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Datasheet for the decision of 28 June 2007

Case Number: G 0001/06

Application Number: 01128824.8

Publication Number: 1227469

IPC: G09G 3/36

Language of the proceedings: EN

Title of invention:
Liquid Crystal Device

Applicant:
SEIKO EPSON CORPORATION

Opponent:
-

Headword:
Sequences of divisionals/SEIKO

Relevant legal provisions:
EPC Art. 54(3), 75(2), 76(1) (2)(3), 77(5), 82, 96(2), 97(1), 100(c), 102(3), 112(1)a, 113(1), 123(1)(2), 138(1)c and 138(2)
EPC R. 25(1)(2), 51(2), 86(3), 86(4)
RPEBA Art. 8
UK Patents Act 1977: Sections 76(1), 130(7)

Keyword:
"Invalidity as a result of non-compliance with Article 76(1) EPC on filing a divisional application - no"
"Amendment to conform with Article 76(1) EPC - allowable, even if at time of amendment earlier application no longer pending"
"Content of a member of a sequence of divisional applications must be disclosed in each of the preceding applications in the sequence as filed."
"Claims of a member of a sequence of divisional applications need not be directed to subject matter within the scope of the claims of the preceding applications in the sequence as filed."

Decisions cited:
G 0001/93, G 0004/98, J 0015/85, J 0002/01, T 0514/88, T 0527/88, T 0122/90, T 0860/90, T 0441/92, T 0873/94, T 0276/97, T 0904/97, T 1074/97, T 0555/00, T 0561/00, T 0743/00, T 1004/90, T 1158/01, T 0720/02, T 0797/02, T 0039/03, T 0090/03, T 0873/04, T 1040/04, T 1092/04, T 1409/05

Hydroacoustics Incorporated's Applications [1981] FSR 538

Headnote:
In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1), second sentence, EPC that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed.

Case Number: G 0001/06

D E C I S I O N
of the Enlarged Board of Appeal
of 28 June 2007

Appellant: (Applicant)
SEIKO EPSON CORPROATION
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Representative:
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Referring Decision:
Interlocutory decision of the Technical Board of Appeal 3.4.03 dated 30 March 2006 in case T 1409/05.

Composition of the Board:

Chairman: P. Messerli
Members: S. Perryman
P. Alting Van Geusau
B. Günzel
C. Holtz
A. Nuss
Sir N. Pumfrey

Summary of Facts and Submissions

I. Technical Boards of Appeal 3.4.02 and 3.4.03 have referred similar points of law to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

By an interlocutory decision in case T 39/03 (OJ EPO 2006, 362), Technical Board of Appeal 3.4.02 referred the following questions to the Enlarged Board of Appeal (considered under number G 1/05):

(1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?

(2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?

(3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

II. By an interlocutory decision in case T 1409/05 (OJ EPO 2007, 113), Technical Board of Appeal 3.4.03 referred

the following questions to the Enlarged Board of Appeal (considered under number G 1/06):

(1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?

(2) If the above condition is not sufficient, does said sentence impose the additional requirement

(a) that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its divisional predecessors? or

(b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?

III. Pursuant to Article 8 of the Rules of Procedure of the Enlarged Board of Appeal, the Enlarged Board decided by decision of 6 April 2006 to consider the above points of law referred respectively in case T 39/03 (G 1/05) and case T 1409/05 (G 1/06) in consolidated proceedings and decided by decisions of respectively 24 October 2005 and 6 April 2006 to invite the President of the EPO to comment in writing on the respective points of law.

In a decision in case T 1040/04 (OJ EPO 2006, 597), Technical Board of Appeal 3.2.03 referred a question of law to the Enlarged Board of Appeal (considered under number G 3/06) concerning amendment of a patent granted on a divisional application which at its actual date of filing extended beyond the content of the earlier application. By decision of 9 May 2006 the Enlarged Board of Appeal decided to consider this point of law also in consolidated proceedings with case numbers G 1/05 and G 1/06.

A member of the Enlarged Board of Appeal informed the Board of a possible objection to her taking part in referral G 3/06 due to a family connection with members of the firm representing one of the parties. In a letter dated 14 June 2006 the appellant's representative in case T 1409/05 questioned the position of another member of the Enlarged Board of Appeal considering that by reason of his membership in case T 90/03 he had already taken position in relation to the matters to be decided. After inviting first the members objected to, and then the parties to comment, the Enlarged Board of Appeal in a composition not including the members affected gave an interlocutory decision of 7 December 2006 relating to the composition in which the Enlarged Board of Appeal was to consider the referred points of law.

By Declaratory order of the Enlarged Board of Appeal of 26 April 2007 proceedings G 3/06 were terminated, their basis having been removed on Appeal Board 3.2.03 closing the appeal proceedings T 1040/04 after all appeals had been withdrawn.

IV. (a) In case T 39/03 (G 1/05), the appeal was against the decision of the examining division refusing a divisional application on the ground that none of the applicant's requests met the requirements of the EPC. In particular, the examining division considered that the divisional application did not comply with Article 76(1) EPC, since a particular feature set out in several independent claims was not disclosed in the earlier application. In a communication dated 22 December 2004 the Board notified the appellant that neither the original nor the replacement version of the application met the requirements of Article 76(1) EPC. The Board considered it an important point of law whether a divisional application which as originally filed failed to meet the requirements of Article 76(1) EPC can still be amended in the course of the examination procedure in order to meet these requirements. The Board further indicated that it envisaged referring this question to the Enlarged Board.

(b) Having identified a number of aspects in which the divisional application as originally filed appeared to be directed to subject-matter which extended beyond the content of the earlier application as filed in contravention of the requirement set out in Article 76(1) EPC, referring Board 3.4.02 indicated that it was well aware of the fact that in cases like the one before it, in which a divisional application as filed offended against the provisions of Article 76(1) EPC, it was the established practice of the EPO to allow the applicant at any later stage of the examining procedure to amend the divisional application so that it met the requirements of Article 76(1) EPC

(Guidelines for Examination in the European Patent Office, Chapter C-VI, 9.1.4).

The referring Board observed that this practice appeared not to have been questioned so far by the Boards of Appeal, which in many instances had accepted that divisional applications which in the version as originally filed offended against the provisions of Article 76(1) EPC, might be later amended (see e.g. decision T 1074/97 of 20 March 2003 or decision T 1092/04 of 6 October 2004).

(c) The referring Board however has strong reservations as to the correctness of this practice based primarily on inconsistencies in the current practice both with recent developments in the case law of the Boards of Appeal regarding the treatment of divisional applications filed as divisional applications of earlier divisional applications, and with the provisions of Rule 25(1) EPC, setting a time limit for the filing of divisional applications. These reservations seem to find support also in the express wording of Article 76 EPC, in the case law of a Contracting State (Great Britain), and in the Historical Documentation relating to the EPC (*Travaux Préparatoires*).

A difficulty with the present practice became apparent as a consequence of recent case law of the boards of appeal allowing the filing of divisional applications as divisionals of earlier divisional applications; see in particular decision T 1158/01 (OJ EPO 2005, 110). In this decision the referring Board in a different composition ruled that when the validity of the second-

generation divisional application was examined the validity of the first-generation divisional application had also to be examined, in order to avoid legal uncertainty in case of the first generation divisional application being or becoming invalid due to non-compliance with Article 76(1) EPC.

Moreover, the present practice of the EPO of authorising at a late stage of the examination procedure, irrespective of whether the earlier patent application was still pending or not, and without any further limitation other than the one imposed by Article 123(2) EPC, amendments aimed at deleting added subject-matter from divisional applications as filed so as to overcome objections under Article 76(1) EPC, in the referring Board's view resulted in applicants being effectively allowed to formulate valid divisional applications in contravention of the provisions of Rule 25(1) EPC. This was detrimental to the legal certainty for the public and could be seen to pave the way for potential misuse of the possibility afforded by the EPC to file divisional applications.

Similar concerns relating to the potential effect on the legal certainty for the public of the late formulation of divisional applications had been expressed by the referring Board in a different composition in its decisions T 720/02 and T 797/02 both of 23 September 2004 (see point 2.2 of the Reasons in either case) in relation to the proper handling of sequences of divisional applications.

The referring Board also found explicit support for its reservations against the present practice of the EPO in

the provision of Article 76(1) EPC. The Board considered that this provision was explicitly directed to the filing of divisional applications and set out the requirements to be met by a divisional application as filed. The consequences resulting from compliance of a divisional application with these requirements ought to be seen as stating that a divisional application could only benefit from the filing and priority dates of the earlier application if it had actually been filed in respect of subject-matter which did not extend beyond the content of the earlier application.

The question of the correct interpretation of very similar legal provisions concerning divisional applications comprising additional subject-matter in their version as originally filed was considered in detail by the English Patents Court in its decision *Hydroacoustics Incorporated's Applications*, see [1981] Fleet Street Reports, pages 538 to 550, in which it had to apply Section 76(1) of the UK Patents Act 1977 which provide:

"An application for a patent (the later application) shall not be allowed to be filed ... in respect of any matter disclosed in an earlier application ... if the later application discloses matter which extends beyond that disclosed in the earlier application, as filed ..."

From this wording, which the referring Board considered obviously to be intended to match the corresponding provisions of Article 76(1) EPC, the Court drew the conclusion, see page 548, second paragraph, that it was mandatory to refuse to allow any divisional application

to be filed which contains additional matter not disclosed in the parent application. The Court did not accept the argument of the applicant, see page 548, third paragraph, that the words "shall not be allowed to be filed ..." were not to be read as meaning that a divisional application with additional matter cannot be filed but were to be read as meaning "shall not be allowed to proceed", so that the applicant should be allowed to delete the additional matter and then to proceed with matter disclosed in the parent application. The Court stated that the words "shall not be allowed to be filed" were perfectly plain and it saw no reason why they should not have been given their plain meaning.

The referring Board noted that Section 76 of the UK Patents Act 1977 had been amended with effect from January 7, 1991 so as to explicitly allow later deletion of added subject-matter. It now provides that "An application for a patent ... which is made in respect of matter disclosed in an earlier application ... and discloses additional matter, that is matter extending beyond that disclosed in the earlier application ... may be filed ... but shall not be allowed to proceed unless it is amended to exclude the additional matter."

Article 76(1) EPC had, however, remained unchanged.

The referring Board also found in the *Travaux Préparatoires* indications that the EPC was not meant to allow deletion from divisional applications of additional subject-matter extending beyond the content of the earlier application so that it met the

requirements of Article 76 EPC. The Minutes of the Munich Diplomatic Conference in 1973 (Doc. M/PR/I, pages 36 to 37) showed that Article 74 (now Article 76, divisional applications) was the object of a thorough discussion in relation more particularly to the question of whether or not additional subject-matter in divisional applications belongs to the state of the art under Article 52 (now Article 54) paragraph 3 EPC. This discussion was summarised under point 210 of these Minutes. There it is stated that "Where a divisional application comprised new examples extending beyond the original version of the earlier application, these examples were not allowable. They should not, however, be deleted ...".

V. (a) In case T 1409/05 (G 1/06), the application under appeal was the third in a sequence A1, A2, A3 of divisional applications, each divided from its predecessor, and stemming from a root (originating) application A0. The root and the first divisional application A1 had been granted. The second divisional application A2 was refused for non-compliance with Article 76(1) EPC. The Examining Division refused A3, by applying what it saw as the *ratio decidendi* of T 555/00 of 11 March 2003 viz. that non-compliance with Article 76(1) EPC of a divisional application as filed necessarily entailed non-compliance of a divisional application of that divisional application, so given that A2 did not comply with Article 76(1) EPC the divisional application A3 also did not comply with Article 76(1) EPC.

(b) The referring Board indicated that on the facts it considered that while the subject-matters of claim 1 of

both the application A3 under appeal and its predecessor A2 (as filed) extended beyond the scope of claim 1 of A1, the subject-matter of the application under appeal was disclosed in A2 as filed, since A3 and A2 as filed were identical, and that the subject-matter of the application A3 under appeal was directly and unambiguously derivable from each of A0 and A1 as filed.

(c) The view of the applicable law taken by the referring Board was that in Article 76(1) EPC "content of the earlier application as filed" was to be interpreted as "the total technical information content of the disclosure", whether in the description or the claims (T 514/88, OJ EPO 1992, 570, point 2.2 of the Reasons; "Case Law of the Boards of Appeal of the EPO, 4th Edition 2001", Chapter III.A.2; Singer-Stauder, "The European Patent Convention, A Commentary 3rd Edition", Article 76, Note 20), and that in accordance with established jurisprudence of the boards of appeal Article 123(2) EPC and Article 76(1), second sentence, EPC were to be interpreted in the same manner in this respect (see the above references and T 276/97 of 26 February 1999, points 2.4 and 4.2 of the Reasons). Further in T 873/04 of 28 November 2005, point 1 of the Reasons, the above principles were applied to a sequence of divisional applications where the predecessor application was itself a divisional application.

The Board considered that this well-established view had been challenged in decisions T 720/02 and T 797/02 (both decisions having essentially the same reasons) in the case of a sequence of (two) divisional

applications, the second divided from the first, and stemming from a root application where it was held that in order to comply with Article 76(1), second sentence, EPC any successor divisional applications must be directed to objects encompassed by the invention or group of inventions divided out of the root application in the first divisional application; that is the subject-matter of the divisional application must fall within the scope of the claims of the earlier divisional application (see point 2.2 of the Reasons). In the more recent decision T 90/03 of 17 March 2005, these principles were apparently applied to the first divisional application as well (point 2 of the Reasons).

In addition, the view of the law on which the Examining Division had relied to refuse the application under appeal, namely that non-compliance with Article 76(1) EPC of a divisional application as filed made that divisional application "invalid" and necessarily entailed non-compliance with Article 76(1) EPC of a divisional application of that divisional application (while in the view of the referring Board being a mistaken interpretation of T 555/00) had indeed been put forward in Board of Appeal decisions T 904/97 of 21 October 1999 and T 1158/01, and accepted in the co-pending referral decision T 39/03.

(d) The referring Board did not agree with the views on the interpretation of Article 76(1) EPC expressed in decisions T 1158/01, T 720/02, T 797/02, or T 39/03 or the extension of this view to the interpretation of Article 123(2) EPC to amendments of claims in a divisional application in decision T 90/03,

but considered that the different views raised important points of law potentially affecting the outcome of the appeal.

(e) The referring Board put forward the further argument that there was no basis in the EPC for a concept of an "invalid" application; and there was no justification for differentiating between normal and divisional applications beyond the requirements of Article 76(1) EPC whose undisputed legal purpose, namely the prevention of granting protection for some added subject-matter that was "smuggled in" by means of the sequential applications could be achieved in a simple and straightforward manner by looking at the disclosure of the divisional application actually being examined and determining whether this was disclosed in all earlier applications as filed: parents, grandparents, etc. as the case might be.

VI. The submissions and requests of the appellant in referral case T 39/03 can be summarized as follows:

The inclusion of the term 'in so far as this provision is complied with' immediately implied that there was a possibility that the provision could be complied with either partially or entirely and that partial compliance with Article 76(1) EPC could be remedied to enable full compliance with Article 76(1) EPC.

Section 76(1) of the UK Patents Act 1977 was not intended to match the corresponding provisions of Article 76(1) EPC, see Section 130(7) of the UK Patents Act 1977. Further the UK provision contained no equivalent to the words 'in so far as this provision is

complied with' in the EPC provision, so the former could be no guide to the interpretation of the latter. The original UK provision came to be appreciated as an unduly harsh provision and had since been changed to allow amendment in conformity with EPO practice.

The Minutes of the Munich Diplomatic Conference of 1973 (Doc. M/PR/I pages 36 to 37) referred to new examples extending beyond the original version of the earlier application as not being allowable in a divisional, but did not say that the application should be refused or deemed withdrawn or that the *application* would not be allowable.

The appellant asked that the Enlarged Board answer questions (1) and (2) put in referral decision T 39/03 with yes, and question (3) to the effect that a corrected divisional application may be directed towards any aspect disclosed by the earlier application, subject to that aspect being disclosed in the earlier application as filed and the divisional application as filed.

Only if the Enlarged Board were minded to answer the referred questions so as to lead to a different result did the Appellant request oral proceedings.

VII. The appellant in referral case T 1409/05 made no requests or submissions in the proceedings before the Enlarged Board of Appeal, other than the challenge to the composition of the Enlarged Board referred to above in point III.

VIII. The comments made by the President of the European Patent Office can be summarized as follows:

(a) The President is of the opinion that the current practice of the first instance departments should be confirmed as being in line with the intentions of the legislator and with the interpretation of the EPC in the case law of the Boards of Appeal with the exception of the recent decisions T 1158/01, T 720/02, T 797/02, T 39/03 and T 90/03 which took views different to the current practice and not justified by the principles based on the EPC. Thus, a divisional application not meeting the requirements of Article 76(1) EPC in its version as originally filed should be treated as a European patent application, and should be allowed to be amended at any later stage of the examination procedure, irrespective of whether or not the earlier application is still pending. Moreover, a divisional application should be allowed to be directed to aspects of the divisional application not encompassed by those to which the divisional application as filed was directed or by those to which the divisional predecessors have been directed.

(b) Points in favour of allowing amendment to meet the requirements of Article 76(1) EPC

Support can be found in the *Travaux préparatoires* as follows:

The effect of the added matter for the divisional application itself was discussed during the 9th meeting of Working Party I in 1971. As can be seen from the minutes of this meeting, *"it was understood that if a*

divisional application contained new material, the attention of the applicant should be drawn to this point so that he might remove this material. If he did not, the divisional application would be rejected for not complying with Article 83a" (Doc. BR/135 e/71, pp. 90-91).

The requirement that a divisional application may be filed only in respect of subject-matter contained in an earlier European patent application was introduced in draft Article 74(1), with the purpose of avoiding conflicts with the national provisions concerning national security, given that European divisional applications have to be filed with the EPO (Doc. M/1, p. 80, Article 74(1), Doc. BR/219 e /72, pp. 8-9, point 10; Bossung, in *Münchner Gemeinschaftskommentar*, 1986, Art. 76, No. 29).

Draft Article 74 (a predecessor of present Article 76 EPC) then read (Doc. M/1, p. 80):

(1) A European divisional application must be filed directly with the European Patent Office. It may be filed only in respect of subject-matter contained in an earlier European patent application. It shall not designate Contracting States which were not designated in the earlier application.

(2) A European divisional application or a European patent granted on the basis thereof shall not contain subject-matter which extends beyond the content of the earlier application as filed; in so far 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 benefit of any right to priority.

The final wording of Article 76(1), second sentence, EPC was the result of an amendment made by the General Drafting Committee, which, for greater clarity, condensed the prerequisites for the filing of a divisional application into paragraph 1 of Article 76 EPC (Doc. M/PR/G, p. 164). However, the General Drafting Committee made no declaration to the effect that the requirements had thereby been changed and there was no discussion of the matter.

Referral decision T 39/03 (and decision T 1158/01 cited therein) refer to a passage in the Minutes of the Munich Diplomatic Conference of 1973 (Doc. M/PR/l, pp. 36-37) as support for their view that there was no intention to allow the deletion of additional matter. However, the passage referred to addressed the question of whether or not additional subject-matter in divisional applications belongs to the state of the art under Article 52 (now Article 54), paragraph 3, EPC. This is a separate question to that of amendment of an application to remove new material addressed by Working Party I above quoted.

A general principle under the EPC is that the applicant can make amendments in order to comply with the substantive requirements up to the end of the grant procedure, as long as he remains within the boundaries of the original disclosure. This is also evidenced by Article 96(2) EPC. Thus, it would be an exception in

the European patent system for divisional applications to have to comply with the prohibition on added matter on filing. It is established case law that Article 76(1) EPC has to be interpreted according to the same principles as Article 123(2) EPC (T 514/88, points 2.1 and 2.2 of the Reasons; T 527/88 of 11 December 1990, point 2 of the Reasons; T 276/97, points 2.1-2.5 of the Reasons; T 743/00 of 23 September 2002, point 3.3 of the Reasons). In the case of non-allowable amendments under Article 123(2) EPC applicants have the opportunity to remove any extension of subject-matter and this should apply also to Article 76(1) EPC.

The wording of Article 76(1) EPC ("in so far as" "dans la mesure" "soweit" versus "if"/ "si"/ "wenn") can also be seen to express the notion that a divisional application comprising added matter when it is filed will benefit from the filing and priority dates of the earlier application but only in respect of subject-matter which does not extend beyond the content of the earlier application, suggesting that amendment to confine the divisional to matter which does so benefit should be allowed.

The existing practice takes into account the fact that compliance with Article 76(1), second sentence, EPC cannot be determined by the Receiving Section. Thus, divisional applications comprising added matter proceed normally, ie fees are to be paid (filing, search, examination, renewal fees, etc.), a search is performed and the application is published as a European divisional application. Therefore, the possible conclusion, long after its filing, that the application

cannot be treated as a European divisional application leaves applicants (and third parties) in considerable uncertainty. On the other hand, if the application is processed as a European divisional application the legal certainty of the public will not be jeopardised, given that the public has been informed of the existence of the divisional application, both the parent (even if it has not been published) and the divisional applications are made available to the public, and the divisional application will only be allowed to proceed if the additional content is removed.

If divisional applications offending against Article 76(1) EPC on filing are not to be treated as European divisional applications subject to the need for amendment to comply with Article 76(1) EPC, applicants would opt to file divisional applications identical to the parent application as filed with a view to amending the divisional application later. This would increase the length of time that the procedure takes and thus the period of uncertainty for third parties before knowing what will be granted.

(c) Amendment of the divisional application at a time when the parent application is no longer pending

It is a generally accepted principle of patent law that once a divisional application has been validly filed it becomes separate and independent from the parent application. Thus, once the conditions of Article 76(1) EPC have been met, the divisional application is to be examined as an application quite separate from the parent application (G 4/98, OJ EPO 2001, 131, point 5

of the Reasons; T 441/92 of 10 March 1995, point 4.1 of the Reasons; T 873/94, OJ EPO 1997, 456, point 1 of the Reasons; T 561/00 of 17 July 2002, point 3.2 of the Reasons). Consequently, the EPO's first-instance departments and Boards of Appeal (see eg T 122/90 of 29 November 1990, T 860/90 of 1 March 1991, T 1074/97, T 1004/00 of 22 May 2002 and T 1092/04) allow a divisional application or patent comprising added matter to be amended at any later stage of the examination or opposition procedure, irrespective of whether the earlier application is still pending or not.

(d) Further limitations on amendments beyond those of Articles 76(1) and 123(2) EPC

Once a divisional application has been validly filed, it is to be examined as an application quite separate from the parent application and must itself comply independently with all the various requirements of the EPC. It follows that amendments of divisional applications must satisfy all the requirements of the EPC, including, inter alia, unity of invention (Article 82 EPC) and the prohibition on changing to unsearched subject-matter (Rule 86(4) EPC).

From the mere fact of division no further limitations on amendments can be deduced. In particular, it appears that no restriction on the potentially claimable subject matter exists for either a parent or a divisional application to something less than the whole content of the respective application as filed.

According to the established practice of the EPO's first-instance departments, amendments which make the parent and the divisional applications identical are refused when the amended divisional application claims the same subject-matter as the pending parent application or granted parent patent, because of the prohibition on double patenting. In such a case the applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same invention.

(e) Sequences of divisional applications

The existing practice of the first instance departments of the EPO allows sequences of divisional applications and treats a divisional application (of first or further generation) comprising added subject-matter in its version as originally filed as a European patent application, which must however be amended in order to be allowed to proceed to grant. If the added matter is not removed from the divisional application, Article 97(1) EPC applies and the application is to be refused. A refusal takes effect *ex nunc* and *not ex tunc*. Thus, as long as a refusal has not been pronounced, the application (of first or further generation) is pending and does not lose this effect retroactively. Accordingly, in the case of a sequence of divisional applications, the first instance departments do not require all divisional predecessors to have complied on filing, or even by subsequent amendment, with Article 76(1) EPC.

According to some recent cases (T 720/02, T 797/02 and T 90/03) the invention or group of inventions defined

in the claims of a divisional application determines the content of the divisional application *per se*, i.e. the content of the divisional application which is to be taken into account for the purpose of assessing whether the requirements of Article 123(2) and Article 76(1) EPC are fulfilled when any further divisional applications are divided out of this (divisional) parent application. This view goes against the established interpretation "content of the earlier application as filed" referring to the whole technical content, whether the earlier application is or is not itself a divisional application.

If such a limited view were followed applicants would file divisional applications claiming every embodiment disclosed in the divisional application, with a view to amending the claims or filing a further divisional application later. This would only increase the public's legal uncertainty.

This view would harm also fully "legitimate" divisional applications. In this respect, it is pointed out that divisional applications of the second generation make up less than 0.5% and later-generation divisional applications less than 0.05% of all European applications.

IX. Numerous *amicus curiae* submissions were received. The majority of these, including briefs filed on behalf of three associations, namely the Institute of Professional Representatives before the European Patent Office, the Fédération Internationale des Conseils en Propriété Industrielle, and the Chartered Institute of Patent Attorneys, strongly supported continuation of

the existing practice of the EPO as reflected in the Guidelines for Examination. The practice was said to be necessary in order that applicants could fully protect their inventions without facing procedural traps, and was fully justified by the wording of Article 76 and Rule 25 EPC. In particular the expression "in so far" in the second sentence of Article 76(1) EPC was taken as a clear indication that partial compliance on filing was possible and that any excess matter could be removed by amendment to allow grant.

Of the *amicus curiae* briefs supporting a more restrictive view, the main argument was the legal uncertainty caused to third parties by the fact that divisional applications could remain pending for the full or nearly the full period of twenty years from the filing of the earliest application, so that third parties were left in the dark during this whole period whether or not subject-matter might not ultimately be patented. Other points made or emphasized were:

The words in Article 76(1) EPC "... may only be filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed" were an all-or-nothing requirement to be fulfilled at the actual date of filing or never. Partial compliance was not possible.

A predecessor of Article 76(1), second sentence, first half sentence, EPC, namely draft Article 74(1), second sentence, as originally drafted solely in German (Doc. BR/199/72), read "Sie kann für einen in einer früheren europäischen Patentanmeldung enthaltenen Gegenstand eingereicht werden" (or in English

translation "It may be filed for subject-matter contained in an earlier European patent application"). This original version of draft Article 74(1), second sentence, was later amended to read "It may be filed only in respect of subject-matter contained in an earlier European patent application" (Doc. M/1, p. 80). The change was deliberate to meet a concern of the French delegation relating to national security, and strict interpretation was necessary to give it some teeth.

A further argument advanced was that Article 76(1) EPC was to be interpreted as allowing only comparison between an application and its immediate parent. If Article 76(1) EPC did not require compliance at the actual date of filing, then, if a first generation divisional application contained added subject matter, it would be possible to file a second generation divisional application identical to the first. Thereby the requirement of Article 76(1) EPC would be met and it would be possible to claim the date of the parent application for the subject-matter derived from the parent via the first generation divisional and the date of actual filing of the first generation divisional for the remaining subject-matter.

Another argument advanced was that the filing of a divisional application in respect of part of the subject-matter of the earlier application could be regarded as a procedural act that once and for all, but only for the purposes of the divisional application waived the other parts of the subject-matter for which protection was sought in the earlier application. This

amounted to an endorsement of the eminently sensible decision T 720/02.

Reasons for the decision

1. *Admissibility*

The Enlarged Board of Appeal is satisfied that answers to the questions referred are necessary for each Board of Appeal to be able to dispose of their respective appeals on the correct legal basis. The referrals are therefore admissible.

REFERRAL T 39/03

Question 1: The right to amend

2. *Invalidity*

2.1 In decision T 39/03 the starting point of the referring Board was its doubts as to whether a divisional application containing subject-matter extending beyond the earlier application as filed could be amended later to comply with Article 76(1), second sentence, first half sentence, EPC, based mainly on the concept that initial non-compliance of a divisional application with the said provision made the divisional application "invalid" (see in particular point 3.3 of the Reasons). However the referring Board did not state under what provision of the EPC such invalidity was to be considered, nor what the precise legal consequences were.

2.2 It would indeed follow from accepting the "invalidity" of a divisional application containing added matter that such an application could not be made valid by later amendment removing the added matter with retroactive effect.

2.3 The EPC does make provision for an application which may be considered to be invalid in that it has no legal effect. Thus, an application, having a deficiency within the meaning of Article 80 EPC cannot receive a filing date, does not have legal effect (see G 4/98, point 3.1 of the Reasons) and cannot be dealt with as a European patent application unless the deficiencies are remedied in accordance with Article 90(2) in conjunction with Rule 39 EPC and the application then receives as filing date only the date on which the deficiencies have been removed.

2.4 While severe formal deficiencies in an application as filed may thus, even if only in the extreme case and if so foreseen in the EPC, entail as a consequence that the application is invalid, i.e. has no legal effect, the concept of a possible "invalidity" for reasons of non-compliance of an application with substantive requirements for grant, however clear-cut the case may be, is otherwise unknown to the EPC. Non-compliance of the application with a substantive requirement for grant does not entail the invalidity of the application as such but only its refusal under Article 97(1) EPC if the deficiency is incurable or is not removed by amendment.

2.5 In his comments the President of the European Patent Office has explained in detail (point VIII(b) above)

how the wording of Article 76(1), second sentence, EPC was arrived at as a result of very late changes made.

2.6 Originally two different provisions existed in the drafts, one being an Article 74(1) which had the purpose of avoiding conflicts with the national provisions concerning national security, given that European divisional applications have to be filed with the EPO. The other provision was a separate provision in an Article 74(2), requiring the divisional application not to contain additional subject-matter but not being connected with the divisional application when being filed but with the pending divisional application or the patent granted on the basis thereof (for the texts of the respective draft provisions, see VIII(b) above). These two separate provisions were then condensed into present Article 76(1), second sentence, EPC, without, however, any intention of the legislator to thereby amend these requirements as to their substance being apparent.

2.7 Accordingly, present Article 76(1), second sentence, EPC has a double purpose, first as a formal requirement preventing applicants from putting into a divisional application new matter which could be objectionable under national security considerations and second, at the same time, setting up the substantive requirement for the patentability of divisional applications that they may not contain added matter in relation to their parent application.

2.8 As regards the aforementioned formal aspect of Article 76(1), second sentence, EPC a comparison with the provisions of Article 75(2) EPC relating to a newly

filed application suggests that considerations of national security are no reason for regarding a divisional application having excess content as invalid – even if said excess content was actually objectionable for such reasons. Article 75(2) EPC, which draws the attention of applicants to the fact that under national security provisions of a Contracting State an applicant may require national authorisation to file a new European application directly with the EPO or may even be required to file his application initially with a national authority, and enables the Contracting States to impose sanctions if their national security provisions are violated, provides no sanction under the EPC for this, and certainly no invalidation of the application.

2.9 The Enlarged Board concludes that neither the purpose of the prohibition in Article 76(1) EPC of adding matter in a divisional application to avoid conflicts with national security nor its meaning as establishing a substantive requirement for grant of the divisional application justify the conclusion that a divisional application which does not conform to the provision on filing is invalid.

3. *Right to amend*

3.1 According to Article 76(1) EPC the division of subject-matter out of the parent application has not been shaped by the legislator, as is e.g. the case in German patent law, as a procedural declaration dividing the hitherto single application procedure into two procedures having each the procedural status the single application had reached (Schulte, Patentgesetz mit EPÜ,

7th edition, § 34, note 264). Under the EPC, the division is effected by filing a new application. Article 76(3) EPC specifies that "...the special conditions to be complied with by a divisional application ... are laid down in the Implementing Regulations". Both provisions when read together lead to the conclusion that divisional applications are to be treated in the same manner as ordinary applications and subject to the same requirements, unless specific provisions of the EPC, in particular those of Article 76 or Rule 25 EPC, require something different (see also 8.1 below).

3.2 For all applications it is an important principle under the EPC that the question whether or not an application complies with the substantive requirements of the EPC is to be decided on the text finally submitted or agreed by the applicant after any objections have been drawn to his attention and he has been afforded an opportunity to comment and also an opportunity to overcome the objection by means of an amendment.

3.3 Whether or not the divisional application meets the requirement that its subject-matter does not extend beyond the content of the earlier application as filed, is, like compliance with Article 123(2) EPC, a substantive requirement for grant of a patent that cannot be examined by the Receiving Section but only by the Examining Division, in which case the above principle affording an opportunity for amendment would apply unless there is some specific provision to the contrary. There is no such contrary provision.

3.4 On a natural reading, Article 76(1), second sentence, EPC does not state what should happen if on the actual date of filing the divisional application contains excess subject-matter. Not complying with a provision cannot raise an automatic presumption that the application is to be refused without any prior possibility of amendment being afforded to the applicant. Rather, the general principle enshrined in Article 96(2) in conjunction with Article 123(1) EPC allowing amendments applies. This view is supported by the second sentence of Article 76(1) EPC (…in so far as this provision is complied with…; …soweit diesem Erfordernis entsprochen wird,…; dans la mesure où il est satisfait à cette exigence…).

3.5 Despite the statement in Article 76(3) EPC that "the procedure to be followed in carrying out the provisions of paragraph 1 ..... are laid down in the Implementing Regulations", there is no special procedure so laid down for examining whether the requirements of Article 76(1), second sentence, EPC are met. This could have been expected if compliance on the date of actual filing had been critical. The absence of such special procedure raises the strong presumption that the legislator wished the procedure before the Examining Division to apply, including the possibility of amendment to meet the requirement of Article 76(1), second sentence, EPC.

3.6 Support for the view to allow amendment of a divisional application to meet the requirement of Article 76(1) EPC can also be found elsewhere in the EPC. Thus in opposition proceedings under Article 100(c) EPC it is a ground of revocation that the subject-matter of the

European patent granted on a divisional application extends beyond the content of the earlier application as filed. Article 100 EPC does not state that it is a ground of revocation that the patent was granted on a divisional application whose subject-matter as *filed* extended beyond the content of the earlier application as filed. Article 100 EPC exhaustively sets out all the grounds of revocation that can be relied on, so the lack of any such ground of revocation suggests that the significant factor is the subject-matter at the time of grant and not whether the subject-matter of the divisional application as filed met the requirement of not extending beyond the content of the earlier application as filed. The same conclusion can be drawn for national proceedings from Article 138(1)(c) EPC which exhaustively lists the grounds for revocation available in national revocation proceedings.

4. *Travaux Préparatoires*

4.1 As set out in points 2.5 to 2.9 above, the *Travaux Préparatoires* do not support the argument that a divisional application contravening Article 76(1) EPC is irrevocably doomed and can for that reason not be amended because of the wording in the provision "may only file".

4.2 On the contrary, the *Travaux Préparatoires* lend further support for the view taken here. In the only document considered significant by the Enlarged Board, namely the minutes of the discussion of the 9th meeting of Working Party I in 1971 (Doc. BR/135 e/71, pp. 90-91), it is said: *"it was understood that if a divisional application contained new material, the attention of*

the applicant should be drawn to this point so that he might remove this material. If he did not, the divisional application would be rejected for not complying with Article 83a" (Article 83a at that time was as follows: "A European patent application shall not contain subject-matter which extends beyond the application as filed."). This discussion took place in the course of the final preparations of the EPC, and this specific topic does not appear to have been discussed later. While the text of the draft convention was changed, there is no indication that those changes were in any way intended to change matters so that amendment of a divisional application in such circumstances should not be allowed.

4.3 In contrast to the above cited passage, the passage in the Minutes of the Munich Diplomatic Conference of 1973 (Doc. M/PR/l, pp. 36-37) cited by the Board in referral decision T 39/03, while later in time, concerns discussion of a quite different point, namely whether or not additional subject-matter in divisional applications belongs to the state of the art under Article 52 (now Article 54), paragraph 3, EPC. There is nothing in the discussion that is inconsistent with amendment of a divisional application to delete subject-matter extending beyond the content of the earlier application being allowable.

4.4 The Enlarged Board can thus only deduce from the *Travaux Préparatoires* that the legislator did intend to allow amendment of a divisional application to delete subject-matter extending beyond the content of the earlier application.

5. *The interests of applicants and third parties*

5.1 A further consideration is whether legal security for third parties might require an interpretation forbidding amendment to meet the requirement of Article 76(1) EPC. The wording of Article 76(1) EPC in relation to a divisional application "[It] may only be filed for subject-matter which does not extend beyond the content of the earlier application as filed..." and the wording in Article 123(2) EPC "... A European patent... [application] ... may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed..." is so similar (in all three languages), that it is clear that exactly the same principles are to be applied for both types of cases when determining what extends beyond the content of the earlier application. This is the view that has been taken by the case law, with which view this Board agrees. As stated in Enlarged Board of Appeal decision G 1/93 (OJ EPO 1994, 541), the idea underlying Article 123(2) EPC is that "an applicant shall not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application" (point 9 of the Reasons). Exactly the same need for legal security of third parties is served by Article 76(1) EPC forbidding the subject-matter of the divisional application to extend beyond the content of the earlier application as filed.

5.2 But while it is clearly important for the legal security of third parties that Article 76(1) EPC keep

any patent granted on a divisional application within the contents of the earlier application, it cannot be argued that legal security for third parties also requires that no amendment to cause the application to conform with Article 76(1) EPC can be allowed.

5.3 Both Article 123(2) EPC and Article 76(1), second sentence, EPC use definitions that refer to the application as filed rather than the claimed subject-matter as filed to define the line drawn by the legislator between the interest of the applicant on the one hand to cover the disclosed invention as broadly as possible and the interest of third parties on the other to know as soon as possible what the scope of the granted patent could be. Both articles enshrine the principle that before grant the legal security of third parties is sufficiently protected by the prohibition of extending the content of the application by amendment beyond what was originally disclosed. Within these limits the right of the applicant to fully and adequately claim the disclosed invention prevails, so that third parties' rights are not affected by a broadening of the claims for the period up to grant of the patent (G 1/93, point 10 of the Reasons) this including the applicant's right to amend the claims so as to direct them to subject-matter not encompassed by the claims as filed. It is only after grant that the interests of third parties are further protected by Article 123(3) EPC and the patentee's right to amend the claims is limited by the scope of the granted patent.

5.4 Not allowing an amendment to bring the divisional application into conformity with Article 76(1), second

sentence, EPC would create a difference in treatment between comparable situations. This difference in treatment would serve no objectively justifiable purpose, but it would create a procedural trap. An example may help to make this clear.

5.4.1 An application is filed with an independent claim to having an element A, and dependent claims to the combinations A+B and A+C. The application as filed also discloses the combination A+B+Z, but not the combination A+C+Z. The search produces a citation which takes away the novelty of the claim to element A by itself. The applicant files a divisional application. In case I, the amended parent application claims combinations A+B and A+B+Z, and the divisional application claims combinations A+C and A+C+Z. In case II, the amended parent application claims A+C and A+C+Z, while the divisional application claims A+B and A+B+Z. The applications are otherwise identical. The only objection made in either case is that the dependent claim to A+C+Z extends beyond the subject-matter of the parent application as filed. The applicant has to admit that on careful reading only the combination A+B+Z but not that of A+C+Z was originally disclosed.

5.4.2 If this was an objection under Article 123(2) EPC in the parent application in case II, the applicant can cure the objection by deleting the offending claim to A+C+Z. The wording "may not be amended" in Article 123(2) EPC has never been interpreted as indicating that the first putting forward of such an amendment is a contravention leading to automatic rejection of the application. Rather the applicant has

to be notified of the objectionable matter and afforded an opportunity to amend in an allowable manner.

5.4.3 If however the objection in case I that the combination A+C+Z was not originally disclosed in the earlier application is raised under Article 76(1) EPC to the divisional application, then unless the applicant is permitted to amend to remove the claim to A+C+Z the result is both arbitrary and unfair. In case I he would lose the divisional application and with it his claim to A+C. In case II, he would keep the parent application and the divisional application, and have claims both to A+B and A+C. The needs of legal security for third parties would obviously be adequately served by allowing the deletion of the offending claim to A+C+Z in case I. To reject the divisional application in its entirety is in the Board's view disproportionate.

5.5 It is true that, if amendment to remove non-compliance of the originally filed text with the requirements of Article 76(1) EPC was not possible, applicants could in many cases try to avoid the procedural trap so caused. They could file any divisional application with the same description and claims as the earlier application, with the claims in a different order so that the claims first in order were directed to the subject-matter of specific interest in the divisional application, and then at a later stage filing amendments to bring the application into the form they particularly desired. The result would be lengthening the patent grant procedure and thus the period of legal uncertainty for third parties which is not desirable.

6. *Provisions in the UK Patents Act 1977*

The referral case giving rise to proceedings G 1/05 relied on what was said in the English case *Hydroacoustics Incorporated's Applications* [1981] FSR 538 as an aid to interpreting Article 76(1) EPC (see IV.(c) above). The *Hydroacoustics* case turned on the precise wording of Section 76 of the UK Patents Act 1977 then in force which (despite by coincidence having the same number as the EPC provision on divisional applications) was not one of the provisions which Article 130(7) of the UK Patents Act 1977 explicitly stated to be framed to have as nearly as practicable the same effect as the corresponding provisions of the EPC. While similar to Article 76(1) EPC in some respects, it did not contain the second sentence "…in so far as this provision is complied with, the divisional application shall be deemed to have been filed…". The wording of Section 76 of the UK Patents Act 1977 has since been changed to negative the decision in that case. The case is thus a decision upon a materially different provision subsequently altered by the legislature, and thus provides no support for any particular interpretation of Article 76 EPC. If anything, the subsequent history in the UK suggests that a provision not allowing amendment is unsatisfactory.

7. *Conclusion on possibility of amendment*

In the opinion of the Enlarged Board of Appeal all the matters set out above point in favour of an interpretation of Article 76(1) EPC permitting an applicant to amend a divisional application after the

application has been filed so as to comply with the provisions of that article, provided always that the amendment complies with the other requirements of the EPC.

8. *Question 2: Parent application no longer pending*

8.1 The second question raised in the referral in G 1/05 is whether it is still possible to amend a divisional application in order for it to meet the requirements of Article 76(1) EPC when the earlier application is no longer pending. According to Article 76(1) EPC a divisional application is a new application which is separate and independent from the parent application (see also point 3.1 above). A more detailed formulation is to be found in Opinion G 4/98 in point 5 of the Reasons, where the Enlarged Board of Appeal affirmed the view taken by commentators "... that the procedure concerning the divisional application is in principle independent from the procedure concerning the parent application and that the divisional application is treated as a new application.... Although there are some connections between the two procedures (e.g. concerning time limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter...".

8.2 Therefore, an amendment to remove added matter not disclosed in the parent application as filed from the divisional application as filed is allowable irrespective of whether the earlier application is still pending or not.

9. *Question 3: Further limitations on the right to amend*

9.1 The principle that the divisional application is a separate and independent application and is, if not specifically provided otherwise, to be treated in the same manner and subject to the same requirements as an ordinary application, also answers question 3 of the referral in G 1/05.

9.2 Amendments to divisional applications are allowed under Article 123(2) EPC to the same extent as amendments of any other non-divisional applications. The Enlarged Board does not consider that from the mere fact of division it is possible to derive limitations, such as by waiver or abandonment of any subject matter of the earlier application not encompassed by the claims of the divisional application under consideration, on what further amendments can be made or to what subject-matter further divisional applications of the said divisional application can be directed. This is in accordance with the established case law (see the referral decision T 1409/05, point 3.1.2 of the Reasons, and the further references cited therein). Article 76(1) EPC refers to the content, interpreted as the whole technical content, of the earlier application, and there is no legal basis for limiting this on division. Third parties need to be aware that while any divisional application is still pending, any of its content as filed may yet be the subject of patent claims either in the divisional application itself, or in further divisional applications. Therefore, a divisional application can be directed by amendment to aspects of the earlier application also disclosed in

the divisional application as filed but not encompassed by the claims of the divisional application as filed.

REFERRAL T 1409/05

10. *Question 1: Sequences of divisional applications*

10.1 In the case of the referral relating to sequences of divisional applications, Article 76(3) and Rule 25(1) EPC are again relevant as well as the principle deduced from them (see point 8.1 above) that divisional applications are to be treated in the same manner as ordinary applications and subject to the same requirements as these unless specific provisions of the EPC, in particular Article 76 or Rule 25 EPC, require something different.

10.2 While Article 76(1) EPC is not explicitly worded to cover divisional applications of divisional applications, it cannot be said to forbid them. Indeed its provisions apply naturally to divisional applications of divisional applications on the principle that absent specific provisions a divisional is to be treated as any other application. This means that a divisional application (of whatever generation) too can be the "earlier application" of Article 76(1) EPC for the purposes of a further divisional application. Present Rule 25 EPC also reflects this view by referring to the possibility of filing a divisional application to any pending earlier European application.

11.1 The specific and much more favourable legal status accorded by Article 76(1), second sentence, EPC to a

divisional application for the subject-matter already disclosed in the earlier application, as compared with what would be the situation on filing a normal application for that subject-matter, is, that for the assessment of the patentability of that subject-matter it is not the date of the actual filing of the divisional application that counts but the filing date of the earlier application.

The characterizing feature of a sequence of divisional applications each divided out from its predecessor is that each member of the sequence claims as filing date the date of the originating or root application in which the subject-matter divided out in sequences of divisional applications was first disclosed.

Under the EPC the filing date of the root application is the only filing date which can be attributed to a divisional application, by way of the legal fiction contained in Article 76(1), second sentence, second half sentence, EPC, irrespective of whether the divisional application is a first divisional or a divisional further down in a sequence of divisionals.

There is no room under the EPC for a divisional application to have as filing date the date of its actual filing with the EPO. By the same token, there is no support in the EPC for the idea that within one and the same application - be it a divisional application or not - different filing dates may be attributed to different parts of its subject-matter filed within that application at different points in time.

There is also no basis in the EPC for filing a divisional application on subject-matter added to the root application or a divisional application further up the sequence and claiming as filing date the date on which that subject-matter was actually first filed, as was possible under former German Patent Law (as applicable before 1 October 1968, see Georg Benkard, Patentgesetz, Gebrauchsmustergesetz, 5th edition, 1969, § 26, note 26).

11.2 For these reasons, in the situation of a sequence of divisional applications each having been divided out from its predecessor, according the filing date of the first disclosure of the subject-matter concerned in the root application is only justified if the said subject-matter was disclosed in each of the preceding (earlier) applications as filed and if it was still present (i.e. it was not unequivocally and definitively abandoned by that time, see J 2/01, OJ EPO 2005, 88, point 6. of the Reasons, J 15/85, OJ EPO 1986, 395, points 4 and 5 of the Reasons) in each earlier predecessor application at the time the - further - divisional application was filed so that it was thereby existing at all times throughout after its disclosure in the root application as filed up to and including the date of filing the divisional application under consideration.

Content which has been omitted on filing a member higher up the sequence cannot be re-introduced into that member or in divisional applications lower down the sequence from it. Conversely, content which has been added on filing of a divisional application a sequence higher up cannot be claimed in a divisional application down the sequence because according to

Article 76(1) EPC such added matter does not benefit from the filing date of the root application in which it was not disclosed.

12.1 On this view of how to apply Article 76(1) EPC the Enlarged Board of Appeal cannot see that the problems mentioned in referral T 39/03 with sequences would arise. The content of the earlier members of a sequence just becomes a limitation that needs consideration on the basis of the applications as filed of the earlier members. The view of the referring Board in T 1409/05 is confirmed.

12.2 Provided that the aforedefined requirements are met for the subject-matter under consideration in the divisional application concerned, it is irrelevant as to whether earlier members of the sequence as filed did not comply with Article 76(1), second sentence, EPC in respect of other subject-matter contained in them or whether they were maintained or rejected after the further divisional application in the sequence had been filed. Neither Rule 25 nor Article 76(1) EPC contain any provision that the subsequent fate of the earlier application or its remaining pending or not can affect the proceedings on the divisional application (see also points 8.1 and 8.2 above), and absent such provisions the Enlarged Board sees no basis for imposing any additional restriction.

13.1 Article 76(3) EPC allows the procedure to be followed and the special conditions to be complied with to be laid down in the Implementing Regulations. This precludes the Enlarged Board of Appeal from imposing more tightly limited conditions than appear in the

Implementing Regulations. To do so would be to trespass on a sphere reserved to the Administrative Council. A comparison of Rule 25(1) and (2) EPC in force in 1978 with present Rule 25(1) is instructive. It can be seen that the limitations that existed on the filing of divisional applications were abolished by the legislator. If more restrictive conditions are to be imposed, then both Article 76(3) EPC and the requirement of legal certainty would require this to be done again by the legislator itself.

13.2 The decisions T 720/02 and T 797/02, cited with disapproval in the referring decision T 1409/05, each in point 2.2 of the respective Reasons contains the following passage:

"... the generally acknowledged principle that the examining procedure at the EPO must be conducted in such a way as to ensure that, within a reasonable period of time after the filing of a patent application, the public should have a fair knowledge of the extent of the exclusive rights sought by the applicant. When applying the material provisions of the EPC governing admissibility of divisional applications to the particular case - not specifically envisaged in the Convention - of applications divided out of divisional applications, care should therefore be taken not to run counter to this principle."

13.3 The Enlarged Board considers that this "principle" is no doubt desirable and applicable both to ordinary applications and to divisional applications, and might induce the legislator to contemplate specific rules to achieve such an end. However it is no basis for the

boards of appeal or other instances of the EPO themselves to restrict the rights of applicants in a manner not warranted by any specific provision of the EPC, such as Rule 25(1) EPC.

13.4 The Board accepts that the principle of prohibition of double patenting exists on the basis that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor. Therefore, the Enlarged Board finds nothing objectionable in the established practice of the EPO that amendments to a divisional application are objected to and refused when the amended divisional application claims the same subject-matter as a pending parent application or a granted parent patent. However, this principle could not be relied on to prevent the filing of identical applications as this would run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward (see point 3.2 above).

13.5 On Article 76(1) and Rule 25 EPC as presently worded the Enlarged Board of Appeal sees no adequate basis for defining any additional requirements to be imposed on divisional applications beyond the requirements that all applications have to fulfil as well. It appears that what applicants consider a legitimate exploitation of the procedural possibilities afforded by the EPC, others consider an abuse in relation to the law as they think it ought to be rather than as it is. The Board finds it unsatisfactory that sequences of divisional applications each containing the same broad disclosures of the original patent application, by means of at

least an unamended description, should be pending for up to twenty years. If administrative measures, such as giving priority to the examination of divisional applications and bundling and speedily deciding co-pending divisional applications so as to minimize the possibility for applicants to keep alive subject-matter on which the Examining Division had already given a negative opinion in one application by means of refiling the same subject-matter again and again, are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be.

14. Since question 1 must be answered in the affirmative, it is unnecessary to answer the other questions.

Order

For these reasons, the questions of law which were referred to the Enlarged Board of Appeal are answered as follows:

In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, it is a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1), second sentence, EPC that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed.

The Registrar: The Chairman:

P. Martorana P. Messerli