

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

File Number: J 11/90 - 3.1.1

Application No.: 89 112 137.8

Publication No.:

Title of invention: Method of blow-moulding a biaxially oriented polyethylene
terphthalate resin bottle-shaped container

Classification: A47J 37/10

D E C I S I O N
of 6 August 1992

Applicant: Yoshino Kogyosho Co., Ltd.

Headword: Deadline for filing divisional application/YOSHINO KOGYOSHO

EPC Article 76; Rules 25(1), 51(4)

Keyword: "filing of divisional application permitted up to grant of parent
patent"

Headnote
Catchwords



Case Number : J 11/90 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 6 August 1992

Appellant : Yoshino Kogyosho Co., Ltd.
No. 2-6
Ojima 3-Chome
Koto-Ku, Tokyo (JP)

Representative : Heath, Derek J., et al
Bromhead & Co.
19 Buckingham Street
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Decision under appeal : Decision of the Receiving Section of the European
Patent Office dated 14 December 1989 refusing to
treat the European patent application
No. 89 112 137.8 as a divisional application of
European patent application No. 85 300 992.6.

Composition of the Board :

Chairman : O.P. Bossung
Members : M.K.S. Aúz Castro
G. Davies

Summary of Facts and Submissions

I. On 14 February 1985, European patent application No. 85 300 992.6 (parent application) was filed by the Appellant for a "Method of Blow-moulding", Claims 1 and 2 of which contained temperature ranges for certain steps of the claimed method. By letter of 17 September 1987, the Appellant deleted the temperature ranges. After a communication from the Examining Division that the deletion was not admissible under Article 123(2), the Appellant reintroduced the temperature ranges. A communication under Rule 51(4) EPC was issued on 23 September 1988, requesting the Appellant to approve the text specified for the grant of a European patent within four months. On 24 January 1989 the Appellant proposed amendments to the claims and description. In its communication under Rule 51(6) EPC, issued on 28 February 1989, the Examining Division informed the Appellant that the proposed amendments were accepted and requested the payment of the fees for grant and printing as well as the filing of the translations of the claims. The fees were paid on 8 May and the translations filed on 18 May 1989.

The decision to grant the patent was issued on 24 August 1989.

II. Prior to that date, namely on 3 July 1989, the Appellant had filed divisional application No. 89 112 137.8 with claims omitting the temperature ranges in question.

III. On 14 December 1989, the Receiving Section, relying on Rule 25(1) EPC, issued a decision refusing to allow the application as a divisional application of the parent application since the divisional application had been filed after approval of the text pursuant to Rule 51(4) EPC.

IV. On 13 February 1990, the Appellant's representative filed a notice of appeal, paying the appeal fee on 14 February 1990. The grounds of appeal were filed on 9 April 1990.

The Appellant argued that the approval by an applicant under Rule 51(4) EPC of the text of an application did not necessarily include the renunciation of any right the applicant might have to protect any subject-matter falling within the text of that application. Furthermore, the Appellant believed that it was entitled to broader protection than that given by the parent patent.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. A divisional application may be filed, according to Article 76(1), second sentence, EPC, in respect of subject-matter which does not extend beyond the content of the earlier application as filed; insofar as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the right to any priority. Article 76(3) provides that the procedure to be followed in carrying out the provisions of paragraph (1), and the special conditions to be complied with by a divisional application, are laid down in the Implementing Regulations.

Rule 25(1) EPC, which concerns these special conditions, puts a time limit on the possibility to file a divisional application up to the date of the approval of the text, pursuant to Rule 51(4) of the parent application. This limitation was introduced by the Administrative Council by

a decision dated 10 July 1988 as an amendment to Rule 25 EPC. Before that amendment, a divisional application could be filed at any time prior to grant if the Examiner considered such filing to be justified.

As explained in detail in decision J 11/91 and 16/91 (to be published), to which the Board refers, Rule 25 in its present version creates new substantive law. It thereby exceeds the competence given in Article 76(3) EPC, which allows only for the procedure to be followed in divisional applications to be laid down in the Implementing Regulations. Amendments to substantive law taking away rights of the applicant are not permitted.

Therefore, the filing of a divisional application, which in this case took place prior to the decision to grant a patent for the parent application, is allowed.

3. All other problems arising in connection with a divisional application should be dealt with in the course of the examination procedure of the divisional application as to substance, in particular the question whether or not the subject-matter of the divisional application extends beyond the content of the earlier application. Moreover, in this case, the question arises whether the subject-matter of a divisional application may not only overlap with part of the content of the parent patent but also comprise its whole content thereby having a broader scope than the parent patent. This is the declared aim of the Appellant.

In this particular case, the appropriate procedure would have been to apply for patent according to the broad claims (without temperature ranges) by way of a main request and according to the restricted version (with temperature ranges) by way of auxiliary request.

As this appeal concerns only the question whether the filing of application No. 89 112 137.8 as a divisional application is permissible, the above-mentioned problems are left to the examination of the divisional application as to substance.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The filing of European patent application No. 89 112 137.8 as divisional application of application No. 85 300 992.6 is allowed.

The Registrar:



M. Beer

The Chairman:



O. Bossung

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