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**D E C I S I O N**  
**of 20 September 2005**

**Case Number:** J 0003/04 - 3.1.1

**Application Number:** 02079519.1

**Publication Number:** -

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**Language of the proceedings:** EN

**Title of invention:**  
Remote learning system

**Applicant:**  
Guy, Frederick R.

**Opponent:**  
-

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 64(1), 76, 97(4), 122  
EPC R. 25(1), 83(1)

**Keyword:**  
-

**Decisions cited:**  
J 0021/96, J 0010/01, J 0024/03, J 0007/04

**Catchword:**  
-



Case Number: J 0003/04 - 3.1.1

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.1  
of 20 September 2005

**Appellant:** Guy, Frederick R.  
850 Fay Road  
Syracuse  
NY 13219 (US)

**Representative:** Boesen, Johnny Peder  
Zacco Denmark A/S  
Hans Bekkevolds Allé 7  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office posted on 12 August 2003  
refusing the request to set aside the  
notification pursuant to Rule 69(1) EPC, not to  
treat the European patent application  
No. 02079519 as a divisional application.

**Composition of the Board:**

**Chairman:** J.-C. Saisset  
**Members:** U. Tronser  
M. B. Tardo-Dino

## **Summary of Facts and Submissions**

- I. The appeal lies against the decision of the Receiving Section that the European patent application 02079519.1 will not be treated as a divisional application, because when it was filed the European Patent Bulletin had already mentioned the grant of a patent in respect of the earlier European patent application 97905597.7.
  
- II. The application in suit was filed as a divisional application to the earlier European patent application 97905597.7 on 30 October 2002, the same date on which in European Patent Bulletin 02/44 the mention of the grant of a patent in respect of the earlier European patent application was published.
  
- III. In response to a communication of the Receiving Section dated 9 December 2002 informing of a loss of rights pursuant to Rule 69(1) EPC, the appellant requested under cover of a letter dated 23 December 2002 to issue a decision according to Rule 69(2) EPC and as an auxiliary request re-establishment according to Article 122 EPC of the rights that were lost by failure to file the divisional application before the mention of the grant of a patent in respect of the earlier application was published. Furthermore it filed an appeal against the decision to grant a patent in respect of the earlier application at the same date. This appeal had the file number T 135/03 falling under the competence of the Technical Board of Appeal 3.4.2.
  
- IV. On 12 August 2003 the Receiving Section issued the above mentioned decision and rejected the appellant's request for re-establishment of rights as well.

It stated that in a Notice of the European Patent Office dated 9 January 2002 concerning amendments of Rules 25(1), 29(2) and 51 EPC, published in Official Journal 2002, 112 it was made clear, what is the last day for filing a divisional application, namely: " 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. Thus the last day for filing a divisional application was Tuesday, 29 October 2002.

Even though the applicant had filed an appeal against the decision to grant a patent with respect to the earlier application this could not shift the last day issue to its merits. Since the appeal was against a positive decision and therefore must be regarded as a clear abuse.

With regard to the auxiliary request the Receiving Section held, that due to Article 122(5) EPC and as there was no time limit set by the EPC to file a divisional application re-establishment of rights was not possible.

- V. On 22 October 2003 the appellant lodged an appeal and paid the appeal fee simultaneously. In its grounds of appeal filed on 22 December 2003 it essentially argued as follows:

A new piece of prior art relevant to the parent application was brought to its attention after a press release concerning the grant of the European patent. This piece of prior art was filed with the notice of appeal in case T 135/03 on 23 December 2002. Having studied the contents of the piece of prior art, it was found that although it did not seem to make the patent invalid, it was so relevant that it should be identified and commented on in the description of the patent, as this might save the applicant from some national proceedings. Furthermore the suspensive effect of the appeal against the grant of the patent did not depend on the admissibility of the appeal.

Although the EPC was not precise in respect of the term "pending earlier European patent application", it does provide good reasons to believe that the date of the mention of the grant should also be considered as a legally valid date for filing a divisional application. The specific provisions of the EPC i.e. Article 76 and Rule 25 were not sufficiently precise in this respect, but it could be inferred from Article 141(2) EPC a provision regarding renewal fees that the post-grant period of a European patent, which was the national life of the European patent, starts the day after the publication of the mention of the grant. It could be inferred from Article 86(4) EPC that in the year in which the mention of the grant of the European patent is published, the patent is considered as an application.

Furthermore any act to be performed as a consequence of the grant of a European patent, specifically the filing of the required translations according to Article 65 EPC, started after the grant.

Whenever a time limit has to be calculated it followed from Rule 83 EPC that the day when a triggering event happens is not considered in computing the relevant time limit.

It also followed from Article 54(2) EPC that the legal effect of any publication begins from the day after publication. Therefore it is to be concluded that the grant of a European patent is effective from the day after the mention of the grant and that on the day of the mention of the grant the corresponding patent application is still pending.

With regard to the rejection of its request under Article 122 EPC the appellant argued essentially that the cited decision J 21/96 referred to a version of Rule 25(1) EPC, which was not comparable to the present version of the provision. The time limit for filing a divisional application was now given by the European Patent Office by stating the date, on which the mention of the grant will be published (within its decision to grant a European patent pursuant to Article 97(2) EPC). The appellant could not share the opinion different from this point of view stated in the decision J 10/01.

Furthermore during the time period from the filing of a European patent application to the day before the date of mention of the grant of the patent the applicant had

the right to file a divisional application. If a divisional application is not filed within that time period, the right to file a divisional application was lost. Thus there was a time limit set by the EPO, and a right was lost if the time limit was not complied with.

