

**Decision of the Legal Board of Appeal dated 6 May 1999**

**J 8/98 - 3.1.1**

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset

Members: R. E. Teschemacher

V. Di Cerbo

**Applicant: N.N.**

**Headword: Divisional application**

**Article: 76, 113 EPC**

**Rule: 25(1), 51(4), 66(1) EPC**

**Keyword: "Application to be treated as a divisional application (yes)" - "No communication under Rule 51(4) EPC in the earlier application"**

*Headnote*

*I. In oral proceedings before a Board of Appeal, the approval of a text in which the patent is to be granted is implied, in the absence of exceptional circumstances, in the appellant's request to take a decision on the text he submitted to the Board.*

*II. Such approval which is not expressed in the form specified by Rule 51(4) EPC does not exclude the filing of a divisional application filed after remittal to the first instance.*

## **Summary of facts and submissions**

I. European patent application No. 97 ... was filed on 23 May 1997 as a divisional application on European application No. 90 ... .

II. After refusal, the earlier application had been the subject of appeal proceedings T ..... . In the oral proceedings, Technical Board of Appeal 3.5.2 announced its decision to remit the application to the Examining Division with the order to grant the patent with the complete set of documents submitted in the oral proceedings. On 4 March 1997, the Examining Division issued a communication under Rule 51(6) EPC inviting the Applicant to fulfil the formal requirements for grant. The Applicant requested the communication be withdrawn and a communication under Rule 51(4) EPC be issued in order to allow the filing of a divisional application. The Applicant was informed that a communication under Rule 51(4) EPC could no longer be issued since he had approved the text intended for grant already during the oral proceedings before the Board of Appeal. On 24 July 1997, the decision to grant the patent on the earlier application was issued.

III. With respect to the present application, the Receiving Section issued, on 2 July 1997, a communication pursuant to Rule 69(1) EPC stating that the application could not be treated as a divisional application because it was filed after approval had been indicated in respect of the earlier application in accordance with Rule 51(4) EPC. On 26 August 1997, the Applicant applied for a decision under Rule 69(2) EPC arguing that, in the absence of a communication under Rule 51(4) EPC in the earlier application, the present application must be accepted as a divisional application.

IV. On 19 November 1997, the Receiving Section issued a decision refusing to treat the application as a divisional application on the following grounds:

The order of the decision of the Board of Appeal contained the text of the patent to be granted in conformity with the Applicant's request. The first instance could not

change the decision of the Board and, therefore, did not issue a communication under Rule 51(4) EPC. Since the Applicant and the Board agreed upon the final text during the oral proceedings, a divisional application should have been filed at that point in time.

V. On 28 January 1998, the Applicant filed a notice of Appeal against this decision, paying the appeal fee on the same day. The Statement of Grounds of Appeal was filed on 18 March 1998.

VI. The Appellant argued that the submission of documents in the oral proceedings before the Technical Board of Appeal was a mere suggestion to have a patent granted on this basis and could not be regarded as an approval of this text. Therefore, a communication under Rule 51(4) EPC should have been issued asking for his final approval under Articles 97(2)(a) and 113 EPC. This should have been done either by the Board of Appeal acting within the power of the Examining Division pursuant to Article 111(1) EPC or by the Examining Division after remittal of the case. In addition, even if his declarations in the oral proceedings before the Technical Board of Appeal were to be understood as an approval of the text, this was not an approval within the meaning of Rule 51(4) EPC. Since Rule 25 EPC defined the last point in time for filing a divisional application with an express reference to an approval in accordance with Rule 51(4) EPC, an applicant could only be denied the right to file a divisional application if a communication as foreseen in Rule 51(4) EPC had actually been issued.

VII. The Appellant requests that the present application be treated as a divisional application on European application No. 90 ...

### **Reasons for the decision**

1. The appeal is admissible.

2. In the decision under appeal, the Receiving Section took the position that a communication under Rule 51(4) EPC cannot be issued after remittal of a case to the Examining Division with the order to grant the patent as requested in the oral proceedings before the Board.

2.1 The Board cannot agree with the Appellant's objections to this starting point. The decision of a Board defining the text in which the patent is to be granted or maintained has the effect that this text becomes *res judicata* and can no longer be amended in proceedings before the EPO (T 843/91, OJ EPO 1994, 818). The question to the applicant whether he approves the text only, however, makes sense as long as this text is open to changes. Once the text has become *res judicata*, the applicant as well as the EPO is bound to the result of the substantive examination. The applicant has to accept the patent in the version defined in the order of the decision. No invitation is necessary to give the applicant the possibility to file a declaration to this effect. If he is no longer interested he may withdraw the application.

2.2 Nor can the Board agree with the Appellant's alternative opinion that the Technical Board of Appeal itself should have issued a communication under Rule 51(4) EPC before remitting the case. Rule 51(4) EPC belongs to the provisions concerning the examination by the Examining Division. Unless otherwise provided, such provisions apply to appeal proceedings only *mutatis mutandis* (Rule 66(1) EPC).

2.2.1 For the parallel situation in opposition appeal proceedings, a communication under Rule 58(4) EPC is only considered necessary if the parties cannot reasonably be expected to state their observations definitively during the oral proceedings (T 219/83, OJ EPO 1986, 211 and the other decisions cited in Case Law of the Boards of Appeal of the EPO, 3rd ed. 1998, VI.C.2.5). This practice is based on the purpose of Rule 58(4) EPC which is to ensure that due account is taken of the principles of due process set out in Article 113 EPC. If it is clear that the text

corresponds to the request of the party (Article 113(1) EPC) and if the parties had sufficient opportunity to appreciate the significance of any amendments (Article 113(2) EPC) the principles enshrined in Article 113 EPC are adequately met (T 219/83 supra, Reasons, pt. 15).

2.2.2 These considerations apply equally to the situation of oral proceedings before a Technical Board of Appeal when an appeal has been lodged against a decision of the Examining Division. If the applicant is present and requests the patent be granted on a complete set of documents submitted by him, the Board willing to give a positive decision on that basis may, in the absence of exceptional circumstances, assume that the applicant has carefully considered his requests. The dialogue in the oral proceedings gives the applicant ample opportunity to make his position clear. If he considers a further check of the documents necessary, eg because the discussions in the oral proceedings resulted in significant amendments, he may request to be given an opportunity to do so. In the absence of any reservation in this direction, he cannot expect a further opportunity to comment on the version submitted by himself or to amend it once more. It is the purpose of oral proceedings before the Board to come to a final decision (Article 11 of the Rules of Procedure of the Boards of Appeal) and sending a further communication as a routine measure would result in a substantial delay in the proceedings. At the end of the oral proceedings in the second instance, normally the factual and legal issues should be clarified and the applicant should be able to come to a final position in respect of the version of the patent to be granted. Accordingly, it is the consistent practice of the Technical Boards of Appeal to order the grant of the patent in the version of a complete set of documents submitted by the applicant, without issuing a communication under Rule 51(4) EPC after oral proceedings have taken place. This is in agreement with Article 113(2) EPC. This provision provides expressly for two alternative situations from which the applicant's approval can be concluded, ie the submission of a text by the applicant or the applicant's agreement to a text.

2.2.3 The Appellant's allegation that his submission of a complete version of the patent to be granted was a mere suggestion is contrary to the minutes of the oral proceedings before the Technical Board of Appeal. There it is stated that the Appellant's representative requested that a patent be granted on the basis of these documents. This wording excludes the possibility that the submission of the documents was a mere basis for discussion as distinguished from a request, ie a procedural declaration to the Board for a decision to be made on that basis.

2.3 The fact that in the earlier application there was a validly approved text without a communication under Rule 51(4) EPC does not, however, justify the Receiving Section's conclusion that the filing of a divisional application after that approval was excluded under Rule 25 EPC.

2.3.1 According to Rule 25(1) EPC, a divisional application may be filed up to the approval of the text, **in accordance with Rule 51(4) EPC**, in which the patent is to be granted. Rule 51(4) EPC prescribes a certain form in which the approval has to be established, in particular a communication to the applicant with a specified time limit. Such a communication has not been issued. Therefore, a requirement expressly foreseen in Rule 25(1) EPC has not been fulfilled.

2.3.2 This leaves the question whether Rule 25(1) EPC may be applied by analogy to a situation outside its explicit wording. Rule 25 EPC implements Article 76 EPC laying down the procedure for filing divisional applications, in particular setting a deadline for filing divisional applications (G 10/92, OJ EPO 1994, 633, Reasons, pt. 4). This deadline aims at setting a clear point in time for both the applicant and the EPO, with the additional advantage of allowing the applicant to determine this point himself (G 10/92, supra, Reasons, pt. 10). Apparently, the legislator chose this point in time for reasons of procedural economy. In drafting Rule 25(1) EPC, the legislator had the possibility to refer to the applicant's approval in general. Instead, reference was made to a specific type of approval. It is not apparent that this was done inadvertently. Rather, the legislator seems not to have envisaged at all the situation

of an approval without a preceding communication under Rule 51(4) EPC. The Board might fill this lacuna applying Rule 25(1) EPC by analogy if the legislator could be assumed to have treated both types of approval in the same way. The question is whether the final approval in oral proceedings before a Technical Board of Appeal is equivalent to the approval in reply to a communication under Rule 51(4) EPC for the application of Rule 25(1) EPC.

It appears that both situations are in certain respects different. Whereas it is true that the date of the oral proceedings before the Board is foreseeable for the applicant, the outcome of the oral proceedings is not always. This outcome may be most important for the applicant's decision whether to file a divisional application and for which subject matter. In the written procedure the applicant is given a time limit after having been informed of the result of the substantive examination, even with the possibility of one extension, for deciding whether to approve the text and for preparing a divisional application if appropriate. In oral proceedings, however, he has to react immediately. The filing of a divisional application on the same day for subject matter still to be defined may pose some administrative problems at the very least.

Hence, the legislator might have regarded it as fair to give the applicant an opportunity after the oral proceedings to prepare a divisional application on the still pending earlier application. A later appropriate deadline might have been the fulfilling of the formal requirements for grant by the applicant in reply to the communication under Rule 51(6) EPC. Even a later point in time might have been chosen up to the decision to grant. The choice of the appropriate deadline for filing a divisional application in the situation under consideration appears to be a matter of legislative discretion. It is not apparent that allowing the filing of a divisional application after approval in oral proceedings before a Board of Appeal would entail significant practical difficulties. Since the legislator, realising the legislative gap and balancing the applicant's interests and administrative needs, might well have chosen other possible solutions, there is no sound basis to assume that he would have considered the situation under consideration as equivalent to the approval in reply to a

communication under Rule 51(4) EPC. In this situation, the Board abstains from applying Rule 25(1) EPC by analogy, which means that the Appellant was not excluded from filing a divisional application by approving the text of the earlier application in the oral proceedings before the Technical Board of Appeal.

### **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 on application No. 90 ...