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Aktenzeichen / Case Number / N° du recours : T 229/86 - 3.5.1

Anmeldenummer / Filing No / N° de la demande : 80 107 868.4

Veröffentlichungs-Nr. / Publication No / N° de la publication : 030 725

Bezeichnung der Erfindung: Cooling an alternating current generator with a
Title of invention: voltage regulator unit for use in vehicles
Titre de l'invention :

Klassifikation / Classification / Classement : H02K 5/04

ENTSCHEIDUNG / DECISION

vom / of / du 28 September 1988

Anmelder / Applicant / Demandeur : NIPPONDENSO CO. LTD

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Divisional application/Nippondenso

EPÜ / EPC / CBE Article 76(1), Rule 25(1)(a)

Schlagwort / Keyword / Mot clé : "Request to file divisional application after approval of text of parent application" - "no amendments to parent application sought" - "filing justified".

Leitsatz / Headnote / Sommaire

I. After the text of an application has been approved in accordance with Article 97(2)(a) EPC and prior to grant, Rule 25(1)(a) EPC* does not preclude the filing of a divisional application.

II. In a case where the applicant requests the approval of the Examining Division for the filing of a divisional application on the basis that no amendments to the parent application are sought, the filing of the divisional application may be justified.

* in force before the amendment of Rule 25 EPC made by the Administrative Council on 10 June 1988, which came into effect on 1 October 1988.

III. Whether the divisional application meets the substantive requirements of the EPC (including the substantive condition in Article 76(1) EPC, second sentence) is not relevant to the question whether the filing of the divisional application is justified and should be considered at the stage of substantive examination of the divisional application.

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Chambres de recours



Case Number : T 229/86

D E C I S I O N
of the Technical Board of Appeal
of 28 September 1988

Appellant : NIPPODENSO CO., LTD
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Kariya-shi Aichi-ken (JP)

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Decision under appeal : Decision of Examining Division 054
of the European Patent Office
dated 29 November 1985 considering
the filing of European patent
application No. 84 114 880.2 to be
not justified under Rule 25(1)(a)
EPC

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : G.D. Paterson
C. Payraudeau
J.A.H. van Voorthuizen
W.B. Oettinger

Summary of Facts and Submissions

I. European patent application No. 80 107 868.4 was filed on 12 December 1980. In due course, by an Advance Notice dated 28 May 1984, the Examining Division informed the Appellant of the text in which it intended to grant the patent. A Communication under Rule 51(4) EPC was issued on 14 August 1984. Within the three months time limit provided by that Communication the fees for grant and printing were paid, and translations of the claims were filed. The three months period expired on 25 November 1984, and no disapproval of the text was communicated by the Appellant. Accordingly, by virtue of Article 97(2)(a) EPC it was at that date established that the Appellant approved of the text of the application. A Decision to grant the patent was issued on 23 January 1985.

II. On 6 December 1984 the Appellant filed a divisional application, No. 84 114 880.2, and on 10 December 1984 he filed a letter (dated 6 December 1984) requesting that the Examining Division approve the filing of that divisional application. The Examining Division issued a Communication dated 23 May 1985, which set out general reasons why, when the procedure of the parent application is far advanced, reopening of the examining procedure may only take place because of very exceptional circumstances, and that no special circumstances had been put forward by the Appellant. Furthermore, the Communication pointed out that the claims filed with the divisional application partly overlap with those contained in the parent application.

In his reply dated 12 July 1985, the Appellant denied that the reasoning of the Communication applied to the present case, because he had no intention to make amendments to the parent application or otherwise to reopen the examining

procedure in the parent application. He would pay an examination fee for a further examination procedure under the divisional application, which refers to a second different subject-matter from that of the parent application. Any overlapping of the claims could be eliminated during the further examination procedure, and was not a reason for not allowing the filing of the divisional application. The Appellant wanted the parent application to be maintained in its granted form. As justification for the late filing of the divisional application, he stated that an economic demand had recently arisen for the second subject-matter which had been disclosed but not claimed in the parent application.

