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**Datasheet for the decision  
of 6 September 2007**

**Case Number:** J 0020/05 - 3.1.01

**Application Number:** 04027697.4

**Publication Number:** -

**IPC:** -

**Language of the proceedings:** EN

**Title of invention:**

Fertile, transgenic maize plants and methods for their  
production

**Appellant (Applicant):**

DeKalb Genetics Corporation

**Headword:**

Filing of a divisional application during suspension of  
proceedings

**Relevant legal provisions:**

EPC Art. 60, 61, 76, 80, 90  
EPC R. 13, 25

**Keyword:**

"Suspension of proceedings"  
"Filing of a divisional application (no)"

**Decisions cited:**

G 0003/92, G 0001/05, J 0038/92, J 0007/96, J 0019/96,  
J 0002/01

**Headnote:**

An applicant whose application proceedings have been suspended  
under Rule 13 EPC is not entitled to file a divisional  
application relating to that application while the proceedings  
remain suspended. Therefore such an application may not be  
dealt with as a divisional application and the Receiving  
Section must decide accordingly.



Case Number: J 0020/05 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 6 September 2007

**Appellant (Applicant):** DeKalb Genetics Corporation  
3100 Sycamore Road  
DeKalb  
IL 60115 (US)

**Representative:** Helbing, Jörg  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 27 September 2005.

**Composition of the Board:**

**Chairwoman:** B. Günzel  
**Members:** E. DufRASne  
K. Garnett

## Summary of Facts and Submissions

- I. The present appeal concerns the decision of the Receiving Section of 27 July 2005 by which the request of the applicant that the European patent application 04027697.4 be treated as a divisional application relating to the earlier European patent application 94927962.4 (hereafter the "parent application") was refused.
- II. The parent application was filed on 24 August 1994 as international patent application PCT/US94/09699 designating inter alia contracting states to the European Patent Convention (EPC) for the purpose of obtaining a European patent. The requirements for entry into the European regional phase were fulfilled on 25 March 1996. Examination under Article 94 EPC was requested.

By a communication in that application dated 24 April 1998, the Legal Division informed the applicant that the proceedings in respect of that application had been suspended as from 18 March 1998, on the basis of proceedings opened by a third party against the applicant before the Tribunal de Grande Instance of Paris for the purpose of seeking a judgement that the third party was entitled to the grant of the European patent.

These proceedings are now pending before the Cour d'Appel of Paris and the proceedings before the EPO are still suspended.

- III. The application in suit was filed on 22 November 2004 as a divisional application of the above-mentioned parent application, during suspension of the proceedings of that parent application.
- IV. By a letter headed "Noting of loss of rights pursuant to Rule 69(1) EPC" dated 14 December 2004, the Receiving Section informed the applicant that its application could not be treated as a divisional application, because the parent application proceedings were suspended. Referring to decision J 38/92, the Receiving Section pointed out that neither the EPO nor the parties could validly perform any legal acts - including the filing of a divisional application - while the parent proceedings were suspended. Furthermore, the Receiving Section considered that it was irrelevant whether or not the subject-matter of the divisional application was in issue before the French national court, because the Receiving Section had no means of verifying which party to the litigation proceedings was entitled to which subject-matter. In this connection, the Receiving Section also made the point that the divisional application might contain further subject-matter which extended beyond that alleged by the applicant not to be in dispute, and which might therefore be made the subject-matter of additional patent claims at a later stage of the divisional application proceedings. The Receiving Section had no means of verifying whether this was the case at that stage of the proceedings.
- V. By letter dated 22 February 2005, the applicant submitted that the Receiving Section was not competent to consider the question of entitlement or to issue the

above letter "Noting of loss of rights", these being matters which lay within the sole competence of the Legal Division, under Article 61 and Rule 13 EPC.

The applicant further submitted that the divisional application proceedings could not be stayed before the publication of the application.

Finally, the applicant argued that the purpose of Rule 13 EPC is to secure the legal position of the party allegedly entitled to the parent application, but that the parent application was not affected by the filing of the divisional application.

The applicant requested that the filing of its application as a divisional application be allowed or, alternatively, that a decision pursuant to Rule 69(2) EPC be issued.

VI. By a decision dated 27 July 2005, the Receiving Section rejected the applicant's request that the application in suit be treated as a divisional application.

The Receiving Section held that, in the case of the filing of a divisional application, it is responsible not only for the examination of the formal requirements pursuant to Articles 90 and 91 EPC, but also for compliance with Article 76 and Rule 25 EPC, and in particular Rule 25(1), which stipulates that the applicant has the right to file a divisional application relating to any pending earlier European patent application.

It further noted that the question of the suspension of the application in suit was not at issue, only the question of its admissibility as a divisional application.

It finally concluded that the applicant was not allowed to file a divisional application at a time when the parent application proceedings were suspended, because this would violate the basic principle that the legal status quo of an application must be maintained and no legal acts should be performed while proceedings were suspended pursuant to Rule 13 EPC.

VII. On 30 September 2005, the applicant lodged an appeal against the above decision and paid the appeal fee. A statement setting out the grounds of appeal was filed on 6 December 2005.

VIII. In its statement of grounds of appeal, the appellant argued in essence that the procedural status quo to be maintained under Rule 13(1) EPC, as interpreted in decision J 38/92, is the procedural status quo of the parent application and that acts of the filing, search and publication undertaken in respect of the divisional application do not alter the procedural status of the parent application.

The appellant further pointed out that Rule 13(1) EPC does not preclude the filing of a divisional application.

Finally, the appellant submitted that the filing of a divisional application does not deprive the third party of the possibility "to interfere" with the further

prosecution of the subject-matter of the divisional application, since the third party also has the option of "interfering" in the granting procedure of the divisional application.

- IX. By a communication dated 25 January 2007, the Board summoned the appellant to oral proceedings and set out its preliminary opinion on the merits of the appeal.

The Board first pointed out that, under Rule 25(1) EPC, no person other than the applicant pursuant to the parent application is entitled to file a divisional application.

It further noted that the question of the lawful status of the applicant pursuant to the parent application is the subject-matter of the pending entitlement proceedings, these entitlement proceedings having led to the suspension of the parent application proceedings, and that the objective of the suspension of those proceedings is to preserve the rights of the third party claimant during the entitlement proceedings.

In passing, the Board also noted that the appellant had not demonstrated the absence of any overlap between the subject-matters of the application in suit and of the pending entitlement proceedings.

The Board furthermore set out its preliminary view that, in the circumstances of the present case, where the proceedings for grant are suspended because of pending entitlement proceedings, the applicant is not

entitled to file a divisional application during such suspension.

X. By letter dated 6 August 2007, the appellant submitted that the divisional application in suit did not embrace or overlap with the subject-matter of the pending entitlement proceedings, since the independent claims of the divisional application did not relate to the subject-matter of the entitlement proceedings, i.e. glyphosate tolerant plants.

XI. Oral proceedings were held on 6 September 2007.

During these oral proceedings, the appellant argued essentially as follows:

- the relevant issue concerns neither the grant of a patent based on a divisional application nor the examination of that divisional application, but only the filing, search and publication of such a divisional application;
- the competence of the Receiving Section on filing is restricted to ensuring compliance of the application with Article 90 EPC (in particular Article 90(1)(a)) and Article 80 EPC (in particular Article 80(c)), i.e. in the present case, the requirement that an applicant be identified;
- Rule 13 EPC does not allow the suspension of proceedings for grant where, as here, the application has not been published;
- the suspension concerns only the legal status of the parent application, which is not affected by the filing of the divisional application.



