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D E C I S I O N
of 27 February 1995

Case Number: J 0027/94 - 3.1.1

Application Number: 94100421.0

Publication Number:

IPC: C10G 1/10

Language of the proceedings: EN

Title of invention:

Recovery of commercially valuable products from used rubber tires

Applicant:

UNIVERSITE LAVAL

Opponent:

-

Headword:

Divisional application/UNIVERSITE LAVAL

Relevant legal provisions:

EPC Art. 76, 111(2)

EPC R. 25(1), 51(4)

Keyword:

"Application to be treated as divisional application (yes)"

"Interpretation of a condition declared with the agreement to the text intended for grant"

"Procedural declaration must not be subject to conditions"

"Good faith"

"Venire contra factum proprium"

Decisions cited:

J 0011/85, J 0008/87, J 0010/91, J 0011/91, J 0016/91,

J 0014/94, G 0010/92, G 0002/93, G 0005/93, T 0815/90

Headnote:

I. In the interest of legal security, a procedural declaration has to be unambiguous (Confirmation of J 11/94, to be published). This implies that it must not be subject to any condition, leaving it open whether the EPO can proceed further on the basis thereof.

II. If a declaration subject to a condition is treated as valid procedural act, the EPO is not allowed later to contradict its own earlier conduct because this would offend against the generally recognized prohibition "venire contra factum proprium" (J 14/94, to be published, followed).

III. The binding effect according to Article 111(2) EPC applies only to the case decided upon.

IV. The first instance was not obliged by the principle of good faith to allow the filing of divisional applications after the approval of the text intended for grant on the basis of decision J 11/91 (OJ EPO 1994, 28) until opinion G 10/92 (OJ EPO 1994, 633) was made available to the public.



Case Number: J 0027/94 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 27 February 1995

Appellant: UNIVERSITE LAVAL
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Quebec G1K 7P4 (CA)

Representative: Casalonga, Axel
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Decision under appeal: **Decision of the Receiving Section of the European Patent Office dated 6 July 1994 refusing to treat European patent application No. 94 100 421.0 as a divisional application.**

Composition of the Board:

Chairman: R. Schulte
Members: R. E. Teschemacher
J.-C. Saisset

Summary of Facts and Submissions

- I. European Patent application No. 94 100 421.0 was filed on 13 January 1994. In box 35 of the request form it was indicated that the application was a divisional application from the earlier application No. 90 906 829.8.

- II. In a communication, dated 25 February 1994, the Receiving Section informed the Applicant that the President of the EPO had referred the point of law to the Enlarged Board of Appeal until when may an Applicant file a divisional application on a pending earlier application (case G 10/92, for referral see OJ EPO 1993, 6). As the legal position with regard to this point of law was still unclear, no decision would be taken until the Enlarged Board of Appeal had delivered its opinion.

- III. In its response of 6 April 1994, the Applicant requested that the divisional application be proceeded without delay on the basis of the decision in the consolidated cases J 11/91 and J 16/91 (OJ EPO 1994, 28, hereinafter cited as J 11/91). It was submitted that this decision had created the opportunity to file a divisional application even after the filing of the response to the communication under Rule 51(4) EPC. Neither had the filing of the divisional application affected the approved text nor had the decision to grant for the earlier application been published before the filing of the divisional application. Therefore, the conditions required by J 11/91 had been met. The Applicant had acted in good faith since the EPO had not warned future Applicants that it would not proceed according to the case law. The referral of the point of law by the President of the EPO did not have any suspensive effect. In the case in question it had been clear that a

divisional application would be filed. The Applicant had already indicated in the reply to the first communication that a divisional application would be filed. Thereafter, in response to the communication under Rule 51(4) EPC, it had been explicitly stated, referring to J 11/91, that a divisional application would be filed later. At the latest at that moment, the Applicant could have expected a warning. In the event that the Receiving Section stuck to its position, the Applicant requested an immediate appealable decision.

IV. In a further letter of the same date, re-establishment of rights in respect of the time limit for filing a divisional application was requested and the respective fee was paid. It was indicated that this request was made for safety's sake. The Applicant had given clear instructions to file a divisional application for the subject-matter deleted from the earlier application and indicated that he wished to delay the filing as long as possible. The representative, knowing the decision of the Legal Board of Appeal J 11/91, the headnote of which had been published in OJ EPO 1993, Number 1-2, had advised the Applicant to file the divisional application not later than when filing a response to the communication under Rule 51(6) EPC.

