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D E C I S I O N
of 9 November 2004

Case Number: J 0007/04 - 3.1.1

Application Number: 03004171.9

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

Oligonucleotides specific for hepatitis B virus

Applicant:

HYBRIDON, INC.

Opponent:

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Headword:

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Relevant legal provisions:

EPC Art. 64(1), 76, 97(2)

EPC R. 25(1)

Keyword:

"Application of Rule 25(1) EPC"

"Filing of divisional application time limit"

Decisions cited:

J 0007/96. J 0021/96, J 0010/01

Catchword:

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Case Number: J 0007/04 - 3.1.1

D E C I S I O N
of the Legal Board of Appeal 3.1.1
of 9 November 2004

Appellant: HYBRIDON, INC.
345 Vassar Street
Cambridge,
Massachusetts 02139 (US)

Representative: Grund, Martin, Dr.
Dr. Volker Vossius
Patentanwaltskanzlei
Geibelstrasse 6
D-81679 München (DE)

Decision under appeal: Decision of the Receiving Section dated
22 September 2003 rejecting the divisional
application filed on the date of the
publication of the mention of the grant of the
parent application.

Composition of the Board:

Chairman: J.-C. Saisset
Members: E. Lachacinski
M. J. Vogel

Summary of Facts and Submissions

- I. European patent application 96 918 671.7 was filed on June 4, 1996 as international patent application PCT/EP96/02432. It entered into the European phase on January 7, 1998.
- II. On January 16, 2003, after various amendments, the applicant was informed that the mention of the grant of the European patent would be published in European Patent Bulletin 03/09 of February 26, 2003.
- III. On February 26, 2003, European patent application 03 004 171.9 was filed as a divisional application to the above-mentioned earlier patent application 96 918 671.7.
- IV. In a communication dated April 14, 2003 the Receiving Section informed the applicant that European patent application 030 041 171.9 could not be treated as a divisional application because when it was filed the European Patent Register had already mentioned the grant of a patent in respect of the earlier European patent application 96 918 671.7.
- V. On September 23, 2003, the Receiving Section issued a decision rejecting the applicant's request to accept the divisional application filed on February 26, 2003.

It stated that in accordance with Article 76 and Rule 25(1) EPC the last day for filing a divisional patent application was the day before the earlier procedure was terminated, i.e. the day before the mention of the grant of the earlier patent application.

The fees which had been paid in connection with the filing of European patent application 03 004 171.9. were refunded.

- VI. On November 21, 2003, an appeal was lodged against the decision. The appeal fee was paid on the same day and the statement of grounds on January 23, 2004.
- VII. The appellant requests that the decision under appeal be set aside and that European patent application 03 004 171.9 be accepted as a divisional application of the earlier European patent application 96 918 671.7 in accordance with Article 76 and Rule 25(1) EPC.
- VIII. The appellant's arguments can be summarised as follows:
- neither Article 97(4) nor Rule 25(1) EPC mentions any date before which the divisional application has to be filed and does not clearly specify the meaning of the term "pending",
 - the Receiving Section does not cite an article or a rule of the EPC that defines a time limit for filing a divisional patent application,
 - Decision J 7/96 (OJ 1999, 443) does not state exactly when the application ceases to be pending,
 - the European patent application ceases to be pending not before the date of the mention of the grant of the patent in the European Patent Bulletin, but rather on that date,

- according to decisions J 21/96 and J 10/01 in combination, the time restriction for filing a divisional patent application is not a time limit but merely identifies a point in the grant procedure after which a divisional application may no longer be filed,
 - "the point in the grant procedure" cannot be anything other than the date on which the mention of the grant of the parent application is published,
 - only the EPC's text and Implementing Regulations are binding in legal terms, and the Notice dated 9 January 2002 concerning the amendment of Rules 25(1), 29(2) and 51 EPC only reflects the EPO's opinion without binding effect for the Boards of appeal.
- IX. On July 6, 2004 the Board sent the appellant a communication containing a provisional opinion set out in substantially the same terms as the Reasons below and directing the appellant to file any comments thereon or any further requests by way of written submissions within two months of the deemed date of receipt of the communication. The communication concluded by stating that, subject to any such submissions, a decision might be issued after that date.
- X. No reply was received to the communication and oral proceedings were not requested.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 (a) and (b) EPC and is therefore admissible.
2. The Board shares the applicant's view that articles and rules of the EPC do not exactly define the date after which a divisional application can be filed. The Board also agrees with the applicant's opinion about the implementation of the notice dated January 9, 2002 concerning the amendment of Rule 25(1), 29(2) and 51 EPC (point 3.2 of the grounds of appeal) which only reflects the EPO's opinion on various issues.

The sole provisions to be implemented concerning the admissibility of a divisional application are contained in Rule 25(1) EPC in the version set out in the Decision of the Administrative Council of October 18, 2001: *"The applicant may file a divisional application relating to any pending earlier European patent application"*.

3. The Board consequently had to interpret the words "relating to any pending earlier European patent application", principally in the light of Decision J 07/96 (OJ 1999, 443).

As requested by the applicant, the Board takes account of the grounds set forth in Decision J 10/01 (not published, see in particular point 16 of the Reasons), which stated that according to Decision J 21/96 (also not published) Rule 25(1) EPC did not lay down a time limit within the meaning of Article 122(1) EPC but

merely identified a point in the grant procedure after which a divisional application may no longer be filed.

However, the Board cannot share the applicant's view that a divisional application may be filed at the latest **on** the date of the publication of the mention of the grant of the parent application.

According to Decision J 7/96 (see in particular point 10) the Examining Division's decision to grant a European patent (Article 97(2) EPC) does not take effect on the date on which the decision-making process following written proceedings before that division is completed, but on the date on which the European Patent Bulletin mentions the grant (Article 97(4) EPC).

This means that in the interim period, i.e. between the decision to grant the patent and the publication of the mention of the grant, the application is deemed to be still pending before the EPO (see in particular point 6.4 of the Decision). Once the grant of the patent has been mentioned, the earlier procedure is terminated (see point 18 of J 10/01) and the application is no longer pending. Consequently it is inaccurate to argue that the term "pending" is ambiguous or does not precisely indicate the date from which the application ceases to be pending.

The date after which the applicant is no longer allowed to file a divisional application is that on which the European Patent Bulletin mentions the grant of the earlier patent.

There is a logical reason why the applicant cannot file a divisional application. With the mention of the grant of the earlier patent, the applicant and the EPO no longer exercise any influence over the patent, which becomes autonomous and has to be treated as though it had been conferred by a national authority in accordance with Article 64(1) EPC.

On the date of the publication of the mention of the grant of the earlier application the patent is deemed to be outside the EPO's jurisdiction, and a divisional application could not be filed on the same date because the application is definitively removed from the EPO's sphere.

4. European patent application 03 004 171.9 filed on February 26, 2003 as a divisional application on the same day as the mention of the grant of parent application 96 918 671.7 was published in European Patent Bulletin 03/09 of February 26, 2003 is therefore inadmissible.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

J.-C. Saisset