In reply to a question from the Board, the appellant accepted that the description in the divisional application in suit is identical to the description in the parent application, so that the whole subject-matter of the parent application is present in the description in the application in suit.

- XII. The appellant requested that the decision under appeal be set aside and that the application be treated as a divisional application.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC. It is therefore admissible.
2. The Board agrees with the submission of the appellant that under Article 90 EPC the Receiving Section is responsible for examining whether, on filing, a European patent application satisfies the requirements of Article 80 EPC, in particular Article 80(c) EPC, i.e. whether the documents filed by the applicant contain sufficient information identifying the applicant.

However, the application in suit was filed as a divisional application and its legitimate status as a divisional application is the issue in the present case.

In addition to the above-mentioned general requirements for any European patent application, a European divisional application must also comply with the specific requirements of Article 76 and Rule 25 EPC,

and in accordance with Article 16 EPC, the examination as to whether or not the formal requirements on filing for a divisional application are fulfilled also lies within the competence of the Receiving Section.

Rule 25(1) EPC provides that the applicant may file a divisional application relating to any pending earlier European patent application.

Fundamentally, it is the entitlement acquired by virtue of the parent application that gives the right to file a divisional application. This means that the rights in respect of the divisional application derivable from the parent 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, point 2.1.3 of the Reasons, cited in J 2/01, OJ EPO 2005, 88, point 6 of the Reasons).

In the same way, it was decided in case G 1/05 of 28 June 2007 (to be published in the OJ), point 11.1 of the Reasons, that under the EPC the filing date of the root application is the only filing date which can be attributed to a divisional application, by way of the legal fiction contained in Article 76(1), second sentence, second half sentence, EPC.

The entitlement to file a divisional application according to Article 76 and Rule 25 EPC is a procedural right that derives from the applicant's status as applicant under the earlier application (J 2/01, above cited, point 5.1 of the Reasons).

Therefore, as well as examining the other formal requirements under Rule 25(1) EPC on the filing of a divisional application, e.g. the existence of a pending earlier application, the Receiving Section must also examine whether the applicant is entitled to file the divisional application, by virtue of him being the applicant in the earlier parent application.

3. In the present case, the proceedings for grant of the parent application have been suspended since 18 March 1998 by the Legal Division under Article 61 and Rule 13(1) EPC since, according to the Legal Division, a third party had provided proof to the EPO that it had opened proceedings against the applicant for the purpose of seeking a judgment that it was entitled to the grant of the European patent, and the third party had not consented to the continuation of such proceedings (see above, II).

When the application in suit was filed as a divisional application, on 22 November 2004, the national entitlement proceedings were still pending and the parent application proceedings were still suspended.

That means that when the application in suit was filed, the doubt about who was the person lawfully entitled to file the parent application subsisted. Even though, as a consequence of the legal fiction contained in Article 60(3) EPC, a European patent application may as a matter of fact be filed by a person other than the inventor or his successor in title, contrary to the legal right of the latter, as a matter of law only the inventor or his successor in title is entitled to apply

for the grant of a European patent (G 3/92, OJ EPO 1994, 607, point 2 of the Reasons).

The provisions of the Implementing Regulations on suspension have to be seen in their proper context, in particular that of Article 61(1) EPC, which governs the procedural rights of a person who has been adjudged to be entitled to the grant of a European patent, as against the actual applicant of a European patent application (G 3/92, *ibid.*, point 1).

The fundamental objective of the suspension of proceedings is to protect the rights of that person during the entitlement proceedings (J 7/96, OJ EPO 1999, 443, point 2.3 of the Reasons).

Therefore, the appellant's argument that it is not forbidden by Rule 13(1)EPC to file a divisional application during suspension of the parent application proceedings cannot succeed.

Even if the filing of a divisional application during suspension of the parent application proceedings is not expressly excluded by Rule 13 EPC, Rule 13 EPC is stated in general terms and it is consistent with its objective of protecting the third party claimant's rights that the filing of a divisional application during suspension should be prevented.