V. He had believed in the correctness of this decision, since there were several decisions of Technical Boards of Appeal, stating that the response to a communication under Rule 51(4) EPC did not constitute a final and irreversible act. Although knowing that the President of the EPO had referred a point of law to the Enlarged Board of Appeal, he could not expect that the EPO would refuse to proceed in accordance with the decision of the Legal Board of Appeal, before the Enlarged Board of Appeal had given its opinion.

- VI. On 6 July 1994, the Receiving Section issued a decision stating that the application would not be treated as a divisional application and refusing the request for re-establishment. In the reasons, the Applicant was informed of opinion G 10/92 (OJ EPO 1994, 633), according to which the filing of a divisional application was not possible after the approval to the text of the parent application pursuant to Rule 51(4) EPC. There had been no reason to follow J 11/91 since a decision of a Board of Appeal was binding only in the case in which it was given. Furthermore, there had been a divergence in case law which the opinion of the Enlarged Board of Appeal had resolved.
- VII. On 9 August 1994, the Applicant filed an appeal against this decision, paying the appeal fee the same day. The Statement of Grounds of Appeal was filed on 4 November 1994.
- VIII. The Appellant submitted that the reply to the communication under Rule 51(4) EPC was not limited to the approval of the text proposed for grant. Additionally, it contained an explicit declaration of intention to file a divisional application for the subject-matter deleted in the parent application, which was clearly defined as Claims 1-7. Since Article 76 and Rule 25 EPC did not require a specific form, this declaration should be regarded as the filing of a divisional application. Furthermore, the declaration did not contain a clear and final approval of the text because it expressed the clear intention to have the previously deleted subject-matter protected by means of a divisional application.
- IX. Alternatively, the Appellant argued that the Receiving Section was bound by decision J 11/91, as confirmed by decision J 11/90 of 6 August 1992 (not published in

OJ EPO), according to Article 111(2), first sentence, EPC, since the facts of the present case were the same as in the cases previously decided. These decisions were in line with decisions concerning Rule 25 EPC, as in force until 1 October 1988, according to which the filing of a divisional was not excluded after approval of the text intended for grant. The filing of the present application, simultaneously with the reply to the communication under Rule 51(6) EPC, had been made relying on decisions published in the Official Journal and giving a clear answer to the conflict between Article 76 and Rule 25 EPC. If the EPO did not intend to follow the case law, it should have given a warning that a divisional application could still be filed until the end of the time limit pursuant to Rule 51(4) EPC. Alternatively, the Examining Division should have sent a communication under Rule 51(5) EPC or should have resumed the examination. According to the principle of good faith, as recognized in the case law of the Boards of Appeal, the legitimate expectations of Applicants had to be protected. The Appellant was entitled to expect that the EPO applied Article 76 and Rule 25, as interpreted in J 11/91, to cases filed until decision G 10/92 was made available to the public. This would correspond to the rule applied by the Enlarged Board of Appeal in decision G 5/93 (OJ EPO 1994, 447).

- X. The Appellant requested that the present application be treated as a divisional application of application No. 90 906 829.8.

Reasons for the Decision

1. The admissible appeal lies from the decision of the Receiving Section refusing to treat the present application as a divisional application. The decision was based on the opinion G 10/92 (supra) of the Enlarged Board of Appeal, stating that an Applicant may only file a divisional application on the pending earlier application up to the approval in accordance with Rule 51(4) EPC.

2. The Board cannot accept the Applicant's position that it filed a divisional application when replying to the communication under Rule 51(4) EPC. First, the wording of the declaration made at this date "the Applicant ... will file in due course a divisional application" makes it clear that the Applicant wished to express its intention to file an application in the future, but not by this declaration itself. Secondly, the requirements for according a filing date for filing a divisional application were not fulfilled at that date, in the absence of any documents filed which could be regarded as description and claim(s) for this application (Article 80(d) in connection with Article 90(1)(a) EPC).

3. Contrary to the Appellant's submissions, the Receiving Section was not bound by the decision of the Legal Board of Appeal to allow a divisional application after the approval of the text of the earlier application. The Appellant seeks to derive this from Article 111(2), first sentence, EPC, according to which the department of the first instance is bound by the ratio decidendi of a Board, in so far as the facts are the same. This binding effect ensues, however, only in the individual case which the Board has remitted to the first instance, as the introductory part of the provision makes clear. A

binding effect for cases in respect of which no decision has been taken by the Board, is not foreseen in Article 111 EPC (cf van Empel, *The Granting of European Patents*, Leyden 1975, no. 519).

4. Moreover, the Appellant's argument J 11/91 is binding on the first instance on the basis of the principle of "good faith" is not valid. In general, there will be good reasons for the first instance to follow the decisions of the Boards of Appeal, in order to maintain a consistent practice and to avoid unnecessary appeals. There is, however, no principle in the EPC preventing the first instance from having a question which has already been decided upon by a Board reconsidered in another case by the same or another Board. This may in appropriate cases contribute to developing the law (see for example the following decisions concerning the interpretation of Rule 28(2) EPC: J 8/87, OJ EPO 1989, 9; Examining Division, OJ EPO 1990, 156 - "Rockefeller"; T 815/90, OJ EPO 1994, 389; G 2/93, of 21 December 1994, to be published, headnote in OJ EPO 1995, Number 1-2).
5. There may be cases in which the public has a legitimate expectation that the first instance will not deviate from the established case law. This might be accepted if this case law had become part of a consistent practice of the first instance, in particular if this had been made known to the public by published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an Applicant may legitimately expect that a practice allowing or even recommending a certain procedural conduct will not be changed without appropriate advance information.
6. Such circumstances have not been shown in this case. The headnote of decision J 11/91 was published in the same issue of OJ EPO as the referral of the point of law to

the Enlarged Board of Appeal (OJ EPO 1993, 6). Taking this information into account, there was no reason to believe that the first instance would follow J 11/91 in future cases. On the contrary, the Guidelines for Examination in the EPO, A-IV, 1.1.2, remained unchanged, which fact gave reason to expect that also the practice based on them would not be changed. In this respect, the facts of the present case differ substantially from those of case G 5/93 in which the EPO had expressly drawn the Applicants' attention to the opportunity provided by the case law to have the application restored after certain losses of rights (Information for PCT Applicants, OJ EPO 1991, 328, B.I.7, C.7). The reasons why the Enlarged Board of Appeal in G 5/93 allowed the application of the interpretation of an overruled decision in pending cases, do not exist in this case.

7. For the reasons outlined above, Rule 25 EPC, in the interpretation given by the Enlarged Board of Appeal, is applicable to this case. The decision under appeal was, however, wrong in interpreting the declarations made by the Applicant in reply to the communication under Rule 51(4) EPC.

8. It is true that the first sentence of the letter in response to the communication contained an approval of the text notified to the Applicant which was, seen in isolation, clear and unequivocal. The Applicant declared, however, additionally in the second sentence that he would file a divisional application for the matter deleted from the application in due course, referring to decision J 11/91. These two declarations cannot be separated from each other without neglecting their correlation and mutual dependence. The Applicant had made it quite clear that he was declaring his approval because it was still possible to file a

divisional application thereafter, according to the case law on which he relied. For this reason, the second sentence should have been regarded as integral part of the declaration of approval. Hence, the Examining Division should not have treated the letter as a valid approval under Rule 51(4) EPC, because it contained a condition which made the approval invalid. The approval of the text intended for grant is a necessary requirement for the next step in the proceedings, i.e. the communication under Rule 51(6) EPC. It must be clear for the EPO when receiving the declaration whether or not it is an appropriate basis for the dispatch of this communication. In the interest of legal security the Board has stated that procedural declarations have to be unambiguous (J 11/94, to be published in OJ EPO). This implies that such a declaration must not be subject to any condition, leaving it unclear whether or not the EPO can proceed further on the basis thereof. The Examining Division should have objected to the invalid approval, with the eventual consequence foreseen in Rule 51(5), first sentence, EPC.

9. On the basis of Rule 25 EPC, in the light of decision G 5/93, the Examining Division was wrong in not following the course of action outlined in the preceding paragraph. By not objecting to the approval, the Examining Division accepted the Applicant's declaration as a whole, i.e. that the text was approved and that the filing of a divisional application was still possible under the conditions laid down in J 11/91. By the implicit acceptance of the Applicant's position, the Examining Division created the legitimate expectation that the filing of a divisional application would not be objected to. It would contravene the principle of good faith if the EPO were allowed to contradict its earlier conduct of the proceedings which served as a basis for the applicant's decision how to proceed. This would

constitute "venire contra factum proprium" which is not allowed in proceedings before the EPO (J xx/87, OJ EPO 1988, 323, point 3.14 of the reasons; J 14/94, of 15 December 1994, to be published). Therefore, the EPO is prevented from contesting the Applicant's right to file a divisional application with the reply to the communication under Rule 51(6) EPC.

10. The request for re-establishment of rights, filed as a precautionary measure, is unnecessary. The payment of the respective fee was without foundation and the fee is therefore to be refunded to the Appellant (J 11/85, OJ EPO 1986,1).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The application is to be treated as a divisional application of application No. 90 906 829.8.
3. The fee for re-establishment is to be refunded.

The Registrar:



M. Beer

The Chairman:



R. Schulte

