

Decision of the Legal Board of Appeal dated 4 May 2005

J 18/04 - 3.1.01

(Language of the proceedings)

Composition of the board:

Chairman: J. Saisset
Members: T. Bokor
S. U. Hoffmann

Applicant: MICROSOFT CORPORATION

Headword: Concept of time limit/MICROSOFT

Article: 122, 125, 76(3), 76(1), 90(2) EPC

Rule: 83, 25(1) EPC

Keyword: "Re-establishment of rights for filing a divisional application - (no)" - "Concept of time limit"

Headnote:

I. Rule 25(1) EPC imposes a substantive requirement which must be fulfilled when a divisional application is filed. A Board has no power to excuse an applicant from complying with this substantive requirement.

II. Time limits in the EPC have two conceptual elements: 1, a period of time determined in years, months or days, and 2, a relevant date, which serves as the starting date of the time limit, and from which the period of time is counted. Time restrictions imposed on applicants by the EPC, but not having these conceptual elements cannot be regarded as time limits for the purposes of Article 122 EPC.

III. No substantive rights are established in a divisional application before the actual filing date of the divisional application. Substantive rights which were lost in the parent application cannot be re-established in the divisional application by applying Article 122 EPC.

Summary of facts and submissions

I. This is an appeal from the decision of the Receiving Section, posted 17 May 2004, whereby the request of the Applicant for re-establishment of rights in accordance with Article 122 was refused, with the result that European patent application No. 03 014 103.0 was not treated as a divisional application.

II. The notice of appeal was filed on 27 July 2004, and the appeal fee was paid on the same day. Grounds of appeal were filed on 27 September 2004.

III. The earlier European patent application 00 950 901.9 [the parent application] was filed on 31 July 2000. In the course of the grant procedure, the applicant was informed on 13 March 2003 that the grant would be published in the European Patent Bulletin on 23 April 2003.

IV. European patent application 03 014 103.0 was filed on 23 June 2003, purportedly as a divisional application to the above-mentioned parent application 00 950 901.9. Together with the filing of the divisional application, the applicant also filed a request pursuant to Article 122 EPC. However, the request appeared to have been filed in the parent application 00 950 901.9, since this application number was indicated in the heading of the request. Therefore, the request was filed with the parent application by the Receiving Section, rather than with the divisional application.

V. On 14 August 2003 the EPO issued a communication "Noting of loss of rights pursuant to Rule 69(1) EPC" (EPO Form 1044) informing the applicant that the application could not be treated as a divisional application

because by the time it had been filed, the European Patent Bulletin had already mentioned the grant of a patent in respect of the earlier European patent application 00 950 901.9.

VI. By letter of 26 August 2003 the appellant requested a decision, in accordance with Rule 69(2) EPC, referring in the request to its earlier request for re-establishment of rights, which was filed on 23 June 2003, together with the purported divisional application (see paragraph IV). Thereafter the Receiving Section issued the decision under appeal.

VII. The decision refers to the fact that the Receiving Section issued the communication pursuant to Rule 69(1) EPC without taking note of the request for re-establishment of rights, because at the time of issuing the communication it was not part of the file of the divisional application. Apart from this note, the Receiving Section did not refer to any formal problem relating to the request for re-establishment of rights (see points 33 and 34 of the Reasons). Instead, in its decision, the Receiving Section refused the request on substantive issues.

VIII. In substance, the Receiving Section held that the provisions of Article 122 EPC cannot be applied to Article 76(3) EPC. The Receiving Section also referred to earlier decisions of the Boards of Appeal, which held that the time restriction for filing a divisional application in the sense of Rule 25(1) EPC is not a time limit within the meaning of Article 122(1) EPC. The Receiving Section stated that since there is no time limit set by the EPC for the filing of a divisional application, no time limit can be missed. As the EPC does not oblige the applicant to file a divisional application, there is no act which can be omitted, and which then needs to be completed, and therefore no rights linked to the observation of a time limit can be lost.

IX. As a main request in the appeal, the appellant requested that the decision refusing the request for re-establishment of rights and the Notification pursuant to Rule 69(1) EPC be set aside, that the re-establishment of rights be allowed, and that the filing date of the parent application be accorded to the divisional application. As an auxiliary request, it was requested that the issue be referred to the Enlarged Board of Appeal. Oral proceedings were requested should the Board intend not to grant any of the main or auxiliary requests in written proceedings.

X. The appellant essentially argued as follows: All key elements of Article 122 EPC are present in the case in suit, namely,

1. Failure to observe a time limit vis-à-vis the EPO.
2. Loss of rights by the applicant.
3. Inability to observe the time limit in spite of all due care.

XI. Concerning the meaning of "time limit" in the sense of Article 122 EPC, the appellant referred to decisions J 10/01 and J 24/03, which both held that the deadline for filing a divisional application was not a time limit for which re-establishment of rights is possible under Article 122 EPC. The appellant requested the Board to overrule this finding, and drew support from the decision G 5/83 of the Enlarged Board of Appeal, which stated that the EPC has to be interpreted in accordance with the rules of interpretation developed in public international law, in particular according to the principles laid down in the Vienna Convention on the Law of Treaties, Articles 31 and 32.

XII. According to the appellant, the terms of Article 122 are to be interpreted in good faith in accordance with the ordinary meaning to be given to those terms, in light of the object and purpose of the EPC, while recourse may be made to supplementary means of interpretation.

XIII. The appellant argued that even though the term "time limit" must be considered as a period of time having duration (as stated, *inter alia*, in J 3/83), or as a period of time with a finite - i.e. determinable - start and finish (as stated in the commentary of Singer, The European Patent Convention, Sweet and Maxwell, London 1995), it is not stated anywhere, either in the relevant literature, the jurisprudence of the contracting states, or the EPC itself, that the end of the period of time must be determinable at the start of the period of time in order for the period of time to be a time limit in the sense of Article 122 EPC. Otherwise, as in the case at issue, the relevant period of time is completely determinable on the basis of the procedural events of the parent application, its start being the filing date, and its end being the date for publishing the mention of the grant.

XIV. The appellant also argued that for an applicant, the actions which need to be taken to observe the deadline for the filing of a divisional application are identical to the actions that are normally taken to observe other time

limits under the EPC. Accordingly, the deadline for filing a divisional application is a time limit in the ordinary meaning of the term; hence it is also a time limit for the purposes of Article 122 EPC.

XV. The appellant further argued that the purpose of Article 122 EPC is to mitigate hardships resulting from a formal application of rules that provide for an irrevocable loss of rights in the case of a failure of the applicant or proprietor to perform timeously an act *vis-à-vis* the EPO, and the EPC implicitly contemplates the general application of Article 122 EPC, except for those cases which are explicitly excluded from re-establishment of rights by Article 122(5) EPC.

XVI. The appellant explained why a refusal of the request for re-establishment of rights entailed loss of rights for the applicant, and the circumstances under which the time limit was missed in the present case.

XVII. In support of the auxiliary request, the appellant stressed the importance of the point of law at issue, and asserted a contradiction between the current jurisprudence of the Legal Board of Appeal and the principles of interpretation established by the jurisprudence of the Enlarged Board of Appeal, as expounded in G 5/83.

XVIII. Following a communication from the Board, Oral Proceedings were held on 4 May 2005. In a written response to the communication and during Oral Proceedings, the appellant sought to refute the arguments of the Board (see Reasons below), maintained its previous arguments, and advanced new ones.

XIX. The appellant cited German procedural law, which the appellant said should be taken into consideration pursuant to Article 125 EPC. It was pointed out that the conditions for the branching off a utility model from a patent application are very similar to the filing of a divisional application. According to Section 5 of the German Utility Model Act, such a branching off may take place up until the expiry of two months after the end of the month in which the patent application is settled or possible opposition proceedings are completed. The appellant argued that this provision establishes a time limit which is subject to re-establishment of rights, at least according to the relevant jurisprudence of the German Federal Patent Court. Since the whole concept of re-establishment of rights in the EPC was modelled on German regulations, the German example should carry special weight when applying Article 125 EPC in conjunction with Article 122 EPC.

XX. The appellant further pointed to the time limit defined by Rule 38(5) EPC, which the appellant asserted is a time limit that cannot be determined in advance, since the relevant procedural act, namely the filing of a translation of a priority document, may be validly performed even before the occurrence of the events referred to in Rule 38(5) EPC. Therefore, the appellant contends that the starting date for the time limit defined by Rule 38(5) EPC is the date from which the applicant may validly perform the relevant procedural act, for example in the case of the filing of a translation, the date of filing of the patent application.

XXI. At the Oral Proceedings, the appellant requested as an Auxiliary request that the following questions be referred to the Enlarged Board of Appeal:

1. Does the term "pending earlier patent application" as used in Rule 25(1) EPC define a time limit in accordance with the interpretation of the EPC under the Vienna Convention on the law of treaties?
2. If the answer to question 1 is yes, is this "time limit" set under Rule 25(1) EPC, one with respect of which the applicant of a European patent application may have his rights re-established under Article 122(1) EPC?

Reasons for the decision

1. The appeal is admissible.

Main request

2. The point of law, upon which the case hinges, is primarily the interpretation of the term "time limit" in the wording of Article 122 EPC. This is also clear from the submissions of the appellant. However, the interpretation of the term "time limit" is not limited to a consideration of its wording in isolation or its legal effects to the appellant. The interpretation must be made in the context of the further requirements of Article 122 EPC, such as "to perform the omitted act" (see below paragraph 10) or "the loss of rights as a direct consequence" (see below paragraphs 12, 13 and 39) and the structure and purpose of the EPC in general.

3. Though there exist several previous decisions of the Boards of Appeal concerning largely the same point of law (see J 3/83, J 11/91 [OJ EPO 1994, 028], J 16/91 [OJ EPO 1994, 028], J 21/96, J 10/01, J 24/03 [OJ EPO 2004, 544]), their findings are not applicable directly. From a formal point of view, most of the previous decisions are not precisely in point, because the wording of Rule 25 EPC was then different. Only decision J 24/03 concerns a case where the legal framework was the same as in the present case, in that, at the date of the filing of the divisional application in question, the wording of the definition of the decisive deadline in Rule 25(1) EPC was the same as that presently in force. This provision defines the deadline in an implicit manner, simply by stating that a divisional application may be filed while the parent application is still pending.

4. However, the key finding of the previous decisions, namely that Rule 25(1) EPC does not define a time limit for the purposes of Article 122 EPC, remains fully applicable. What is more, even in those cases the appellants argued that the final deadline for filing a divisional application should be the date of the publication of the mention of the grant.

5. On the other hand, decision J 3/83 - which has been relied on in later decisions - does not provide any explanation for its finding, namely that time limits for the purposes of Article 122 EPC mean periods of time having duration. A more detailed analysis of the term "time limit" for the purposes of interpreting Rule 25(1) in conjunction with Articles 76 and 122 EPC is found in decision J 21/96, where it is explained that Rule 25(1) EPC does not lay down a time limit within the meaning of Article 122(1) EPC. It merely identifies a point in the grant procedure after which a divisional application may no longer be filed. This point is decided upon by the applicant when he gives his approval pursuant to Rule 51(4) EPC. Therefore, in the absence of a time limit to be observed, re-establishment of right is not possible.

6. The starting point for the discussion on whether or not Article 122 EPC applies in the present case must be the wording of Rule 25(1) EPC:

"The applicant may file a divisional application relating to any pending earlier European patent application".

7. The Board holds that the term "*pending ... patent application*" does not establish a time limit, but rather a **substantive** requirement which has to be fulfilled at the point **when** a divisional application is filed. The fact that this substantive requirement can only be fulfilled within a certain time frame - and for this reason an applicant needs to proceed as if it was dealing with a proper procedural time limit - does not create a time limit under Rule 25(1) EPC which has to be met by the applicant (see also J 24/03).

8. It follows from the structure of the Convention that the Implementing Regulations are not to contain substantive requirements - i.e. provisions which directly influence the **scope** of the material rights acquired by a granted patent - but merely procedural ones. However, it is unavoidable that procedural requirements touch upon substantive rights, and therefore a clear separation between these concepts is difficult, if indeed possible at all. The Board holds that Rule 25(1) is a procedural provision, because it concerns the "procedure to be followed" pursuant to Article 76(3) EPC, and the Administrative Council is competent to rule on this issue by virtue of the same Article, in conjunction with Article 33(1) EPC, subparagraph (b). However, the Board holds that although Rule 25(1) EPC is a procedural provision, it is one with a significant substantive content. This substantive content resides not in the fact that a procedural time restriction **is** defined, but rather in **how** this has been implemented, i.e. why exactly that particular point in time was chosen by the legislator as the decisive date, rather than some other date.

9. Where a question arises whether some apparently procedural provision of the EPC that determines a time restriction for performing a procedural act - either by defining a time limit (see paragraphs 14 to 30 below) or in some other manner - is at the same time a substantive requirement, the following question may usefully be posed: would substantive rights of the applicant or substantive interests of third persons be significantly affected if the "measure", and thereby the actual expiration date of the time restriction in question, were to be changed by the legislator, even if only by the minimum possible amount, such as a few days? If the answer to this question is no, then the provision will merely be a procedural one, and the time restriction will most probably have been a compromise between the need for a speedy procedure and the objective necessity of leaving the applicant sufficient time to perform the relevant procedural act. In other words, the actual expiration date, as a point in time, will have been chosen more or less arbitrarily, and no particular reason can be found why that particular date was chosen as the expiration date. In such a case the measure of the time restriction in question does not involve considerations of substantive rights. If, however, the answer to the above question is yes, then the procedural provision will also be a substantive one, where the substantive content resides in the **choice** of the starting and/or finishing date, i.e. in the way the time restriction at issue has been defined. Applying this test to the present case, the Board holds that a pendency of a patent application is not only a procedural requirement, but to a large degree also a substantive requirement. Its choice reflects considerations which take into account legal effects on material rights of the applicant and material interests of third persons. Whether a patent application is pending or

not has a **direct material effect** on the legal interests of third persons. If the patent application ceases to be pending because the patent has been granted, the EPO no longer has the power to decide on issues relating to these material effects. This means that the legal situation which arises after grant is independent from the EPO (and from the applicant as well). Upon grant, the protected and abandoned subject-matter of the patent application become *res judicata*, and the scope of the granted patent is determined. Claiming abandoned subject-matter clearly violates the interests of the public, in exactly the same manner as if the applicant were to claim subject-matter belonging to the prior art. It is also arguable that filing a divisional application after grant is **conceptually** impossible, because if the parent application no longer exists there is nothing to divide. In other words, these considerations clearly show that even a minor extension of the time restriction by the legislator - e.g. allowing the filing of a divisional application within one or two months, or only days, after grant - would create a completely different legal situation for third parties as well as the applicant. This shows that the material legal content in the current wording of Rule 25(1) EPC goes far beyond defining "only" a point in time. The choice of this point in time is anything but arbitrary, and it cannot be deferred any further without seriously affecting legitimate interests of third persons. Therefore, it is clear that the requirement that the parent application be pending is not only a procedural requirement but also a substantive one. This is in distinct contrast to purely procedural time restrictions - such as the obligation to observe a time limit for responding to a communication of the EPO, or for paying a fee - where the actual deadline is merely the result of an approximate balancing act between conflicting interests, and where the material interests of third persons are otherwise not truly affected by the actual outcome of this balancing act. Thus the length of the time that is given to the applicant to file his response, or the time to pay a particular fee, does not affect the legal status of the subject-matter which may be validly claimed. In other words, the expiration date of a mere procedural time limit is really nothing else than a point in time, and the scope of the material rights or interests are not affected by the specific choice of this point. The same holds for all procedural time limits where a re-establishment of rights pursuant to Article 122 EPC is applicable according to the established jurisprudence of the Boards of Appeal.

10. Therefore, even if the Board were to proceed on the assumption that besides setting a condition, Rule 25(1) EPC also defines a time limit for the purposes of Article 122 EPC, the Board would be unable to allow the requested re-establishment of rights, lacking the power to do so. Article 122 EPC only empowers the competent Division of the EPO (or a Board of Appeal) to allow a procedural act to be performed after the expiration of a time limit assigned to that specific procedural act. But neither a Division nor a Board has the discretionary power to excuse an applicant from complying with a substantive requirement. In other words, a re-establishment of rights according to Article 122 EPC is not allowable because it is simply no longer possible to correctly perform the omitted act (see Article 122(2), second sentence). In the present case, it is no longer possible to file the divisional application during the pendency of the parent application.

11. The above explains why the wording of Rule 25(1) EPC defines a condition, and not a time limit, as stated in J 24/03. However, it may still be argued that meeting a time limit is nothing other than a fulfilment of a condition, the condition being that a procedural act is performed before a certain date. Therefore, it is incumbent on the Board to examine the difference between a time limit proper and other possible conditions prescribed by the EPC, and to find the legal basis of this difference in the wording of the EPC itself, if the concept of "time limit" has to be clarified for the purposes of interpreting Article 122 EPC.

12. The Board holds that the wording "...**direct** consequence, by virtue of this Convention..." in Article 122 EPC means that the non-observed time limit must have been a time limit which was explicitly and specifically provided by the Convention for the performance of the procedural act in question. Otherwise, the omission of the procedural act, i.e. the non-observance of the time limit, will only result in the loss of rights in an indirect manner. This is exactly the case here. The direct cause of the loss of rights - i.e. the loss of the possibility to claim the filing dates of the parent application, see paragraph 39 below - was the fact that the parent application had ceased to be pending. It is to be noted that the event causing this legal effect, namely the publication of the grant, occurred independently from, and its legal consequences took effect irrespective of, whether the applicant did or did not perform the procedural act in question, i.e. did or did not file a divisional application.

13. In other words, the non-observance of a time limit will only cause a loss of rights **directly** if there are **only two** events which are legally relevant for determining if a procedural act was performed correctly, i.e. whether there was a time limit missed: 1, the **passing of time** - i.e. the expiration of a time limit as an objective event occurring independently of the actions of the applicant - and 2, the applicant **taking or not taking** appropriate action before the time limit has expired. As a further precondition, a provision of the EPC must exist which determines the rights which are lost as a result of this passing of time. However, as soon as the passing of time will be legally relevant **not** because of a direct provision in the EPC, but because **some other independent legally relevant** event occurs, the validity of the actions of the applicant are subject to a condition, and not to a time limit. In this regard, an event is independent and legally relevant if the occurrence of this event is not dependent on the taking or not taking of action by the applicant (i.e. the performance of the specific act that is prescribed in order to meet the time limit) and further, the occurrence of this other event will influence the correct performance of the specific procedural act. Contrary to time limits proper, in this case the passing of time is **only** legally relevant **because of** the occurrence of this **other independent and legally relevant event** - here, the publication of the grant. In other

words, in the case of a genuine time limit nothing else prevents the valid performance of the procedural act in question, except the expiration of the legally defined time limit itself. The relevant procedural act may indeed be performed later, precisely because **no other legal condition** changes as the time passes - more precisely, any changes of the legal conditions are only those that themselves were caused by the non-observance of the time limit. This follows from the provisions of Article 122(2) EPC, second sentence: the omitted act must be completed within the time limit for requesting re-establishment of rights. This provision of the EPC presupposes that the completion of the omitted act **is** still possible. Is this not the case, because a change of conditions does not permit the completion of the omitted act, the loss of rights was not a "direct consequence" of the non-observance of the time limit, but rather the changed conditions directly caused the loss of rights.

14. Further and quite different considerations also support the finding of the Board that the time restriction caused by Rule 25(1) EPC is not a time limit within the meaning of the EPC. The Board agrees with the appellant that, in fact, the period of time for filing a divisional application is a factual "time limit" for the applicant, i.e. a time limit in the ordinary sense of the word, because indeed the same measures have to be taken as with other time limits set by the EPC or the EPO. However, it does not follow from the fact that the time restriction imposed by the publication of the grant of the parent application is in practice treated similarly as other procedural time limits that it also has the same legal character.

15. It is noted that the Vienna Convention puts equal weight on the "ordinary meaning of the terms" in a treaty and on the "object and purpose" of the treaty. The object and the purpose of the EPC is to create a material and procedural legal framework for granting patents. Hence, it is clear that the term "time limit" in the EPC is not any time limit in general, but a time limit as a concept of procedural law. See also J 24/03, point 3 of the Reasons.

16. It is also true that the period of time available to the applicant by virtue of Rule 25(1) EPC is a time period having a finite duration, or at least it becomes definite when the publication of the mention of the grant has indeed taken place.

17. However, the Board does not agree with the appellant that this period of time does not have to be defined from the outset to qualify as a "time limit" for the purposes of Article 122 EPC. Certainly, careful examination is needed to determine the "starting date" of a time limit. The appellant's submissions that the term "time limit" should be seen in light of the definition given by German scholars when commenting on German procedural or civil law is not convincing. Article 125 EPC is to be applied "in the absence of procedural provisions", i.e. when the Convention itself does not provide sufficient guidance. However, this is not the case here, as will be explained below. The Board holds that the EPC itself provides sufficient guidance for the correct interpretation of the term "time limit" as used in Article 122(1) EPC - or in the Convention in general, for that matter.

18. Article 120 EPC explicitly concerns time limits ("Frist", "délai") as used in the EPC. Article 120 EPC provides that "The Implementing Regulations shall specify:

(a) the manner of **computation** ["**Berechnung**", "**calcul**"] of time limits and the conditions under which such time limits may be extended,...;

(b) The **minima** and **maxima** for time limits to be determined by the European Patent Office."

19. The wording of Article 120 implies that time limits for the purposes of the EPC in general should be definable from the start. Otherwise, it would be hardly possible to determine their minima and maxima. It is true that on a strict analysis, this wording still leaves open the theoretical possibility that time limits imposed by the EPC itself - i.e. not by the EPO - need not have any minima or maxima. However, the wording of paragraph (a) should be valid for all time limits of the EPC, i.e. the time limits should be susceptible to **computation**, which is only possible in practice if ends of time limits are defined relative to their start dates. This view is fully reflected in the provisions of Rule 13(5) EPC (interruption of time limits by suspension of proceedings) and Rule 85 EPC (extension of time limits).

20. This is supported by an analysis of the implementing rule to Article 120 EPC, namely Rule 83:

"Calculation of time limits

(1) Periods shall be **laid down** ["**berechnet**", "**fixés**"] in terms of full years, months, weeks or days.

(2) Computation shall start on the day following the day on which **the relevant event** occurred, the event being either a procedural step or the expiry of another period..."

21. As a preliminary remark, it must be noted that the English text of Rule 83, somewhat confusingly, uses the term "period" instead of "time limit", although the German and French texts leave no doubt that, for the purposes of Rule 83, the term "period" should be understood as a "time limit". This is also the English text of the title of Rule 83, and the term "period" is the only logical substitute for the term "time limit" throughout the wording of the rule. This interpretation is also supported by the fact that the German and French versions consistently use the terms "Frist" and "délai", both in the title and in the text of Rule 83 EPC.

22. As regards the scope of Rule 83, it is noted that this Rule was laid down by the Diplomatic Conference establishing the Convention. There is no indication in the EPC that it should be restricted to time limits imposed by the EPO. Since the EPC empowers the Administrative Council to define time limits for the EPC in general (Article 33(1)(a)), it appears that Rule 83 validly lays down general rules which should be applicable to any time limits which are to be considered as such for the purposes of the EPC. Therefore, unless there are strong indications to the contrary, it must be assumed that the Administrative Council sought to amend Rule 25(1) EPC in conformity with Rule 83 EPC, it being presumed that the Administrative Council would not wish to make Rules which were internally inconsistent.

23. From the above it follows that if the time restriction for filing a divisional application had originally been intended to be a time limit for the purposes of the EPC in the sense of Article 120 EPC - and by implication, also for the purposes of Article 122 EPC - it would have to be **defined** either in the EPC or in the Implementing Regulations in terms of years, months and days. Otherwise, the wording of Rule 25 EPC presently in force would be at odds with Rule 83(1) EPC, because the "time limit" defined by Rule 25 is **not** expressed in years, months or days. In other words, the time limits of the EPC are indeed intended to have a predetermined start and end, the end being calculable in a foreseeable manner by the applicant **immediately when the starting date - dies a quo - is known.**

24. Rule 83(2) EPC further makes it clear that a time limit, as a legal concept of the EPC procedural system, also requires another element, namely the definition of a **relevant event**, from which the time limit in question is calculated. Again, the reader of the EPC must turn to the German and French text for the clear meaning of the term "relevant event": it is the event which triggers the start of the time limit, i.e. the well-known concept of the "*dies a quo*". The key to a time limit is the date on which the event occurred, which serves as the starting point of the time limit [**"an dem das Ereignis eingetreten ist, aufgrund dessen der Fristbeginn festgelegt wird", "où a eu lieu l'événement par référence auquel son point de départ est fixé"**].

25. In light of the above, the commentary of Singer, cited by the appellant, does not contradict the interpretation of the term "time limit" by the Board. A time limit in the sense of the EPC is indeed a period of time having a finite (i.e. determinable - see appellant's arguments in paragraph XIII above) start and finish. Its start is determined by the "relevant event", and its finish is determined by the duration of time specified in the legal provision establishing the time limit.

26. This interpretation of the term "time limit" is also wholly in line with the provisions of the European Convention on the Calculation of Time-Limits (Basle Convention of 16 May 1972, in force since 28 April 1983): see especially Articles 2,3 and 4. The Board notes that several Member States of the EPC are also signatories to the Basle Convention, which, therefore, also may be taken into account pursuant to Article 125 EPC when the meaning of the term "time limit" is to be determined, as is the case here. It is noteworthy that the Explanatory Report to the Basle Convention explains that the wording "time limit" was chosen as the English term for the French term "délai". The Explanatory Report also lists several - not exhaustive - examples for periods of time which were **not** considered as "time limits" by the committee of experts preparing the Basle Convention, though none of these examples is directly comparable to the condition that a patent application is pending.

27. Therefore, when looking at Rule 83 EPC in detail, it becomes clear that any provision of the EPC which intends to define a time limit for the purposes of Article 120 EPC, - and hence for the purposes of Article 122 EPC - must contain expressly (or by direct reference) these two conceptual elements: 1, a duration of time expressed in years, months or days, and 2, an event, the date of which serves as the starting point of the calculation. Clearly, neither of these notional elements of a time limit is found in Rule 25(1) EPC.

28. The appellant argued that Rule 83(1) EPC merely specifies that no time limits are to be comprised of subdivisions of a day, such as hours and minutes. This is not accepted by the Board. Indeed, it is a corollary of Rule 83 that no such subdivisions may be used. However, Rule 83 still states that time limits **must be defined** in terms of years, months and days, and not just that they **may** be (retrospectively) calculable in that manner.

29. Clearly, it would be a quite absurd interpretation of Rule 83 - contrary to Article 32, paragraph a, of the Vienna Convention, and thus contradicting even the appellant's position - to state that the purpose of Rule 83 is to ensure that the duration of time limits as provided by the EPC or set by the EPO should be determinable **retrospectively** by units of years, months and days. Instead, the purpose of Rule 83 is to ensure an equitable procedure for applicants, providing clear and foreseeable ends for time limits, which may be calculated from their beginning for the normal course of proceedings. This holds good even if the actual expiration of a time limit may change in exceptional circumstances, such as the suspension of proceedings. Indeed, all other time limits in the EPC that are considered as time limits subject to re-establishment of rights are defined in the EPC in the manner as provided in Rule 83 EPC. This is also the case for time limits which are defined only by reference to other time limits, since the time limits referred to themselves conform to Rule 83 EPC, see e.g. the time limit of Rule 38(5).

30. The appellant's argument that the EPC contains several time limits, the duration of which is not determinable in advance, is not convincing. The definition of a time limit which may be deduced from Rule 83 EPC does not imply that the procedural act for which a time limit has been set cannot be performed before the actual start of the time limit. A time limit assigned to a procedural act is not necessarily equal to the period of time during which the procedural act may be validly performed. In many cases, the EPC allows applicants to perform acts even before a time limit starts to run. However, this only means that the start of the time limit - the date of the "relevant event" of Rule 83(2) EPC - will be **different** from the date from which the performing of the procedural act is **possible**. The start of the time limit - *dies a quo* - will still be the date of the relevant event ("fristauslösendes Ereignis") which is defined as such in the legal provision determining the specific time limit in question. Therefore, a time limit set for a procedural act - more properly, its **expiry date** - may indeed be indeterminable at a time when it is already possible to validly perform the act, but it will be determinable immediately when the date of its genuine triggering event - i.e. the date of the "relevant event" of Rule 83(2) EPC - becomes known. Again, it is stressed that the triggering event of a time limit is **not** necessarily the same triggering event as that which opens up the possibility of performing a procedural act. This distinction is made clear in the EPC itself, see e.g. Article 86(2) EPC in conjunction with Rule 37(1) EPC, last sentence. This is also acknowledged by the case law dealing with the time limit for filing a notice of appeal, see T 389/86 (OJ EPO 1988, 087) and T 427/99. This means that the time limit defined by Rule 38(5) does not start with the filing date of the application, contrary to the appellant's argument. The fact that the relevant procedural act (filing of the translation) may be performed at an even earlier date does not affect the duration of the time limit itself, which remains one with a fixed duration, as defined by Rule 38(5) EPC. The fact that Rule 38(5) EPC only refers to other time limits does not prevent it from defining a time limit in conformity with Rule 83 EPC, because both the relevant events and the durations of the time limits are precisely specified by means of the reference. Therefore, this time limit is indeed subject to re-establishment of rights pursuant to Article 122 EPC.

31. The above interpretation also fully conforms to the interpretation of time limits for the purposes of Article 122 EPC, as stated in decisions J 10/01 and J 24/03. The Board sees no reason to deviate from the findings of these decisions, cited by the appellant. Decision J 24/03 explains very clearly the legal character of the provisions of Rule 25, namely that Rule 25 merely sets a condition, and not a time limit.

32. The appellant's arguments based on the analogy between a divisional application and a utility model which has been derived from an earlier patent cannot be accepted. A divisional application under the EPC is not comparable with the German example of branching off a utility model. In the latter case, there is clearly no requirement that the parent patent application be pending. On the contrary, the typical situation for a branching off is where the parent application has been finally refused. Furthermore, the question whether this time limit is indeed subject to reinstatement under German law remains open, or at least the Board is not aware of any relevant German decision to that end. Even if it were the case, there would still be a major difference between the two procedures. The applicable German legal provisions - as cited by the appellant - appear to define a genuine time limit, with a relevant event (the last day of the month in which the patent application is settled) and a determined duration of time (two months).

33. Although the request of the appellant can be decided purely by examining the existence of the time limit, as explained above, it is also questionable whether the appellant's alleged loss of rights can properly be regarded as a loss of right for the purposes of Article 122 EPC. In the present case, the appellant argued that the rights lost were the right to obtain full protection for an invention that was disclosed and its corresponding right of priority (cf. point 1.2 in the grounds of the appeal). However, the appellant did not make it clear whether the loss of rights occurred in the parent or in the divisional application. The Board considers that the right to obtain full protection for a disclosed invention is probably a right within the parent application. *Prima facie*, the appellant filed its request for re-instatement of rights in the procedure of the parent application, while its appeal was filed in the procedure of the divisional application - the latter necessarily so, because he wished to appeal a decision of the EPO which was issued in the procedure of the divisional application. On the other hand, the appellant referred to its request for re-instatement in the procedure of the divisional application as well, and the Receiving Section also considered this request on its merits, thereby implicitly considering it as if the request had indeed been filed in the purported divisional application instead of the parent application. It appears that the Receiving Section did not

consider the procedural problem of whether such a request is **formally** admissible at all in a procedure different from the one in which it was filed.

34. From a purely procedural point of view, the act of filing a divisional application is a procedural step which is performed in the procedure of the divisional application - it is the step which commences that procedure. This may support the suggestion that formally the request for re-establishment of rights was correctly considered in the procedure of the divisional application. It is also clear that the procedure of a parent application and its divisional application are in fact linked, even if they are formally and procedurally different. The Board has been conscious of the formal contradictions outlined above, but has found it more appropriate to decide on the appellant's request with reasoning based on the substantive issues rather than pure formalities. The Board has therefore chosen not to go into these formal issues in depth, and has accepted - with a certain degree of doubt - that it was proper to consider the appellant's request for re-establishment of rights in the procedure of the divisional application. Instead, the Board has found it more appropriate to examine briefly the other possibility as well: see paragraph 40 below. As a result, the case has been exhaustively examined and decided on, rather than possibly being rejected on purely formal grounds. Nevertheless, the Board finds it expedient to clarify which rights may have been lost in which procedure.

35. The appellant argued that even the Communication of the EPO dated 14 August 2003 recognised that a loss of rights had taken place. This, by itself, is not disputed by the Board. However, no convincing arguments were put forward explaining why the rights which were lost could be reinstated according to Article 122 EPC.

36. The appellant contended that the right which was lost was the patent protection for subject-matter disclosed in the parent application (and which was to be continued in the divisional application). In the appellant's submission, the divisional application helps the applicant to exercise his - already existing - right to patent protection. Therefore, the filing of a divisional application is fundamentally different from the filing of a normal European patent application, because already-existing rights are continued.

37. The Board sees the situation differently. A divisional application - when treated as such - is deemed to have been filed on the filing date (and enjoys the priority, if applicable) of the earlier application. Otherwise, the two applications are procedurally independent, and the substantive rights claimed in them also exist independently from each other. This independence is affected neither by the limitation of scope defined by Article 76(1) EPC, second sentence, nor by the fact that the existence of the substantive rights in the divisional application presupposes the establishment of these substantive rights in the parent application. However, as regards the filed subject-matter of the earlier application (description, claims, drawings) which will finally determine the scope of the protection, it does not automatically become the subject-matter of the divisional application, even if it is precisely the same material right which is sought to be protected by the divisional application. Article 76(1) only specifies that the subject-matter of the divisional application may not extend **beyond the content** of the earlier application as filed. Within this limitation, it is not some provision of the EPC, but the applicant himself who determines the content of the divisional application. From this it follows that, from a procedural point of view, the **subject-matter of the divisional application** - i.e. the material right to be protected - is established only on the **actual filing date** of the divisional application, when the applicant - by filing a new application, including description, claims and drawings - **positively defines** the subject-matter of the divisional application (if only temporarily, given that the final subject matter will be decided on grant). It is true that the applicant may decide to re-file the contents of the earlier application without the slightest change, but from a legal point of view it is still only on **the actual filing date** of the divisional application that its subject-matter "materialises", and is established. Until then, the subject-matter of the divisional application is pure speculation, and not an existing substantive right on its own, even if, after filing, the filing date of the parent application will **retroactively** be accorded to the divisional application pursuant to Article 76(1) EPC. This is also in line with the fact that a divisional application is procedurally independent from the parent application: see e.g. T 1177/00.

38. Hence, the rights which may be potentially lost if the divisional application is not filed while the earlier application is pending - namely, the subject-matter of the divisional application - has not been **established** before the divisional application is actually filed, simply because there is no existing divisional application. Therefore, these not-existing rights cannot be lost. From this it follows that from a procedural point of view it is not possible to request re-establishment of rights in the procedure of the divisional application.

39. The communication issued by the Receiving Section did not relate to those substantive rights asserted by the appellant and outlined above. In the present case the notification of the loss of rights was justified by the application of Article 90(2) EPC, last sentence, last clause. Article 76(1) EPC, last sentence, provides that a divisional application is "deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority". If this filing date could not be accorded, it is the standard assumption that another application having a later filing date would not be of interest to the applicant, because the parent application would otherwise form part of the state of the art in relation to the later-filed, divisional application. Therefore, only the filing date and priority date (if any) of the earlier application are relevant. If those dates are

denied, then according to the practice of the EPO no other application with a filing date later than that of the parent application ever comes into existence. The application is treated as if it were not filed at all so that, as a matter of routine, filing fees are refunded. This situation is comparable to the case dealt with in Article 90(2) EPC, so that an analogous application of that provision is justified (cf. J 11/91, reasons point 4.2). Therefore, an immediate communication from the Receiving Section pursuant to Article 90(2) EPC, stating that the application is not being dealt with as a European divisional application, was justified. Thus the right lost in the procedure of the divisional application was the (substantive) right of the earlier filing date.

40. If the Board were to accept that the rights lost were indeed those established in the parent application, then a re-establishment of those rights would only be possible in the parent application. It would then need to be determined if a request for reinstatement of rights by the appellant could possibly have succeeded if it were to have been considered on its merits in the procedure of the parent application, see paragraph 32 above. As an obiter dictum, the Board holds that such a request would have been *prima facie* unallowable, simply because there are no procedural steps which are available to be taken by the applicant **in the procedure of the parent application** in order to file a divisional application. Hence, there is no possible time limit which could have been missed (see also J 10/01, point 19 of the Reasons).

Auxiliary request

41. Concerning the merits of the auxiliary request, the Board agrees with the appellant that the question at issue is an important point of law. However, the conditions for a referral pursuant to Article 112(1) EPC, subparagraph (a) are not present.

42. Firstly, there are no contradictory decisions of the Boards of Appeal. In all similar cases concerning the interpretation of Rule 25(1) EPC, the decisions of the Boards of Appeal have been consistent, in that re-establishment of rights was denied when a divisional application was filed after the applicable deadline.

43. Secondly, the Board does not see that the validity of the existing case law of the Boards of Appeal can seriously be questioned. The perceived differences in interpretation of the EPC by itself do not warrant a referral to the Enlarged Board of Appeal, because even with different interpretations, the results were the same. The opinion of the Enlarged Board of Appeal cited by the appellant, G 10/92 (OJ EPC 1994,633) did not address or even consider the possibility of filing a divisional application beyond the pendency of the parent application. Its reasoning implicitly presupposes that the parent application is still pending; see e.g. paragraph 10 of the reasons, third subparagraph. Therefore, the Board sees no contradiction between the standing jurisprudence of the Legal Board and the jurisprudence of the Enlarged Board of Appeal.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.