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File Number: J 28/90, J 29/90
Application No.: 88 111 763.4 - 88 111 762.6
Publication No.:
Title of invention:

Classification:

D E C I S I O N
of 25 July 1991

Applicant: Laboratoires Hoechst

Headword: Divisional applications/HOECHST

EPC Rule 25

Keyword: "Divisional applications - filed in time under former and new
Rule 25"

Headnote



Case Number : J 28/90, J 29/90

D E C I S I O N
of the Legal Board of Appeal
of 25 July 1991

Appellant : Laboratoires/Hoechst

Representative : Orès, Bernard
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Decision under appeal : Decisions of the Receiving Section of the European Patent Office dated 18 June 1990 refusing European patent applications No. 88 111 762.6 and 88 111 763.4 the status of divisional applications of No. 85 102 131.1.

Composition of the Board :

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

Summary of Facts and Submissions

I. On 21 February 1985 the Applicant and Appellant filed the European patent application No. 85 102 131.1 ("parent application"). After the Examining Division had objected on the ground of lack of unity and invited the Applicant to file one or more divisional applications, the Applicant, by letter of 13 May 1988 limited the parent application and announced the following:

"We intend to file, without prejudice, two divisional Applications within two months following the limitation of the present answer."

II. On 18 July 1988 he filed the two divisional applications No. 88 111 763.4 and 88 111 762.6, subject of the present appeals.

III. On 1 October 1988 an amended version of Rule 25 EPC entered into force (OJ EPO 1988, 290).

The old version distinguished between a "voluntary" divisional application (former Rule 25(1)(a) EPC), for which consent was required, but which could be filed without a special time limit, and a compulsory "divisional application", which, where there was lack of unity, had to be filed "within two months following the limitation" of the parent application (former Rule 25(1)(b) EPC).

The new Rule 25(1) EPC no longer makes such a distinction, but provides that any divisional application be filed "up to the approval" of the text of the parent patent to be granted.

In the document (CA/29/88 from 16 May 1988), on the basis of which the Rule 25(1) EPC has been adopted by the Administrative Council of the EPO, the following is stated:

"8. No transitional arrangement is necessary since once the proposed decision has entered into force it will not 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."

- IV. By a letter dated 29 June 1989 the Applicant required decisions under Rule 69(2) EPC that the filing of his divisional application was not belated.

With two decisions of 18 June 1990 the Receiving Section of the EPO decided that the two applications No. 88 111 763.4 and 88 111 762.6 could not be treated as divisional applications of application 85 102 131.2. The Receiving Section found that former Rule 25(1)(b) EPC had to be applied. Because the time limit provided in that former Rule had expired, the subject-matter contained in the two applications was "no longer pending in the parent application".

- V. On 30 July 1990 the Applicant filed two appeals against the said decisions, paid the appeal fees; statements setting out the grounds followed on 9 October 1990. The Applicant and Appellant request that the decisions under appeal be set aside and the two applications be treated as divisional applications. He requires reimbursement of the appeal fees. He agrees that the two cases may be dealt with in consolidated proceedings.

Reasons for the Decision

1. The two appeals are admissible and shall be dealt with in consolidated proceedings in accordance with Article 9(2) of the Rules of Procedure of the Boards of Appeal (OJ EPO 1983, 7).

2. There are three reasons which may justify the acceptance of the applications as divisional applications. The first two reasons (2.1 and 2.2.1 shall only be mentioned briefly since the latter (2.3) alone justifies the present decision.
 - 2.1 It is not fully clear whether the Applicant's letter of 13 May 1988 contained an unconditional response to the invitation to establish unity (cf. Decisions J 24-26/82/GRIESEBACH, OJ EPO 1984, 467 and Guidelines C-VI, 9.2). The wording of the letter "we intend to file, without prejudice" indicates reservation and at that stage it was not at all clear that the invention remaining in the parent application would be found to be patentable. So it was still feasible that some of the subject-matter derived from the parent application would be reintroduced. The unclarity of the concept of "limitation at the invitation of the Examining Division" in the former Rule 25(1)(b) EPC was one of the reasons for its revision.

 - 2.2 The opinion expressed in the decision under appeal that, after expiry of the two-month time limit provided for in former Rule 25(1)(b) EPC, the subject-matter derived from the parent application is "no longer pending in the parent application" is liable to misinterpretation. This subject-matter is still "pending before the Office", i.e. "legally

viable"; it could either be reintroduced into the parent application or, at least after the examining proceedings of the latter have been reopened, it could once more become a divisional application. So the Examining Division could have allowed the filing of divisional applications even after the "two-month time limit" of former Rule 25(1)(b) and also after the "approval" mentioned in new Rule 25(1) EPC (cf. the Board's Decision J 1/90, Reasons No. 2).

- 2.3 Notwithstanding the above considerations, both applications can be accepted as divisional applications because they were filed in a period of transition from former to revised Rule 25.

The revised Rule provides a common time limit for the filing of both kinds of divisional applications ("voluntary" and "compulsory"), being "the approval" of the text of the parent application. In the present case the divisional applications were indeed filed before the said "approval" under the new Rule and had not yet been finally declared belated under the old Rule. When the new Rule entered into force on 1 October 1988 the loss of the right to file divisional applications was not yet final. From that date on they can be accepted as having been filed in due time, corresponding to the intention of the Administrative Council set out above (see III).

3. A refund of the appeal fees under Rule 67 is not equitable because there has been no substantial procedural violation.

Order

For these reasons, it is decided that:

1. The decisions under appeal are set aside.
2. The filing of the European patent applications No. 88 111 762.6 and 88 111 763.4 as divisional applications of application No. 85 102 131.1 is allowed.
3. The requests for refund of the appeal fees are rejected.

The Registrar:

The Chairman:

M. Beer

O. Bossung