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**Datasheet for the decision  
of 9 July 2009**

**Case Number:** J 0005/08 - 3.1.01

**Application Number:** 06111681.0

**Publication Number:**

**IPC:**

**Language of the proceedings:** EN

**Title of invention:**

Recording apparatus having a device for detecting the presence or absence of a liquid

**Applicant:**

CANON KABUSHIKI KAISHA

**Opponent:**

-

**Headword:**

Device for detecting the presence or absence of a liquid/CANON KABUSHIKI KAISHA

**Relevant legal provisions:**

**Relevant legal provisions (EPC 1973):**

EPC Art. 97(3), 106, 107, 108, 109(1), 110, 111  
EPC R. 25, 64, 89

**Keyword:**

"Interpretation of the notice of appeal"  
"Pending status of the parent application up to the revision decision pursuant to Article 109 EPC 1973"  
"Application to be treated as divisional application (yes)"

**Decisions cited:**

G 0003/03, J 0012/85, J 0028/94, J 0028/03, J 0003/04,  
J 0010/07, J 0002/08, T 0001/88, T 0001/88, T 0001/92,  
T 0919/05



Case Number: J 0005/08 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 9 July 2009

**Appellant:** CANON KABUSHIKI KAISHA  
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**Representative:** TBK-patent  
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**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 24 September 2007  
stating that the application will not be  
treated as a European divisional application.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** S. Hoffmann  
K. Garnett

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Receiving Section posted on 24 September 2007 refusing the request that the European patent application No. 06111681.0 be treated as a divisional application. The decision of the Receiving Section was based on the ground that at the date when the present divisional application was filed (24 March 2006) the earlier application No. 01113197 (hereinafter "the parent application") was no longer pending.
- II. The relevant procedural events in the parent application can be summarized as follows:
- (a) The parent application was filed on 12 July 1996 as a divisional application to European Patent application 96111292.7.
  - (b) On 26 January 2006 a decision to grant a patent on the basis of the supporting documents which had been indicated in the communication pursuant to Rule 51(4) EPC 1973 was issued. The mention of the decision to grant in the European Patent Bulletin was scheduled for 8 March 2006.
  - (c) On 3 February 2006 a request for correction of the wording of claim 1 on the ground of an obvious mistake according to Rule 89 EPC was filed. The corrected German and French versions of claim 1 were enclosed. Furthermore, it was requested that the forthcoming publication of the mention of the grant be based on the corrected version of claim 1.

- (d) On 7 February 2006 the first examiner amended Part 3 of the existing EPO Form 2035 ("Form 2035.3") to record the way that claim 1 as corrected by the letter of 3 February 2006 was to be published. The examiner signed this amended sheet. The sheet was then inserted in the file but not sent to the applicant, who was not aware of it until later.
  
- (e) On 8 March 2006 the European Patent Bulletin mentioned the grant of the patent. The pertinent European patent specification which was published by the European Patent Office on the same day contained the amended wording of claim 1 as submitted by the patentee with the letter dated 3 February 2006.
  
- (f) On 23 March 2006 the appellant filed an appeal against the decision to grant dated 26 January 2006 and paid the appeal fee on the same date. Referring to Legal Advice No. 17/90 (OJ 1990, 260) according to which the decision to grant determines the text of the patent, the appellant requested that the decision to grant dated 26 January 2006 be corrected as requested with letter of 3 February 2006 because this decision still referred to the uncorrected text of claim 1.
  
- (g) On 12 June 2006 the Examining Division in the composition of a chairman, primary and second examiner signed, in Part III of EPO Form 2701 under the heading "Appeal against the decision of the Examining Division", a direction to the formalities officer stating that:

- the appeal against the decision of the Examining Division was allowable and well founded;
- the decision under appeal was rectified according to Article 109(1) EPC, and Form 2710 should be dispatched; and
- reimbursement of the appeal fee was ordered.