It would be inconsistent with and contrary to the fundamental objective of the provisions on suspension, on the one hand to suspend the parent application proceedings because of the national entitlement proceedings, but on the other to allow the filing of a

divisional application by the applicant whose entitlement is challenged.

Since, as already set out, the rights in respect of a divisional application can only be derived from the parent application, the disputed right of the applicant to file the parent application cannot form a sufficient basis for a right to file a divisional application.

It follows that in the exercise of its duty to examine whether the applicant is entitled to file the divisional application, discussed at the end of paragraph 2, above, the Receiving Section may not deal with such an application as a divisional application and must decide accordingly where the parent application is suspended under Rule 13 EPC. This is because the status of the applicant in the parent application has been put in doubt by the operation of the machinery of that rule.

4. The appellant further submitted that the claimant third party would not be affected by the filing of the divisional application, since in this case the subject-matter of the claims of the divisional application is not at issue in the national entitlement proceedings.

The Board notes that, in its decision of 24 April 1998, the Legal Division suspended the proceedings for grant of the parent application as a whole. Hence, the effect of the suspension is not restricted to just a part of the subject-matter of the parent application and the Receiving Section has no power to question or disregard the suspension ordered by the Legal Division.

Further, the Receiving Section, which is competent to decide on the fulfilment of the formal requirements on filing, has no means of examining the subject-matter of the divisional application in suit nor, a fortiori, its possible overlap with the subject-matter at issue in the national entitlement proceedings. More importantly, in the system of legal process provided for under Article 61 EPC, it is exclusively within the competence of the judge in the national entitlement proceedings and not that of any organ within the EPO to determine what is the subject-matter at issue in the pending entitlement proceedings.

Therefore, the Board cannot concur with the appellant's argument that the alleged absence of overlap between the subject-matter of the application in suit and the subject-matter at issue in the entitlement proceedings would justify allowing the filing of the application in suit as a divisional application.

In any event, what would have to be considered as the subject-matter of the divisional application in suit for the purposes of such a comparison is not restricted to the scope of the claims initially filed with that application. What would have to be considered is the whole content of the divisional application in suit, this forming the basis for possible amended or added claims at a later stage of the proceedings. As accepted by the appellant during the oral proceedings, the content of the application in suit is identical to the content of the parent application. Therefore, the content of the application in suit necessarily overlaps with the subject-matter at issue in the entitlement proceedings.

5. The appellant also argued that the proceedings for grant of the divisional application cannot be suspended, since Rule 13 EPC does not allow a stay of the proceedings before the publication of the application.

That argument is not relevant in the present case since the question at issue is whether the application should have been treated as a divisional application on filing under Rule 25 EPC and not the question of the suspension of the proceedings in the divisional application under Rule 13 EPC.

6. Finally, the appellant argued that the claimant third party would not be affected (i.e. prejudiced) by the filing of the divisional application, since it could also ask for a suspension of the divisional proceedings.

It has to be noted that it is not possible for the claimant third party to apply to the EPO for an automatic and immediate suspension of the divisional application proceedings by way of an extension of the suspension of the parent application proceedings. On the contrary, in order to have the divisional application proceedings suspended the third party would first have to bring ("open") new national proceedings against the applicant in which it sought a judgment that it is entitled to the grant of a patent on the divisional application. The third party would then have to provide evidence that it had brought such proceedings and finally the matter would have to be decided by the EPO. All this would clearly put an additional heavy and undue burden on the third party and would be contrary to the objective of the

suspension of the parent application proceedings, which is to protect its interests.

Hence, the Board cannot accept the argument of the appellant that the claimant third party would not be prejudiced by the filing of the application in suit.

7. The Board therefore agrees with the decision of the Receiving Section that the application in suit, filed during suspension of the proceedings for grant of the parent application, shall not be dealt with as a divisional application.

## **Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel