid the appeal fee. The statement of ground was filed on 23 November 1989. The Appellant requests that application No. 89 100 658.7 be accorded the status of divisional application and that the appeal fee be refunded.

Reasons for the Decision

1. The appeal is admissible.
2. First, attention has to be drawn to the fact that, during the examining procedure of the parent application, the Appellant submitted under old Rule 25(1)(a) EPC two different requests for allowance of a divisional application. Only the first request of 18 September 1987 has been rejected (see above I.). The second, not identical request of 21 April 1988 (see above II.), was not answered either before or after 1 October 1988 (entry into force of new Rule 25(1) EPC).
3. If this second request had been allowed before 1 October 1988, the divisional application could have been filed even after that date without having to comply with the new time-limit introduced by the new Rule 25(1) EPC. Therefore, the question arises whether requests filed under old Rule 25(1)(a) EPC can still be allowed after the entry into force of new Rule 25(1) EPC. Considering the purpose of the new Regulations and the views expressed in the "Travaux preparatoires" (see above IV.), the Board does not see any obstacle to this being permitted even at this stage at least where a procedural violation has occurred. In the cited document of the Council of Administration (see above IV. under No. 8, last sentence)

it is clearly stated: "Only divisional applications already finally declared to be unjustified will be unaffected by the new ruling." In the present case the request for allowance under old Rule 21(1)(a) EPC has not yet received a response. Therefore, the Board, under Article 111(1), second sentence and Rule 66(1) EPC exercises the discretionary power of the Examining Division and retrospectively gives its consent under old Rule 25(1)(a) EPC to the filing of the divisional application. This seems to be an adequate solution for the special case where a request for consent to a divisional application under old Rule 25(1)(a) EPC has been filed before the entry into force of new Rule 25(1) EPC. It should be noted that under the new Rule there is no longer any necessity to obtain consent. Because there was a procedural violation this would not contravene what has been quoted from point 7 in the Travaux préparatoires (see point IV above). Also in the Decision of J 1/90 of 16 August 1990 "Time limit for divisional application/CHEMICAL FABRICS" (reasons to 2.) the Board expressed the opinion that even under new Rule 25(1) EPC, which allows the filing without consent of divisional applications up to the approval of the text of the parent application, it should still be possible to file with consent even after that approval, but before grant of the patent in respect of the parent application. This is because the subject-matter taken from the parent application is still pending before the EPO, i.e. is still legally viable.

4. The reimbursement of the appeal fee under Rule 67 EPC is equitable. The fact that the Examining Division did not deal with the request dated 21 April 1988 for allowance of a divisional application constitutes a "substantial procedural violation" within the meaning of Rule 67 EPC.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The filing of European patent application No. 89 100 658.7 as a divisional application of application No. 83 103 978.9 is allowed.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Beer

O. Bossung