

## **Decision of the Legal Board of Appeal dated 4 October 2004**

### **J 28/03 - 3.1.1**

(Language of the proceedings)

Composition of the board:

Chairman: J.-C. Saisset  
Members: H. Preglau  
M. B. Tardo-Dino

**Applicant: Ericsson Inc.**

**Headword: Divisional application/ERICSSON INC.**

**Article: 106, 107, 121 EPC**

**Rule: 25(1), 51(6) EPC**

**Keyword: "Meaning of suspensive effect" - "Divisional application (no)"**

*Headnote:*

*Suspensive effect means that the consequences following from an appealed decision do not immediately occur after the decision has been taken. Actions normally taking place after a decision are "frozen". Suspensive effect does not have the meaning of cancellation of the appealed decision. Even after an appeal the decision as such remains and can only be set aside or confirmed by the Board of Appeal.*

*The status of a divisional application filed while an appeal against the decision to grant a patent on the parent application is pending depends on the outcome of that appeal. Therefore, the department of first instance cannot decide on the question whether the divisional application has been validly filed until the decision of the Board of Appeal on the appeal is taken.*

#### **Summary of facts and submissions**

I. European patent application No. 99 911 255 (parent application) was filed on 8 March 1999 as an international patent application PCT/US99/05159 and entered into the European phase on 24 August 2000. The communication under Rule 51(4) EPC was sent on 30 July 2001. The approval of the text in which the grant of the patent was intended was given with letter dated 20 September 2001.

II. A communication according to Rule 51(6) EPC was sent on 8 October 2001. On 27 February 2002 the applicant was informed that the application was deemed to be withdrawn. A request pursuant to Article 121 EPC was filed on 18 April 2002 and was accepted by the Office on 13 May 2002. On 15 May 2002 the Office informed the applicant that the mention of the grant of the patent would be published in European Patent Bulletin 02/26 of **26 May 2002**.

III. On **25 July 2002** an appeal was filed against the decision dated 15 May 2002 to grant the patent and the appeal fee was paid accordingly.

As no statement of grounds of appeal was filed, the appeal was rejected on 16 July 2003 as inadmissible (T 1187/02).

IV. On **22 August 2002** European patent application No. 02 018 257 was filed as a divisional application from the above-mentioned parent application.

On 11 December 2002 the Office informed the applicant (noting of loss of rights) that according to Rule 25(1) EPC the application could not be treated as a divisional one because at the date of filing the European Patent Register had already mentioned the grant of the parent application.

V. With letter dated 12 February 2003 the applicant requested a formal decision pursuant to Rule 69(2) EPC and argued that due to the appeal T 1187/02 and its suspensive effect the parent application was pending at the time when filing the divisional application.

VI. Following this request the Receiving Section issued a formal decision dated 23 April 2003 and referred in the reasons to the amended Rule 25 EPC and the Notice of the European Patent Office dated 9 January 2002, published in OJ 2002,112, the latter making clear that a divisional application can only be filed whilst the parent application is pending.

VII. According to the Notice mentioned above an application is pending up to (but not including) the date of the mention of the grant of the European patent in the European Patent Bulletin or until the date of a decision that the application is refused. If notice of appeal is filed against the decision to refuse, a divisional application may still be filed while appeal proceedings are under way.

It further argued that no decision was made by the Examining Division against which the applicant could appeal because a positive decision to grant the patent was issued and the applicant was asked before for his approval which was given unconditionally.

VIII. With reference to decision T 549/93 (not published in the OJ), it was stated that in the case in suit Article 107 EPC was not applicable because the applicant gave his approval to the text and was obviously not adversely affected by the decision to grant the patent.

IX. The filing of the appeal only to re-open the examining procedure to file a divisional application had to be regarded as a clear abuse of Article 106 and 107 EPC and could not lead to a suspensive effect in the meaning of Article 106(1) EPC.

X. The present appeal was lodged on 23 June 2003 against this decision. The appeal fee was paid the same day and the statement of grounds of appeal were filed 25 August 2003. It was requested to set aside the decision of the Receiving Section and to treat the European patent application No. 02 018 257 as a divisional one. As an auxiliary request oral proceedings were requested.

XI. In the grounds of appeal the appellant argued that the divisional application was filed on 22 August 2002, which date is before 16 July 2003, the date of the decision in the appeal procedure T 1187/02. It follows from the suspensive effect of an appeal that the appealed decision (to grant the patent) did not become final, but had to be put on hold, at least until the appeal was decided. Consequently the parent application was pending until the date of the decision in case T 1187/02 and the European patent application No.02 018 257 had to be treated as a divisional one. He therefore requested to set aside the decision of the Noting of loss of rights and to accord the before-mentioned application the status of a divisional one.

XII. Together with the summons to oral proceedings the Board issued the preliminary opinion, that the appeal against the decision to grant the patent on basis of the approved text of the (parent) application cannot benefit from the particular suspensive effect of an appeal against the refusal of a patent application.

XIII. With letter dated 16 September 2004 the appellant informed the Board that he would not attend the oral proceedings and asked for a decision on basis of the documents on file.

### **Reasons for the decision**

1. The appeal is admissible.

2. In its decision concerning the appeal T 1187/02 against the decision to grant the European patent No. 1 062 826 (Application No. 99 911 255), which should serve as the parent application, the Board stated that because of missing statement of grounds of appeal it was not in a position to examine whether the impugned decision was wrong and whether or not the appellant was adversely affected by it. Concerning a possible suspensive effect it stated that this question was not to be decided in that case.

3. It is now up to this Board to consider the circumstances not only of the divisional patent application but also those of the parent application and especially with the effect of the appeal against the decision to grant the parent application.

4. To allow a divisional application several preconditions have to be met. The crucial point is the status of the parent application.

Amended Rule 25 EPC which applies to the case in suit states that a divisional application may be filed on any pending earlier European patent application.

An application is pending up to (but not including) the date that the European Patent Bulletin mentions the grant of the European patent, or until the date that the application is refused, withdrawn or deemed withdrawn; if notice of appeal is filed against the decision to refuse, a divisional application may still be filed while appeal proceedings are under way (see Notice of the Office dated 9 January 2002 concerning amendment of Rule 25(1), 29(2) and 51 EPC, published in OJ 2002,112).

5. The parent application was published in the European Patent Bulletin on 26 May 2002. This publication ended the pending status of this application and also the possibility to file a divisional application. An application filed on 22 August 2002 does not fulfil the precondition of Rule 25(1) EPC that a pending earlier application must exist in relation to which a divisional application may be filed, because the pending status of the earlier application already ended on 26 May 2002.

6. Exemptions to that precondition are only made in case of an appeal against a decision to refuse the parent application. Only in such a case is a divisional application allowed as long as the appeal procedure has not been terminated (see again the wording of amended Rule 25(1) EPC and the Notice of the Office in OJ 2002, 112).

7. Applied to the present case it is clear that a divisional application filed nearly three months after the publication of the patent in the European Patent Bulletin does not fulfil the precondition that an earlier application must still be pending.

8. As the decision to grant the patent was a positive one, going fully along with the request of the applicant, the exemption mentioned in the Notice of the Office concerning the amendment of Rule 25(1) and others EPC cannot be applied as there was no refusal which would be open to appeal.

9. Consequently the appeal against the decision to grant the patent as requested by the applicant cannot benefit from the particular suspensive effect of an appeal against a refusal of a patent application.

10. Although the exemptions result from a Notice of the Office which does not have a legally binding character on the decisions of the Board it has to be stated that in the present case the Board fully shares the explanations and interpretations given in the Notice concerning divisional applications.

11. The logical idea behind the Notice of the Office concerning the amendments of Rule 25(1) and other Rules of the EPC mentioning that only an appeal against a refusal of the patent application would allow the filing of a divisional application was to enable a party to file a divisional application independently of the outcome of the appeal, in other words even if the refusal of the "parent application" would have been confirmed by the Board of Appeal the divisional application would have its own and independent examining procedure.

On the other hand an appeal against a decision granting a patent and resulting in the publication of the grant of the patent would be expected to be inadmissible with respect to Article 107(1) EPC and should therefore not benefit of the possibility to file a divisional application even during the appeal procedure. This can also be understood as to avoid abusive appeals to construe artificially pending "parent applications".

12. As it seems that there is a substantial misunderstanding what usually a suspensive effect means the Board wants to emphasise that the suspensive effect does not have the meaning of an immediate cancellation of the appealed decision. This is clearly not true. Suspensive effect means that the consequences following from an appealed decision do not immediately occur after the decision has been taken but that every action is frozen until the final decision on the appeal is taken and the decision of the first instance is either confirmed or set aside. In the intermediate period between the filing of an appeal and the final decision of the Board of Appeal the fate of the appealed decision is pending although the decision as such still exists.

13. In no way suspensive effect can be interpreted as having the same effect as a cancellation of a decision by a higher instance. Only the final decision of a Board of Appeal can either set aside an impugned decision with the effect to make it disappear and to put back a procedure to the status where it was before the first instance took its decision or can confirm the first instance's decision and so terminate its pending status.

14. It is a matter of fact that once an appeal has been filed, the Board of Appeal before which it had been lodged has the only competence to decide whether or not this appeal is admissible. According to the suspensive effect of an appeal (Article 106(1) EPC) a contested decision does not develop any effect until the final decision of the Board which in case of the European application No. 99 911 255 ("parent application") was meaningless because the grant of the respective patent was already published in the Patent Bulletin but was of importance for a possible divisional application.

15. The difference between an appeal against a refusal of a European patent application and an appeal against the decision to grant a European patent with respect to the filing of a divisional application lies in case of the first kind of appeal in the benefit to file a divisional application even during the appeal procedure and the guarantee that this divisional application can survive even in case of a refusal of the appeal for whatever reasons. This approach allows to get possibly a patent although the applicant failed with his request concerning the parent application.

16. In case of an appeal which is not directed against the refusal of a European patent application the situation is quite different. There is already a patent granted. In such a case every further action (not only divisional applications) is completely depending on the outcome of the appeal proceedings. In other words one has to wait until the final decision by the Board of Appeal is taken. And it is the order which is decisive for the further consequences.

17. In case T 1187/02 the Board finally decided to reject the appeal as inadmissible. That it expressly stated that it could not decide whether or not the appeal had suspensive effect is of no relevance for the current case. The consequence of that decision was that the party was put back to the legal situation existing at the time of the grant of the patent as if no appeal had been lodged. Therefore the Examining Division rightly decided that European patent application No. 02 018 257 could not be treated as a divisional one because it was filed after the publication of the grant of that patent which should serve as the parent application.

18. As was pointed out earlier the suspensive effect as consequence of an appeal does not allow to ignore the existence of an already taken decision. It only interrupts the normally following further steps until the definite decision of the last instance has been taken. Under these aspects it does not matter if the appeal might have been obviously inadmissible from the very beginning or if it was rejected as inadmissible at a later stage.

19. Under these circumstances the Board could only confirm the decision of the Examining Division and had to dismiss the appeal.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.