III. The Examining Division issued a Decision on 29 November 1985, in which it held that it was not justified for the Appellant to file a divisional application under Rule 25(1)(a) EPC, and accordingly it denied its approval for such a filing. The reasons for the Decision were similar to those set out in the Communication dated 23 May 1985, and were essentially as follows:

- (i) The considerations which affected the possible justification of the filing of a divisional application under Rule 25(1)(a) EPC were similar to those which affected the possible allowing of amendments to be filed under Rule 86(3) EPC. The underlying reason for both provisions is to speed up proceedings and to avoid reopening questions which have already been dealt with or which would have been dealt with if the applicant had reacted in time.
- (ii) The divisional application in the present case was filed after the text of the parent application had been approved. At that stage in the proceedings the

grant procedure would be reopened only in very exceptional circumstances. The applicant cannot intervene at this stage. The consent of the applicant to the intended text of the patent means that he has finally disposed of the disclosure of the application as a whole.

- (iii) Amendments to the application at this stage, or the filing of a divisional application, would be a reopening of the examination procedure.
- (iv) The Appellant's suggestion of a late economic demand did not convince the Examining Division, and was furthermore not substantiated. Without any special justification the Examining Division could not allow a divisional application to be filed, especially as the claims of the divisional application partly overlap those in the parent application.
- (v) To give consent to the filing of a divisional application after the Appellant has approved of the text of the parent application, and fulfilled the formal requirements for that application, would lead to a reopening of the proceedings of the parent application.

IV. A notice of appeal was filed on 15 January 1986 and the appeal fee duly paid. A statement of grounds of appeal was filed on 8 April 1986.

The submissions of the Appellant were similar to those previously set out in his letter dated 12 July 1985, and can be summarised as follows:

- (i) The Appellant does not wish to amend the wording of the parent application, now a granted patent.

Therefore, no reopening of the proceedings of the parent application is intended or necessary.

- (ii) Rule 25(1)(a) EPC allows the filing of a divisional application at two stages in the examination procedure. During the second stage such filing has to be "justified", and such justification is concerned with not causing delays in the examination procedure.

If the filing of a divisional application causes no delay in the examining procedure, the consent of the Examining Division should be essentially formal.

- (iii) The Appellant has an economic interest in filing a divisional application and such economic interest arose late.
- (iv) The question of possible overlap of the claims is a matter to be discussed during the substantive examination of the divisional application.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC, and is admissible.
2. Rule 25(1)(a) sets out the circumstances when an applicant for an earlier application may file a divisional application in respect of such earlier application, in the case when no objection of lack of unity of invention has been made under Article 82 EPC. It provides that such a divisional application may be filed "at any time after the date of receipt of the earlier ... application ... , 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".

3. Insofar as this Rule provides that "the Examining Division" should consider such a filing to be justified, this must be a reference to the Examining Division responsible for the examination of the parent application. In the present case, the divisional application was filed before the Decision to grant was issued, so the Examining Division was still responsible for the parent application when the divisional application was filed.

It was not filed, however, during the period prescribed in the first Communication from the Examining Division, and so cannot be filed as of right, but only as a matter of discretion. The appeal therefore raises the question as to what are the proper considerations to be taken into account by the Examining Division when deciding whether or not the filing of a divisional application is "justified".

4. The filing of a European divisional application is governed by Article 76 EPC (Rule 25 EPC being the Implementing Regulation for this Article). The second sentence of Article 76(1) EPC provides that a divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". This provision generally corresponds to Article 123(2) EPC, and constitutes a substantive condition for allowability of the divisional application. Article 76 EPC does not contain a provision corresponding to Article 123(3) EPC, however. It is thus necessarily envisaged that a divisional application may include claims which seek protection for different subject-matter from that which is defined in the claims of the earlier, parent application -

provided that such different subject-matter is within the content of the parent application as filed. The criterion for admissibility of the subject-matter of the claims of the divisional application is the same as set out in Article 123(2) EPC in relation to amendment of a normal application. The subject-matter of the amended claims in a normal application or of the proposed claims in a divisional application may be such as to extend the protection conferred and thus to broaden or extend the scope of the claims, as compared to the claims which were originally filed - see for example Decision T 66/85, dated 9 December 1987 (to be published), in relation to amended claims.

- 4.1. The broadening (i.e. extending) of the claimed subject-matter while an application is pending, either by way of amendment of that application or by the filing of a divisional application, is a matter which affects other persons who may wish to carry out commercial activities in relation to the invention(s) which are the subject-matter of such application(s). It could, therefore, be said that there is a public interest against extending the claimed subject-matter in the application with regard to the claims as originally filed -especially having regard to the fact that European patent applications are published at a relatively early stage.

Nevertheless, as set out above, the EPC recognises that the claimed subject-matter of an application may be extended beyond the scope of the claims as originally filed, during the time when the application is pending, either by way of amendment of the application or by filing a divisional application. This is in contrast to the position during opposition proceedings, i.e. after grant of the patent, when Article 123(3) EPC prohibits amendment of the patent "in such a way as to extend the protection conferred".

Interested members of the public are thus put on notice by the EPC that after a European patent application has been filed, while the content of that application cannot thereafter be extended, nevertheless, while the application is pending the protection sought by the claims may be extended beyond that sought in the claims as originally filed. The public are informed as to the content of the application as filed when the application is published - see Article 93(2) EPC.

- 4.2 A divisional application does not necessarily include claims seeking protection beyond what was originally claimed. In providing that a divisional application may only be filed during the later stages of examination of the parent application if "the Examining Division considers the filing of a divisional application to be justified", Rule 25(1)(a) EPC does not give any indication at all that a divisional application whose claims are broadened beyond the scope of the claims as originally filed should be considered differently from a divisional application whose claims are not so broadened. If the EPC had intended that in exercising its discretion under Rule 25(1)(a) EPC the Examining Division should pay particular regard (in the public interest) to whether or not the proposed divisional application contains claims which are broader than those originally filed, it is to be expected that Rule 25(1)(a) EPC would contain some clear indication to this effect.

It follows that in the Board's view, the fact that the proposed divisional application contains claims which are of different scope from those which were originally filed is not a factor which should be taken into special account when considering whether the filing is justified.

The Board notes that this view is consistent with the relevant contents of the "Guidelines for Examination in the EPO" at C-VI, 9.3, at the time the appealed decision was taken, i.e. the March 1985 version of this part of the Guidelines, where it is stated that "Unless the Examining Division has already sent out the communication under Rule 51(4) EPC, the filing of a divisional application should normally be allowed" (provided that the application meets the substantive conditions there set out) (emphasis added).

- 4.3 The above sentence of the Guidelines implies that as a general rule, after the communication under Rule 51(4) EPC in the parent application has been sent out, the filing of a divisional application is not allowable. This sentence was probably written having regard to the common situation when a divisional application is filed that amendments to the parent application are also applied for, and that such amendments would effectively require interferences with and re-opening of the examining procedure of the present application. However, the present case is an exceptional case in that the Appellant's representative has expressly stated that he wishes to file the divisional application on the basis that no amendments to the parent application will be made.

The Board notes that in Decision J 34/86 "Divisional application/Bowles" dated 15 March 1988 (to be published), the Legal Board of Appeal at paragraph 1 referred to the above-quoted passage in the Guidelines, and said "As pointed out by another Board in case T 92/85 (OJ EPO 1986, page 352) this general rule (no divisional application after the Rule 51(4) EPC communication) may, however, be departed from in exceptional cases". This Board agrees that in particular cases it may be found to be justified that a divisional application is filed after the Rule 51(4) EPC communication has been sent.

- 5.1 The main basis for the Decision dated 29 November 1985 of the Examining Division not to approve the filing of the divisional application is that "the filing of a divisional application would be a reopening of the examining procedure". This seems to ignore the express statement by the Appellant's representative in his letter dated 12 July 1985 that "the applicant has no intention to make amendments to the parent application or to reopen this examination procedure." In any event, the Appellant approved the text of the parent application (see paragraph I above) before he filed the divisional application. Therefore, the question of justification in this case must be considered on the basis that the parent application will not be affected in any way by the filing of the divisional application. It follows that the main basis for the Decision as set out above is incorrect.
- 5.2 Furthermore, the Board does not agree with the statement in the Decision that "The consent of the Applicant to the text (of the parent application) proposed for grant means that he has finally disposed of the disclosure of the (parent) application as a whole." In the Board's view there is nothing in Rule 25(1)(a) EPC or elsewhere in the Convention which precludes the filing of a divisional application after the text of the parent application has been approved - provided such filing is "justified".
- 5.3 In the Board's view, on the proper interpretation of Rule 25(1)(a) EPC there is no need for the Appellant to establish that there are good economic reasons for filing a divisional application, for example. This can be assumed from the desire to file a divisional application.

- 5.4 The Decision also referred to the fact that "the claims filed with the divisional application partly overlap those contained in the parent application for which the decision to grant has already been given", as a further basis for disapproval of the filing of the divisional application. The Appellant has contended that if the filing of the divisional application is approved, he will duly pay the examination fee and any such overlap of the claims can be discussed and dealt with during the examination procedure of the divisional application (for which he will have paid). In the Board's view, having regard to the Appellant's prior approval of the text of the parent application and his statement that he does not wish to amend the parent application, the Appellant is correct that any such present overlap does not provide a ground for disapproval of the filing of the divisional application.
- 6.1 A particular purpose of the provision in Rule 25(1)(a) EPC that the filing of a divisional application must be justified (during the later stage of the examination procedure of the parent application) is to prevent undue interference with and prolongation of such examination procedure, and to ensure that such procedure is expeditious and efficient.
- 6.2 In particular cases there may be particular reasons why the filing of a divisional application is not justified. Examples of such cases are illustrated by Decision J 15/85 "Abandonment of claim" (OJ EPO 12/1986, page 395), and Decision T 5/86 "Newman's Energy Device" dated 18 March 1988. However, in an exceptional case such as the present where the parent application will not be affected at all by the filing of the divisional application, and where there are no other particular circumstances weighing against the filing of a divisional, the Board considers that the proposed filing is sufficiently justified.

- 6.3 Whether or not the subject-matter of the divisional application is novel and inventive is, of course, a matter to be considered during the substantive examination of the divisional application. However, in the Board's view, in the circumstances of the present case the Appellant should be allowed to file his divisional application in respect of subject-matter which (according to the Appellant) has been disclosed in the parent application as originally filed (which was subsequently published in accordance with Article 93(2) EPC) but which has not yet been claimed.
- 6.4 After the Appellant has filed his divisional application, in due course the examination fee for such application must be paid. All substantive questions relating to the divisional application, including the substantive condition for allowability set out in Article 76(1) EPC (second sentence), should be considered by the Examining Division appointed for its examination procedure after the request for examination has been filed, including payment of the fee for examination; they should not be considered by the Examining Division for the parent application when it is merely deciding whether the filing of a divisional application is justified. In this respect this Board does not agree with the sentence in parentheses in paragraph 4.2 above.

In this connection, it is to be noted that Rule 25(1) EPC allows a divisional application to be filed during examination and before the reply to the first communication without any justification, and therefore without any check upon the substantive condition of Article 76(1) EPC, second sentence. It would therefore be illogical for justification for filing a divisional application at a later stage to be dependent upon whether such substantive condition in Article 76(1) EPC is satisfied.

This seems to be more in accordance with paragraph C-VI, 9.3 of the Guidelines in its recent version of July 1987.

- 7.1 It follows from the above that in the present case, in the Board's judgement, the filing of a divisional application is justified. However, the Board notes that the Decision of the Examining Division was understandable having regard to the wording of the Guidelines at the time of their Decision (see paragraph 4.2 above).
- 7.2 Article 111(1) EPC provides that in deciding on an appeal, a Board of Appeal may exercise any power within the competence of the department which was responsible for the decision appealed. Accordingly, the Board decides that the filing of the divisional application in the present case is justified.

Order

For these reasons, it is decided that:

1. The appeal is allowed.
2. The filing of European divisional application No. 84 114 880.2 is justified and allowed.

The Registrar:

The Chairman:

S. Fabiani

P.K.J. van den Berg