VI. By letter dated 29 November 2004 the appellant had withdrawn its appeal against the decision to grant a patent in respect of the earlier patent application. The appeal proceedings in case T 135/03 - 3.4.2 were thus closed.

VII. In a communication send to the appellant the Board inferred that thus the appeal proceedings being closed the suspensive effect of the appeal T 135/03 could not be a point at issue for the appeal J 3/04. Furthermore the Board held that the factual and legal situation seemed to be congruent with that underlying the decision J 7/04, which was enclosed in the communication.

With regard to the appellant's request for re-establishment its attention was drawn to the decisions J 24/03 and J 10/01, which were enclosed in the communication as well.

VIII. Though invited to file observations to this communication, the appellant did not answer in writing. Oral proceedings were scheduled for 20 September 2005.

IX. During the oral proceedings the appellant requests:

That the decision under appeal be set aside and that the application 02079519.1 be processed as a European

divisional application to the earlier European patent application 97905597.7 according to Rule 25(1) EPC.

Auxiliary

He requested re-establishment of his rights to file the divisional application, that were lost by failure to file it before the mention of the grant of a patent.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. As to the admissibility of a divisional application Rule 25(1) EPC stipulates:  
  
"The applicant may file a divisional application relating to any pending earlier European patent application."  
  
3. To decide on the merits of the appellant's main and auxiliary request the Board consequently has to interpret the words "relating to any pending earlier European patent application".
4. Since the appellant has withdrawn its appeal in case T 135/03 - 3.4.2 against the decision to grant a patent in respect of the earlier application 97909597.7 the suspensive effect of this appeal ceased to be a point at issue for the appeal underlying this decision and the mention of the grant of the patent is valid from



the outset, as the appellant had admitted this during oral proceedings.

5. With regard to the reasons of the decision under appeal (point II, 9) the Board however takes the opportunity to point out that the suspensive effect of an appeal does not depend on the admissibility of the appeal or on the answer to the question if an appellant is adversely affected according to Rule 107 EPC and that the assumption of a procedural abuse needs to be substantiated carefully.
6. But the appellant's argumentation that the grant of a European patent is effective from the day after the mention of the grant and that on the day of the mention of the grant the corresponding patent application is still pending is contradictory to the relevant provisions of the EPC.
7. According to Article 64(1) EPC "A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date of publication of the mention of its grant, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State".

In the French version of Article 64(1) EPC the date on which the grant of a European patent becomes effective is established by the following terms:

"... à compter du jour de la publication de la mention de sa délivrance...." and in the German version by the words: "...von dem Tag der Bekanntmachung des Hinweises auf seine Erteilung ...".

In line with these provisions under Article 64(1) EPC Article 97(4) EPC rules." The decision to grant a European patent shall not take effect, until the date on which the European Patent Bulletin mentions the grant". In the French and the German version Article 97(4) EPC words: "La décision relative à la délivrance du brevet européen ne prend effect qu'au jour de la publication au Bulletin européen des brevets de la mention de cette délivrance" and " Die Entscheidung über die Erteilung des europäischen Patents wird erst an dem Tag wirksam, an dem im Europäischen Patentblatt auf die Erteilung hingewiesen worden ist".

8. If the grant of a European patent becomes effective on the date of the publication of the mention of its grant, the patent application consequently ceases to be pending on the same date.
9. The appellant cannot reverse the principal laid down in Article 64(1) and Article 97(4) EPC to the merits of its appeal by citing special provisions of the EPC concerning the payment of renewal fees, the filing of a translation of the specification of the European patent, the calculation of time limits or the determination of the state of the art which are specific measures taken in specific circumstances and are as such exceptions to the afore mentioned principle.
10. Thus the appellant's main request cannot succeed.
11. The appellant's auxiliary request for re-establishment of rights according to Article 122 EPC which moreover

should not be excluded by Article 122(5) EPC can only succeed if Rule 25(1) EPC imposes a time limit for filing a divisional application.

12. It follows from the above cited wording of Rule 25(1) EPC (see the reasons for the decision point 2) and the reasons of this decision with regard to the appellant's main request (see the reasons for the decision points 2 to 9) that the divisional application should have been filed before the publication of the mention of the grant because after that point in time the necessary condition for filing a divisional application, i.e. that the earlier application is still pending, is not fulfilled.
  
13. In line with the Case Law of the Legal Board of Appeal (see for example J 21/96 and J 10/01) it is set out in the decision J 24/03 point 4 of the reasons for the decision: " In procedural law, the fact that a conditional act can only be accomplished before a particular set of circumstances foreseen by a legal provisions occurs (condition), is conceptually different from a set period of time imposed for doing an act (time limit) because in the first case the duration of the period in time in which the act should be completed is determined by the occurrence of the condition itself, whereas in the second case it is pre-determined from the outset".
  
14. This definition of a time limit as a period of time which is pre-determined from the outset is corroborated by the provisions of Article 120(a) and Rule 83(1) EPC, where the criteria for the calculation of time limits are established as follows: "Periods shall be laid down

in terms of full years, months, weeks or days". The duration of the period in time within which a divisional application should be filed cannot be laid down in terms according to Rule 83(1) EPC. It is all the more so since Article 76(3) EPC which provides for all requirements for filing a divisional application refers to "time limit" only for fees but refers as for the rest to "conditions".

15. For this reason the request for re-establishment of rights is not admissible.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset