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**Datasheet for the decision
of 10 December 2010**

Case Number: J 0002/08 - 3.1.01

Application Number: 05027368.9

Publication Number: 1635262

IPC: G06F 11/273

Language of the proceedings: EN

Title of invention:

Device diagnostics

Applicant:

Sony Deutschland GmbH

Opponent:

-

Headword:

Pending application/SONY

Relevant legal provisions:

EPC R. 36(1)

Relevant legal provisions (EPC 1973):

EPC Art. 108

EPC R. 25(1), 78(2), 69(1)

Keyword:

"Pending earlier application (yes)"

"Divisional application"

"Appeal period"

Decisions cited:

G 0001/09, J 0002/08

Catchword:

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Case Number: J 0002/08 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 10 December 2010

Appellant: Sony Deutschland GmbH
Kemperplatz 1
D-10785 Berlin (DE)

Representative: Müller - Hoffmann & Partner
Patentanwälte
Innere Wiener Strasse 17
D-81667 München (DE)

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 9 August 2007.

Composition of the Board:

Chairwoman: B. M. Günzel
Members: T. Bokor
S. Hoffmann

Summary of Facts and Submissions

- I. The present appeal proceedings concern an appeal against the decision of the Receiving Section, posted 9 August 2007, deciding *inter alia* that European patent application No. 05027368.9 is not considered to have been validly filed as a divisional application and that the appellant's request that the noting of loss of rights pursuant to Rule 69(1) EPC 1973 issued on 25 April 2006 be set aside, is refused.
- II. Against this decision an appeal was filed on 19 September 2007.
- III. For the details of the decision of the Receiving Section and the appeal, reference is made to the interlocutory decision J 2/08 of 27 May 2009 (OJ EPO 2010,100).
- IV. The decision under appeal essentially held that the parent application of the purported divisional application ceased to be pending on the date of the oral proceedings, when the decision refusing the parent application was pronounced.
- V. The appellant argued, *inter alia*, that an application must be considered pending until the expiration of the time limit for filing an appeal against a refusing decision of the Examining Division.
- VI. In the decision J 2/08 (*supra*) the following point of law has been referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC:

Is an application which has been refused by a decision of the Examining Division thereafter still pending within the meaning of Rule 25 EPC 1973 (Rule 36(1) EPC) until the expiry of the time limit for filing a notice of appeal, when no appeal has been filed?

VII. In its decision G 1/09 of 27 September 2010 the Enlarged Board of Appeal answered this question of law.

VIII. As a main request in the appeal, the appellant requests that the decision under appeal be set aside. In the notice of appeal the appellant also requested a rectification of the decision under appeal.

Reasons for the Decision

1. In the communication "Noting of loss of rights pursuant to Rule 69(1) EPC" (EPO Form 1044) of 25 April 2006 (see point I above), the Receiving Section informed the appellant that the application is not being processed as a divisional application because when it was filed, the pending earlier European patent application had been finally refused, withdrawn or deemed withdrawn. This reasoning has been upheld by the Receiving Section in the decision under appeal, following a request from the appellant to set aside the above communication concerning the loss of rights.
2. The findings of the Receiving Section have been disputed by the appellant, who argues that for the purposes of Rule 25(1) EPC 1973 (Rule 36(1) EPC) an application must be considered as pending at least until the expiry of the time limit for filing an appeal against a refusing

decision of the Examining Division, even in the absence of an appeal.

3. In the decision G 1/09 of 27 September 2010 the Enlarged Board of Appeal gave the following answer to the referred question of law:
"In the case where no appeal is filed, a European patent application which has been refused by a decision of the Examining Division is thereafter pending within the meaning of Rule 25 EPC 1973 (Rule 36(1) EPC) until the expiry of the time limit for filing a notice of appeal."
(see Headnote and Order of the decision).
4. The earlier European application No. 01102231.6 [the parent application] was refused by the Examining Division in the course of oral proceedings held on 23 November 2005. The written decision is dated 27 January 2006. Accordingly, the time limit for filing a notice of appeal against this decision expired on 6 April 2006 (Article 108 EPC 1973 in conjunction with Rule 78(2) EPC 1973).
5. The application in suit was filed on 14 December 2005 as a divisional application to the above-mentioned parent application No. 01102231.6. Thus following the decision G 1/09 (*supra*), the parent application was still pending when the purported divisional application was filed.
6. Therefore, the decision under appeal erred in finding that the parent application was no longer pending. The communication under Rule 69(1) EPC 1973 dated 25 April 2006 was equally erroneous and must be reversed.

7. The decision under appeal did not deal with the further requirements for according a valid filing date under Article 90 EPC 1973. Insofar the present appeal also does not extend to this issue. Therefore, the Board remits the case for examination of the further requirements for the full formal recognition of the divisional application. Point 4 of the Order of the impugned decision is also ancillary to the legal effect pronounced in point 1, and its rectification requires no further action from the Board.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The noting of loss of rights pursuant to Rule 69(1) EPC 1973 dated 25 April 2006 is set aside.
3. Application No. 01102231.6 is to be regarded as a pending earlier European patent application pursuant to Rule 25(1) EPC 1973 with respect to the present application.
4. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel