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D E C I S I O N
of 4 February 2004

Case Number: J 0002/01 - 3.1.1

Application Number: 99104102.1

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:
Treatment of T cell mediated autoimmune disorders

Patentee:
THE TRUSTEES OF DARTMOUTH COLLEGE

Opponent:
-

Headword:
Divisional application/THE TRUSTEED OF DARTMOUTH COLLEGE

Relevant legal provisions:
EPC Art. 58, 59, 60(1)(3), 61, 68(1), 72, 75, 76, 81, 112, 116, 118
EPC R. 17(1), 20, 25(1), 48(2), 72, 88, 100
Art. 4G, 19 Paris Convention
Art. 31, 32 Vienna Convention
§§ 6, 7 PatG
Section 15(4) KK Patent Act

Keyword:
"Patent application in the name of more than one applicant - divisional application in the name of not all the applicants for parent application - no - unless Art. 61, Rule 20 EPC are met"

Decisions cited:
G 0001/83, G 0003/92, G 0001/98, G 0003/98, G 0002/99, G 0003/99, J 0015/85, J 0034/86, J 0011/91, J 0018/93, J 0022/95, J 0016/96, J 0017/96, J 0019/96, T 0128/82, T 873/94

Headnote:

1. A consequence of the unity requirement in Article 118 EPC is that, when two or more persons file an application in common, they cannot acquire a procedural status different from that of a single applicant, because otherwise each of them could perform different and contradictory procedural acts, including the filing of different versions of the patent to be granted.

2. Therefore, where an application (the "earlier application") has been filed jointly by two or more applicants and the requirements of Article 61 or Rule 20(3) EPC have not been met, the right to file a divisional application in respect of the earlier application under Article 76 EPC is only available to the registered applicants for the earlier application jointly and not to one of them alone or to fewer than all of them.

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: J 0002/01 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 4 February 2004

Appellant: THE TRUSTEES OF DARTMOUTH COLLEGE
6210 Raven House
Hanover, NH 03755-3580 (US)

Representative: Daniels, Jeffrey Nicholas
Page White & Farrer
54 Doughty Street
London WC1N 2LS (GB)

Decision under appeal: **Decision of the Receiving Section of 26 July 2000 deciding that European patent application Nr. 99 104 102.1 should not be dealt with as a European divisional application relating to earlier European patent application No. 96 921 309.9.**

Composition of the Board:

Chairman: J. C. Saisset
Members: M. B. Günzel
E. Lachacinski

Summary of Facts and Submissions

I. The appeal lies from the decision of the Receiving Section of the European Patent Office, deciding that the application in suit, European patent application No. 99 104 102.1, should not be dealt with as a European divisional application, relating to the earlier European patent application No. 96 921 309.9.

II. The application in suit was filed on 1 March 1999 in the name of the Trustees of Dartmouth College, as a divisional application relating to parent application No. 96 921 309.9, which had been filed on 6 June 1996 as a PCT application, International Application No. PCT/US96/09137, in the name of the Trustees of Dartmouth College and the Nederlandse Organisatie Voor Toegepast-Natuurwetenschappelijk Onderzoek. The parent application claimed the priority of 7 June 1995.

III. The Receiving Section, after it had informed the appellant of its view that the application in suit could not be treated as a divisional application and after the appellant had replied to this, decided on 26 July 2000 that the application would not be dealt with as a divisional because, in the case of multiple applicants, a divisional application could only be filed in the name of all the applicants named in the earlier application.

A European divisional application could only be filed by the same applicant as the earlier European application from which it was derived. Article 4G Paris Convention made it clear that it was the applicant who had the right to divide the patent application.

Reference was also made to Rule 25(1) EPC and the Guidelines for Examination A-IV, 1.1.3.

For the purposes of proceedings before the EPO, the applicant was deemed to be entitled to exercise the right to the European patent (Article 60(3) EPC). Questions relating to ownership of the right to the European patent were not to be examined by the EPO, but fell to be settled by national law (Article 61 EPC).

Where there was more than one applicant in respect of the earlier application, for the purpose of Article 60(3) EPC the applicants were deemed to hold the right to the European patent jointly, which was to say that they could only exercise it jointly in proceedings before the EPO.

Decision J 34/86 of the Legal Board of Appeal concerned an exceptional set of circumstances and was not applicable in the present case, because in that case the applicant for the earlier application had accepted that he was not entitled to the right to the patent and the question of the rights of joint applicants did not arise.

The applicant's argument that if the application in suit had been filed in the names of both applicants of the earlier application it would not have been possible to submit a valid declaration of inventor did not hold good. For the purposes of Article 81, second sentence, and Rule 17(1) EPC it was sufficient that only one of the joint applicants derived the right to the European patent from the designated inventor and, moreover, the

accuracy of the information given in the designation of inventor was not checked by the EPO.

IV. The applicant appealed against this decision on 25 September 2000, paid the appeal fee on the same day and submitted the grounds of appeal on 4 December 2000.

V. After the Board had communicated to the appellant its preliminary view of the appeal, oral proceedings were held before the Board on 4 February 2004.

At the beginning of the oral proceedings, the Board informed the appellant that these proceedings were not public. Although the requirements of Rule 48(2) EPC for non-publication of the application appeared not to have been met, the divisional application in suit had in fact not been published. Since Article 116 EPC required publication as a prerequisite for oral proceedings to be public, the Board had corrected its original summons to public oral proceedings.

VI. The submissions of the appellant in the grounds of appeal and in the oral proceedings can be summarized as follows:

1. The parent application of the present divisional application had been directed to two separate inventions.

Invention 1 was the generic invention directed to the use of a gp39 antagonist for the manufacture of a medicament for the alleviation of certain tissue destruction associated with an autoimmune disorder.

Invention 2 was the specific invention of the use of the antagonist for the manufacture of a medicament for the alleviation of said tissue destruction associated with multiple sclerosis.

The generic Invention 1 had been made by Dr Noelle alone, and his rights were assigned to the appellant by virtue of his employment contract. Invention 2 was the result of collaborative work between Dr Noelle and a further researcher whose rights were assigned to the co-applicant of the parent application by virtue of his employment contract with this co-applicant.

Accordingly, the right to a European patent in respect of Invention 1, to which the divisional application was directed, belonged to the appellant alone, in accordance with Article 60(1) EPC, and the right to a European patent with respect to Invention 2 belonged to both applicants for the parent application in common and they were therefore both correctly named as co-applicants in the parent application.

2. In accordance with Article 60(3) EPC, as a co-applicant for the parent application, the appellant was deemed to be entitled to exercise the right to the European patent.

None of Articles 58, 60(3), 76 EPC or Rule 25 EPC or Article 4G Paris Convention imposed restrictions with regard to the name of the applicant for a divisional application. Therefore,

a broad interpretation of the term "applicant" was possible, such that each of several joint applicants could be an "applicant" within the meaning of those provisions. In the absence of any indication that a narrow interpretation of the term "applicant" was both intended and justified - ie that it only meant all joint applicants taken together - the broad interpretation of the term had to be applied.

Article 76(1) EPC stipulated that, provided the divisional application was not filed in respect of subject-matter extending beyond the content of the earlier application as filed, the divisional application was deemed to have been filed on the date of filing of the earlier application. Article 76 EPC did not use the term "applicant" and thus put no restriction on the identity of the applicant, nor were any such other conditions laid down in Rule 25 EPC. Moreover, the question as to who was entitled to file a divisional application was, as observed on similar facts in decision J 11/91 of 5 August 1992 (point 2.3.4 of the reasons), a question of substantive law and not of procedure. According to Article 76(3) EPC, only the procedure for divisional could be dealt with in the Implementing Regulations.

A narrow interpretation of the term "applicant" could not be derived from Article 4G Paris Convention either. The EPC constituting a special agreement within the meaning of Article 19 Paris Convention (see the Preamble to the EPC) and Rule 25 EPC being lower-ranking law, that rule had

to be interpreted in accordance with Article 4G Paris Convention, as the Legal Board of Appeal had also stated in decision J 11/91. A narrow interpretation of the term "applicant" in Rule 25 EPC would therefore be contrary to Article 4G Paris Convention.

Nothing in the travaux préparatoires suggested a narrow interpretation. The term "applicant" had not been present in the first draft of what is now Rule 25 EPC. The appellant submitted an extract of the Minutes of the Munich Diplomatic Conference for the Setting up of a European System for the Grant of Patents, M/PR/I, points 199 to 211, Article 74(76)-European divisional applications. It could be seen from this that the legislator had no intention of imposing a further "special condition" within the meaning of Article 76(3) EPC on the applicant for a divisional application.

Nothing relevant to the present case could be derived from Articles 59 and 118 EPC, cited by the Board in its communication, because neither of them addressed the status or the rights of multiple applicants. Equally, no conclusions could be drawn regarding the status of multiple applicants from decision G 3/99 cited by the Board, because said decision only dealt with the procedural rights of common opponents. Moreover, according to the decision, the members of the group of common opponents did indeed have an individual status because each of them could individually withdraw from the proceedings.

In decision J 34/86 cited by the Receiving Section, Article 60(3) EPC was not even mentioned. In decisions J 18/93 of 2 September 1994 and J 17/96 of 3 December 1996, corrections substituting the name of the applicant had been allowed in certain circumstances. In the present case, however, the filing of the divisional application in suit in the name of the appellant alone was not an error but was intentional and there was no ownership dispute within the meaning of Article 61 EPC. Therefore, the argument raised by the Board in its communication - that it would be unjust if, by reason of a procedural provision the first of joint applicants for a parent application to act unlawfully could deny the others their rights in a divisional - could no be sustained. Moreover, the EPO should respect the presumption that applicants were acting in good faith.

3. To comply with Rule 17 EPC it was not possible to name the co-applicant for the parent as co-applicant for the divisional because that co-applicant had not derived any rights from the inventor in relation to Invention 1. Nor could the co-applicant transfer any rights to the appellant for the divisional to proceed in the name of the appellant alone without contravening Rule 20 EPC because the co-applicant never had any rights to the European patent to be granted in relation to Invention 1.

4. No mention of the issue raised here was made in the Guidelines for Examination, which merely indicated in the version published in July 1999,

and thus after the filing date of the present divisional application, that only the applicant on record could file a divisional application.

5. During the oral proceedings the appellant submitted that, as a result of an enquiry made by its representative, it had turned out that under certain administrative conditions eight contracting states to the EPC accepted divisional applications filed by less than all applicants for the parent application. As evidence of the UK practice, the appellant submitted an extract of the "Manual of Patent Practice in the UK Patent Office", Fifth edition, May 2003, points 15.10 to 15.34, and referred particularly to point 15.24 therein.

6. According to decision G 3/92, point 3 of the reasons, the fiction contained in Article 60(3) EPC relieved the EPO of any need to investigate the existence of the entitlement of the applicant. Accordingly, the EPO was not entitled to deny the present appellant's entitlement to exercise the right to the European patent derivable from the divisional application in suit.

7. The issues raised by the appellant were important points of law justifying their referral to the Enlarged Board of Appeal for the sake of uniform application of the law.

VII. As **main request**, the appellant requested that the decision of the Receiving Section be set aside.

As first **auxiliary request**, the appellant requested that the following question be referred to the Enlarged Board of Appeal:

"Where more than one applicant is named in a pending earlier European patent application, can a divisional application be validly filed in the name or names of fewer than all those applicants?"

As second auxiliary request, the appellant requested that the following question be referred to the Enlarged Board of Appeal:

"Does the legal fiction under Article 60(3) EPC that the applicant shall be deemed to be entitled to exercise the right to the European patent only relieve the EPO from any need to investigate the existence of the entitlement?"

Reasons for the decision

1. The application in suit was filed in the name of the appellant, the Trustees of Dartmouth College, as a European divisional application relating to European patent application No. 96 921 309.9. At the filing date of the application in suit the registered applicants for the parent application were the appellant and the Nederlandse Organisatie Voor Toegepast-Natuurwetenschappelijk Onderzoek (the "co-applicant").

2. The appellant has contested the Receiving Section's position that in the case of more than one registered applicant for a European patent application the right

to file a divisional application under Article 76 EPC belongs only to the registered applicants for the earlier application jointly and not to one of them alone.

2.1 It is correct that the provisions of the EPC cited by the appellant and Article 4G Paris Convention refer to "the applicant" in the singular. However, that does not mean that the term has to be read as thereby referring to a single person only. It appears to the Board to denote the function or status of being an applicant rather than the precise number of persons who form the applicant or applicants.

2.2 In the oral proceedings before the Board, the appellant emphasised that, in the absence of an explicit basis for construing the term "applicant" in the narrow sense of applying it to joint applicants, the EPO should give this term a broader interpretation such that it refers to each co-applicant individually.

It is doubtful whether the two different interpretations of "applicant" identified by the appellant can really be characterised as "narrow" and "broad". This is however immaterial because there is no general rule of law that, in the absence of a specific literal meaning, a term has to be interpreted narrowly or broadly, whatever either may in the circumstances mean.

According to the established jurisprudence of the boards of appeal and in accordance with Articles 31 and 32 of the Vienna Convention on the Law of Treaties, whenever legal provisions need interpretation to

establish their meaning, as is the case here, all the established methods of legal interpretation eg as laid down in the Vienna Convention should be used. Thus, the possible literal meaning of a word is not necessarily decisive: the meaning of the word must be considered in the context of the legal provision and the broader context of other related provisions. The object and purpose of the provisions as well as their legislative history have also to be considered (see eg how the Enlarged Board of Appeal reached its conclusions in G 3/98, OJ EPO 2001, 62 and G 2/99, OJ EPO 2001, 83 and in G 1/98, OJ EPO 2000, 111; see also G 1/83, OJ EPO 1985, 60, T 128/82, OJ EPO 1984, 164, point 9 of the reasons, and J 16/96, OJ EPO 1998, 347, point 3 of the reasons).

2.3 With regard to Article 4G Paris Convention, the appellant's only reason for its submission that, in the case of multiple applicants, the use of the term "applicant" in the singular should be read as referring to each co-applicant individually, is that its interpretation is linguistically possible. However, there is nothing in Article 4G Paris Convention permitting the conclusion that the use of the term "applicant" in the singular was intended to mean that, in the case of multiple applicants, every co-applicant should have - individually and independently of his co-applicants - the right to divide the application in such a way as to be able to file a divisional application for part of the subject-matter of the original application in his name alone. Therefore, the appellant's argument that to interpret Rule 25 EPC as meaning that, in the case of multiple applicants, the term "applicant" applied to multiple applicants jointly

was in conflict with Article 4G Paris Convention, must fail.

2.4 It is correct that, in contrast to Rule 25 EPC, Article 76 EPC does not use the term "applicant" but defines the conditions for the filing of a divisional application in a passive linguistic form. It is, however, interesting to note that when work on the drafting of the EPC began, Article 68(1) - at the time there were as yet no draft implementing provisions and therefore also no Rule 25 EPC - already provided that "Der Anmelder kann die Europäische Patentanmeldung teilen", ie the applicant may divide the European patent application (Ergebnisse der zweiten Sitzung der Arbeitsgruppe "Patente" vom 3. bis 14. Juli 1961 in Brüssel, IV/4860/61-D). As the appellant has itself pointed out, the drafting of the EPC provisions relating to divisional applications was based on Article 4G Paris Convention. That article makes clear that it is the applicant who has the right to divide the patent application. As the appellant has claimed, in order to be consistent with Article 4G Paris Convention, Article 76 EPC in today's version therefore has to be read in the same way.

No other conclusions can be drawn from the fact that the passage from the travaux préparatoires cited by the appellant (see VI.2. above) does not deal with the question of the "applicant" at all but exclusively with problems related to Article 76(1), second sentence, EPC, namely that the divisional application may only be filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed. As can be inferred from these discussions, this

issue did indeed raise serious problems specific to divisional applications. On the other hand, there was no reason to discuss the meaning of the term "applicant" in this context because the question of multiple applicants is addressed in other provisions of the EPC, eg in Articles 59 and 118 EPC, which will be discussed below.

2.5.1 Article 59 EPC provides that an application may be filed by joint applicants. A consequence of the unity requirement in Article 118 EPC is that, when two or more persons file an application in common, they cannot acquire a procedural status different from that of a single applicant, because otherwise each of them could perform different and contradictory procedural acts, including the filing of different versions of the patent to be granted. Therefore, joint applicants only acquire the procedural status of one applicant in common, ie they constitute a single party in the legal sense and they hold the rights and obligations derived from this procedural status jointly in respect of the application. Even where two or more applicants are not joint applicants within the meaning of Article 59 EPC but have designated different contracting states, their status as applicants for a single application is still the same. According to Article 118 EPC, they will also be regarded as joint applicants and the unity of the application in these proceedings will not be affected. Therefore, joint applicants can only act in common or through a person entitled to represent them (see Rule 100 EPC) and the legal fiction contained in Article 60(3) EPC that the applicant is deemed to be entitled to exercise the right to the European patent applies to the joint applicants in common for the

application as such. That means that the legal fiction applies to the application as a whole and cannot be split into parts, in particular irrespective of which part of the invention or, in the case of several inventions contained in one application, which invention belongs to which one of the joint applicants as a matter of substantive law according to Article 60(1) EPC (see in more detail below under 2.6).

The appellant has objected to the above interpretation as giving these provisions a particular meaning. However, the Board can only observe, as already stated in 2.2 above, that it is the duty of the Board (and the decision-making bodies) to apply the law, if necessary by interpretation.

2.5.2 Even in the absence of such specific provisions as are contained in Articles 59 and 118 EPC with respect to applicants, the Enlarged Board of Appeal ruled in its decision G 3/99, OJ EPO 2002, 347, point 15 of the reasons, with respect to an opposition filed in common by a group of persons, that an opposition filed in common is to be dealt with as an opposition filed by only one party and that the group of common opponents is to be considered as a whole, ie as a single party. An individual common opponent who is not the common representative is not allowed to act or intervene on his own (point 14 of the reasons) other than to withdraw as a joint member of the group (point 20 of the reasons). The Board does not share the appellant's view that nothing can be inferred from this decision concerning the status of joint applicants. On the contrary, despite the fact that in that decision the Board allowed individual common opponents individually

to withdraw from the proceedings, the Board defined the status of common opponents as constituting a single party only. The common opponents jointly hold one position only, of being a party to the proceedings, and they can only exercise this position in common. That a member of the group has been allowed individually to withdraw from being a member of the group and thereby from the proceedings does not change the nature of the legal status of the group of common opponents as such, ie as constituting a single party to the proceedings in the legal sense, and is to be explained by the fact that, unlike in the case of applicants, the EPC contains no provisions relating to the transfer of an opponent's procedural status.

2.6 During the oral proceedings, the appellant acknowledged as a matter of principle that the right to the European patent as a matter of substantive law is addressed in Article 60(1) EPC and that it has to be distinguished from the formal (procedural) right to the patent which derives from the status of being the registered applicant addressed in Article 60(3) EPC. For the meaning of this distinction, the Board referred the appellant to Schulte, Patentgesetz mit EPÜ, 6. edition, Cologne 2001, § 6, note 3, and § 7, notes 5 and 6. The appellant objected with regard to this citation that the cited passages only referred to German Law. This is, however, not correct. The cited passages expressly mention Article 60(1) and (3) EPC and state that these provisions correspond to §§ 6, first sentence, and 7(1) PatG (German Patent Law). Moreover, the reference to the cited passages was made only to explain what the distinction meant, and this meaning was not as such contested by the appellant.

The Board is unable to endorse the appellant's opinion that the term "applicant" in Article 60(3) EPC could, in the case of joint applicants, be taken to mean the joint applicant to whom the invention to which the procedural act relates (here: the filing of the divisional application) belongs according to Article 60(1) EPC. The difference in terminology used in Article 60(1) and (3) EPC respectively ("inventor or successor in title" in (1) and "applicant" in (3)) is intentional and reflects the above-defined different aspects of the industrial property right. The distinction made in Article 60(1) EPC, on the one hand, and in Article 60(3) EPC, on the other, between the right to the patent as a matter of substantive law depending on who made the invention and the procedural right to the patent depending on who has the procedural status of applicant was deliberate. The EPO should not be concerned with questions of entitlement in terms of substantive law and should have no power to determine disputes as to whether or not a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application (G 3/92, OJ EPO 1994, 607, point 3 et seq. of the reasons). Any such questions should be left to the competent national authorities, in particular to the national courts, according to the "Protocol on Recognition". In point 3.3 of the reasons for decision G 3/92, the Enlarged Board of Appeal also emphasises that a court of the appropriate contracting state is the only forum before which a lawful applicant may commence proceedings to establish his right to the grant of a European patent.

As a second auxiliary request, the appellant asked that the question of whether the legal fiction under Article 60(3) EPC only relieved the EPO of a need to investigate the existence of the applicant's entitlement under Article 60(3) EPC be referred to the Enlarged Board of Appeal.

However, it is clear from the above-cited findings of the Enlarged Board of Appeal in decision G 3/92 that this question has already been clearly answered by the Enlarged Board of Appeal in the sense that the EPO not only does not need to, but has no power to, investigate questions of entitlement. Thus, there is in this respect neither an, as yet, unresolved, important point of law nor have conflicting decisions been given by the boards of appeal.

In conclusion, in the case of joint applicants, the procedural rights to be derived from the filing of the parent application belong to the registered joint applicants in common with respect to the entire subject-matter of the application as a whole and no distinction can be made as the joint applicant to whom any particular subject-matter of the application belongs as a matter of substantive law.

3. Article 61 EPC and the provisions concerning a transfer of rights, namely Article 72 in conjunction with Rule 20 EPC, define the conditions under which the EPO may take into account questions of substantive law and procedural acts by a person other than the registered applicant. The appellant has however always maintained (see also below) that neither of these provisions is fulfilled in the present case. The appellant has also

made it clear from the outset that there was no error within the meaning of Rule 88 EPC and that the filing of the divisional application in suit in the name of the appellant alone was deliberate.

4. In decision J 34/86 of 15 March 1988 cited by the appellant, the Legal Board of Appeal allowed the filing of an application as a divisional application by a person other than the registered applicant for the parent application. Whereas the appellant had originally accepted the Receiving Section's view that no conclusions could be derived from this decision for the present case, in the oral proceedings before the Board the appellant appears to have returned to the view that the Board's finding in decision J 34/86 could have some form of analogous application to the present filing of a divisional application in the name of only one of the registered applicants for the parent application.

It is true that in point 3 of the reasons for that decision the Board made a fairly general statement by saying that a divisional application may also be filed by a person other than the applicant for the parent application on the basis of an assignment as provided for in Article 72 EPC requiring the signature of the parties to the contract.

However, as the Receiving Section has already pointed out, the case underlying decision J 34/86 concerned a very particular set of circumstances. In that case, the applicant for the parent application had been ordered by a US court to assign all property rights in the invention defined by certain claims of the parent

application to the applicant for the divisional application, and the applicant for the parent application had already signed an assignment to that effect. Thus, in that case it was clear that the applicant for the parent application had accepted that he was not entitled to obtain patent protection for all the subject-matter covered by his application as filed and had already released the subject-matter covered by his assignment (point 5. of the reasons).

In the present case, no information was ever given as to what the co-applicant for the parent application might think about the appellant filing in its own name alone a divisional application in respect of the subject-matter of the invention defined by the appellant as Invention 1. The appellant has not even submitted that the co-applicant for the parent application would not have objected to that. Instead, throughout the proceedings, the appellant exclusively relied on its opinion that it was entitled to file a divisional application in its own name alone for the subject-matter of Invention 1.

5. The Board is unable to follow the appellant's argument that according to Article 60(3) EPC the EPO was not allowed to question the appellant's entitlement to file the application in suit. In the present case, the objection is not whether the appellant was entitled to file an application as such but whether it was entitled to file a divisional application in its own name alone.

5.1 If an application is recognised as a valid divisional application it benefits from the filing and priority dates of the parent application. This right derives

from Article 76 EPC only. In contrast to the right to file a "normal" application according to Article 75 EPC which can only benefit from its own relevant dates and disclosure (a right belonging to any person according to Article 58 EPC) the right to file a divisional application according to Article 76 and Rule 25 EPC and according to Article 4G Paris Convention is a procedural right that derives from the applicant's status as applicant for the earlier application. It is not a right which derives from the substantive right to the invention defined in Article 60(1) EPC.

Article 4G Paris Convention makes this quite clear by providing that the applicant may divide the application. Interpreting the right to file a divisional application under Article 76 EPC as a procedural right which derives from the status of being the applicant for the earlier application is thus entirely in line with and perfectly corresponds to the wording of Article 4G Paris Convention.

5.2 Therefore, a problem of the kind as addressed in decision J 11/91, OJ EPO 1994, 28, point 2.3.4 of the reasons, cited by the appellant, as to whether certain elements of a lower-ranking rule of law, ie the limitation of the point in time up until which a divisional application could be filed according to the then applicable Rule 25 EPC, were incompatible with Article 4G Paris Convention, does not arise in the present case.

It is correct that in this decision the Board also posed the question of whether the "new" time limit introduced in Rule 25(1) EPC was a procedural matter or

a question of substantive law. After stating that the test should be: "Does the new rule cut down the rights of the applicant in some significant way?", the Board answered that the introduction of a time limit before the real conclusion of the proceedings appeared to it to be an unjustified substantial limitation of this essential right of the applicant. It is apparent from the foregoing that in this context the Board did not use the word "substantial" in the sense of having to do with the substantive right to the invention as defined in Article 60(1) EPC, but in the sense of referring to "important" limitations on the rights of divisional applicants, as opposed to other formal conditions to be complied with by divisional applications, such as, eg, respecting the time limits for paying certain fees. It cannot be inferred from the passages cited by the appellant that the Board meant to doubt that the right to divide the application according to Article 4G Paris Convention was as such a procedural right deriving from an applicant's status as the applicant for the earlier application.

6. Since the divisional application results in substance in a splitting-up of the parent application, even if under Article 76 EPC it takes the form of a further application, it is the entitlement acquired by the parent application that extends to the divisional application. This means that the rights derivable for the divisional application from the earlier application extend to, but are also limited to, the rights existing in the parent application at the filing date of the divisional application (J 19/96 of 23 April 1996, unpublished, point 2.1.3 of the reasons). Thus, according to Rule 25(1) EPC the earlier application

must still be pending at the filing date of the divisional application. According to Article 76(1), second sentence, EPC, the subject-matter of the divisional application may not extend beyond the content of the earlier application as filed (see eg J 19/96, loc.cit, T 873/94, OJ EPO 1997, 456). Where subject-matter has been unequivocally and definitively abandoned in the parent application there is neither a right to claim such subject-matter again in the parent application nor the right to file a divisional application based on it (J 15/85, OJ EPO 1986, 395, points 4 and 5 of the reasons). According to Article 76(2) EPC, the divisional application may not designate contracting states not designated in the earlier application. Moreover, the designation must still be valid at the filing date of the divisional application (J 22/95, OJ EPO 1998, 569, point 2.6 of the reasons, J 19/96, points 2 et seq. of the reasons). By the same token, it is to be concluded that, in the case of joint applicants for a parent application, a divisional application can, as a matter of principle, only be filed by these applicants in common and not by one of them alone, because each of the joint applicants for the parent application only has the status of a party in common with the other joint applicant(s) and therefore can only exercise his party rights in common with him or them.

7. Further, such an interpretation of Article 76 EPC, in conjunction with Rule 25 EPC, as claimed by the appellant, could lead to injustice in that the applicant who decided to file a divisional in his name alone could deprive the others, without their knowledge and/or consent, of their procedural right to be

co-applicants for any divisional application filed from the parent application. The others would thereby also be prejudiced in their right under Article 60(3) EPC to the grant of a patent for any subject-matter originally contained in the parent application filed by them. It is with a view to avoiding that happening that the rules and procedures laid down in Articles 60 and 61 and Rule 20 EPC have been established and that in proceedings before the EPO only the registered applicants are entitled to act.

Because it is the very aim of the provisions discussed here that the EPO should not consider questions of entitlement, no presumption of the applicants acting in good faith can be applied, nor can it be taken into consideration that in the present case there may have been no ownership dispute, as the appellant has submitted.

8. The appellant's argument based on Rule 17 EPC was refuted for the right reasons in the Receiving Section's decision. As the appellant did not really attack this finding on appeal, this issue need be pursued no further in the reasons for the present decision. As regards the appellant's argument that it was not possible for the appellant to record an assignment from the co-applicant for the parent application without contravening Rule 20 EPC, because the co-applicant had never had rights to the invention to which the divisional application was directed, the Board observes that, for the purpose of registering a transfer in accordance with Rule 20 EPC, it would be sufficient for a co-applicant to agree to the

application being prosecuted further in the sole name of the other applicant.

9. In its written submissions, the appellant pointed out that the 1999 version of the Guidelines for Examination for the first time contained a reference to the principle that the right to file a divisional application belonged to the applicant for the parent application. However, no specific legal conclusions were drawn by the appellant from that fact and the Board also sees none. It is not the function of the Guidelines for Examination, nor is there an obligation for these to do so, to deal with every legal issue that may arise in proceedings before the EPO.

10. The position taken by the Board on the present issue is wholly in line with the legal principles relating to divisional applications hitherto applied in the above-cited jurisprudence of the boards of appeal. In the view of the Board, the present decision applies the same legal principles to yet another aspect of the filing of divisional applications. With respect to the question underlying the appellant's first auxiliary request for a referral to the Enlarged Board of Appeal, there is therefore neither an, as yet, unresolved, important point of law which the Legal Board of Appeal could not decide on its own nor is there any divergence from previous decisions of the boards of appeal within the meaning of Article 112 EPC. There was therefore no reason to refer the question formulated by the appellant as first auxiliary request to the Enlarged Board of Appeal either.

11. The appellant submitted that eight contracting states to the EPC allowed divisional applications to be filed by fewer than all applicants for the parent application, "subject to certain administrative conditions". However, apart from the fact that the expression "subject to certain administrative conditions" is very vague and can mean anything or nothing, the Board notes that this assertion made at a very late stage of the proceedings, ie at the oral proceedings before the Board, was not corroborated by evidence.

The only document submitted by the appellant is an extract from the Manual of Patent Practice, fifth edition, May 2003, reflecting the UK practice. Point 15.24, referred to by the appellant, states that a divisional application must be filed by the original applicant for the parent application or by his successor in title. It goes on to say that where more than one applicant is named in the parent application, it is possible for the divisional application to be filed by some only of the original applicants. However, it says further that, where the applicants in the parent and divisional applications differ and no explanation is either apparent or submitted, the formalities examiner should raise an objection, and the application cannot proceed as a divisional if the provisions of Section 15(4) have not been complied with. Section 15(4) reads, as far as it is relevant here: "Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his successor in title ....".

It is apparent therefrom that, even for the UK, the assertion by the appellant that UK law and practice allowed a divisional application to be filed by fewer than all the applicants, "subject to certain administrative conditions", is not legally correct. Section 15(4) allows a divisional application to be filed by the successor in title. As point 15.24 of the Manual makes clear it must be shown that there was succession in title. Otherwise the application cannot be prosecuted as a divisional application. That succession in title must have taken place is not an administrative condition but a significant procedural requirement that a person other than all the applicants for the parent application must comply with in order to be entitled to file a divisional application in his name alone.

What the requirements are for allowing a successor in title to act as an applicant is a matter for the applicable national law. According to Rule 20(3) EPC, documents must have been produced that satisfy the EPO that the transfer has taken place.

However, in the present case, the appellant maintained throughout the proceedings that there was no succession in title but that the appellant was entitled in its own right to file a divisional application in its name alone. It cannot be inferred from the document submitted by the appellant that in UK law and practice the present legal situation would have been treated in the same way as a legal succession, any more than it would have been in other contracting states to the EPC.

12. The Board therefore concludes that where an application (the "earlier application") has been filed jointly by two or more applicants and the requirements of Article 61 or Rule 20(3) EPC have not been met, the right to file a divisional application in respect of the earlier application under Article 76 EPC is only available to the registered applicants for the earlier application jointly and not to one of them alone or to fewer than all of them.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

S. Fabiani J.-C. Saisset