(h) On the same date, the same examiners also signed Part 6 of EPO Form 2051 (the form is headed "Correction after decision to grant" and Part 6 is headed "Correction of the decision"). The examiners stated:

"The decision of 26.01.06 is corrected so that the amendments requested with letter dated 03.02.06 have been accepted".

(i) The appellant was then sent two separate communications from the Examining Division dated 21 June 2006, as follows:

(i) The first (on Form 2710), headed "Rectification (Article 109(1) EPC)", stated that following the appeal of 23 March 2006 rectification was ordered and that the appeal fee was to be reimbursed pursuant to Rule 67 EPC 1973;

(ii) The second, headed "Correction of a decision under Rule 89 EPC", stated that the decision to grant a patent of 26 January 2006 was corrected as requested in the applicant's letter of 3 February 2006.

- III. Meanwhile, on 24 March 2006 the application in suit was filed as a divisional application to the parent application.
- IV. By a communication from the Receiving Section dated 31 July 2006 informing the appellant of a loss of rights pursuant to Rule 69(1) EPC 1973, the appellant was informed that the application in suit was not being processed because when it was filed the grant of patent in respect of the parent application had already been mentioned in the European Patent Bulletin.
- V. In response to the communication the appellant requested with letter dated 29 September 2006 as main request that the finding of the noting of loss of rights be reversed and that the applicant be informed that the application was to be processed as a divisional application and (as first auxiliary request) oral proceedings and (as second auxiliary request) that an appealable decision in writing on the matter be issued. The letter contained detailed reasons with respect to all requests.
- VI. In a communication dated 9 March 2007 the Receiving Section maintained the position that notice of loss of rights had been correctly issued. It stated that the request for correction pursuant to Rule 89 EPC 1973 filed on 3 February 2006 and the appeal filed on 23 March 2006 did not alter the procedural situation with respect to the requirements for the filing of a divisional application. A decision to correct the decision to grant a patent only relates to linguistic errors, errors of transcription and obvious mistakes

and does not reopen the grant procedure. Furthermore, the Receiving Section argued that the decision to grant was corrected by a decision dated 7 February 2006 (ie, the amendment to Form 2035.3 made on that date) before the publication of the mention of the grant of the patent in the European Patent bulletin. The Receiving Section interpreted the content of the notice of appeal dated 23 March 2006 as being directed against the missing notification of the "decision" of 7 February 2006 because, from an objective point of view, this interpretation was in the appellant's best interests. If the appeal were to be interpreted as having been directed against the decision to grant, the appeal would have been inadmissible pursuant to Article 107, sentence 1 EPC 1973 since the request for correction had already been granted (ie, on Form 2035.3 of 7 February 2006), so that the appellant was no longer adversely affected. On the basis of the interpretation that the appeal was directed against the missing notification, the Receiving Section concluded that it was not relevant whether or not a divisional application could be filed after an appeal was filed against a decision to grant a patent with regard to the parent application, or whether or not this appeal was admissible or inadmissible, and referred to decision J 28/03 (OJ EPO 2005, 597).

- VII. In a letter of 21 March 2007 the appellant disputed that its appeal had been directed against a missing notification of a decision correcting the decision to grant or that the amended content of EPO Form 2053.3 in the file of the parent application could be considered a decision correcting the decision to grant a patent because this EPO Form was only used as an EPO internal



paper for the purpose of collecting the correct documents for publication and did not have the character of a decision. Furthermore, it argued that a missing notification cannot be appealed because, according to Article 106 EPC, only decisions can be appealed. Since the appeal in the parent application was not rejected as inadmissible, but was in fact decided in favour of the applicant by means of an interlocutory revision, the assumption of the Receiving Section that the appeal was directed against the missing notification of a decision was also contradicted by the history of that file. The appeal against the decision to grant a patent was filed within the two month time limit for filing an appeal and was clearly not a mere procedural abuse: otherwise no rectification would have been ordered by the Examining Division. Therefore, the appeal operated to suspend the legal effect of the decision to grant a patent until the appeal had been positively decided in favour of the applicant. During that time period, the parent application was still pending and the application in suit should be treated as a divisional application thereof.

VIII. On 24 September 2007 the Receiving Section issued the decision under appeal, deciding that the application would not be treated as a European divisional application, that the request for oral proceedings was rejected and that the fees paid for the application should be refunded once this decision had become final.

In the reasons for this decision, the Receiving Section mainly reiterated the line of reasoning already given in its prior communication. As regards the fact that

Form 2035.3 was used, the Receiving Section referred to existing case law to the effect that whether an act is to be considered as a "decision" depends on its content, not on its form. In the opinion of the Receiving Section, the handwritten amendments signed by the first examiner on Form 2035.3 indicated that the examiner's intention was to correct the decision to grant, it being assumed that the responsible formalities officer would then issue the necessary communication to the appellant in order to inform it of the decision taken. The Receiving Section then added that in accordance with this intention, the patent was published with claim 1 as filed on 3 February 2003.

The Receiving Section further said that an appeal against the decision to grant would have been inadmissible since the appellant was not adversely affected either by the decision to grant, which was based on documents approved by the appellant, or by the decision correcting the decision to grant, which corresponded to appellant's request under Rule 89 EPC (citing J 12/85, OJ EPO 1986, 155). In this respect the Receiving Section concluded that it was to the appellant's advantage that the Examining Division in the parent application had treated the appeal as an appeal against the missing notification of the decision to correct the decision to grant.

Furthermore, the Receiving Section held that its interpretation of the appeal as being directed against the missing notification was not in contradiction to the history of the parent application. It considered that *"The decision rectifying the decision under Rule 89 EPC in the framework of the interlocutory*

*revision pursuant to Article 109(1) EPC does not state the grounds for ordering the rectification, but the title of the 'Correction of a decision under Rule 89 EPC' issued on 21.06.2006 reflects this interpretation of the appeal by the examining division".*

The Receiving Section stated that the successful appeal resulting in the rectification of the decision to grant pursuant to Rule 89 EPC only had suspensive effect with regard to the decision to correct the decision to grant and concluded the appeal did not re-open the possibility of filing a divisional application since the decision pursuant to Rule 89 EPC did not itself set aside the decision to grant.

- IX. In its grounds of appeal the appellant adhered to its position that the appeal filed in the parent application was not directed against the missing notification but against the decision to grant a patent. It concluded from the fact that the appeal was not rejected as inadmissible that the Examining Division also understood the appeal as being directed against the decision to grant.

The appellant accepted that the decision to grant was completely in accordance with its original request but claimed that it had detected the obvious error in claim 1 in good time before the mention of the grant of the patent was published in the European Patent Bulletin. It submitted that, at the latest at the time when the EPO gained knowledge of this obvious error, the applicant had a legal right to appeal the decision to grant because, as from this time, the decision to grant

no longer contained what the applicant and the European Patent Office really wanted to grant.

The appellant emphasised that the appeal proceedings in the parent application were terminated by an "*interlocutory decision*" under Article 109 EPC 1973 which "*lifted*" the earlier decision to grant and corrected it as requested and referred to the communication dated 21 June 2006 bearing the title "*Rectification (Article 109(1) EPC)*", but not the title "Correction of a decision under Rule 89 EPC".

The appellant concluded from the foregoing procedural facts that the parent application was still pending between 23 March 2006, the day on which the appeal was filed, and 21 June 2006, the day on which the document bearing the title "*Rectification (Article 109(1) EPC)*" was signed. Therefore, it asserted that it was entitled to file a divisional application on 24 March 2006 according to Article 76 EPC (1973).

- X. The appellant requested that the impugned decision be set aside and that application 06111681 be treated as European divisional application.

### **Reasons for the Decision**

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC 1973 and is therefore admissible.

As regards the EPC 2000, which entered into force on 13 December 2007, the present Board follows the reasoning in decision J 10/07 (OJ EPO 2008, 567,

points 1.1, 1.2 and 1.3 of the Reasons) that the provisions of Article 106 to 109 EPC 1973 and the Implementing Regulations 1973 which are linked to these Articles are to be applied in the present case.

2. The same applies for the application of Rule 25(1) EPC 1973 stipulating the requirements for filing a divisional application and which reads as follows:

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

*Object of the appeal in the parent application*

3. The Board first needs to clarify the situation with respect to the procedural acts and events in the parent application. In particular, the Board does not share the Receiving Section's conclusion that the notice of appeal filed on 23 March 2006 was directed against the omitted notification of the decision allegedly taken by the first examiner on Form 2035.3 or the conclusion as to the effect of the decision made by the Examining Division under Article 109(1) EPC.
4. The Receiving Section argued that since the mention of the grant of the patent in the parent application took place on 8 March 2006 the pendency of the parent application came to an end on that date and, furthermore, that the request for correction pursuant to Rule 89 EPC filed on 3 February 2006 as well as the appeal filed on 23 March 2006 did not alter the procedural situation with respect to the requirements for filing a divisional application.

In this regard, the Receiving Section regarded the first examiner's amendment to the EPO Form 2035.3 as a decision to correct the decision to grant and concluded that the appeal, although on its face directed against the decision to grant, should in fact be interpreted as having been directed against a missing notification in order to avoid the conclusion that the appeal was inadmissible. The reasons why this conclusion was incorrect are explained by the following.

5. The version of Form 2035.3 which was signed on 7 February 2006 with its handwritten amendments cannot be interpreted as a decision pursuant to Rule 89 EPC 1973.

Form 2035.3 is only concerned with the administrative measures to be taken regarding the documents for the grant of the patent. Using this form, the publication of the decision to grant is prepared. Neither the form as originally worded nor the handwritten amendments to it, even if signed by the first examiner, are capable of constituting a decision. As discussed further below, what constitutes a decision is an objective question, but it can be pointed out that the first examiner was obviously not aware at the time that a decision to correct the decision to grant was required and was also obviously of the opinion that it would be sufficient to correct the data in Form 2035.3. Otherwise he would not have acted in this way. There is nothing in the file from which it can be concluded that the first examiner intended to take a decision pursuant to Rule 89 EPC 1973, something which could only be done by all three members of the Examining Division. An act

made to amend an internal administrative measure cannot be interpreted as a decision solely because such a decision was legally required in order to correct the decision to grant. The Examining Division was obviously of the same view since on 12 June 2006 it took the requested decision by using EPO Form 2051, Part 6, which was headed "Correction of the decision" (see point II(h) above and points 8, 9 and 10 below).

Furthermore, the Receiving Section concluded (cf. point 4.3 of the Reasons) that: "*As soon as a decision exists, as in the present case the decision under Rule 89 EPC, an appeal can lie from it under Article 106 EPC and the appeal may be directed against defects of the decision, as e.g. the missing notification.*" The latter conclusion "*as e.g. the missing notification*" was obviously erroneous since an omitted notification of a decision does not constitute an appealable decision in terms of Article 106(1) EPC 1973.

In any event, however, a document such as a notice of appeal must be construed objectively having regard to its wording, the context of the proceedings (see, e.g. T 01/88 of 26 January 1989, point 1.1.2 of the Reasons) and, where there remain doubts, on the basis of an objectively correct interpretation of the appellant's interests (see J 06/08 of 27 May 2009, point 4, 6.3 et seq., in particular point 7 of the Reasons). In the present case the notice of appeal filed on 23 March 2006 stated clearly that it was being filed against the decision to grant dated 26 January 2006, in respect of which interlocutory revision was requested. Admittedly the notice of appeal (which also contained the grounds

of appeal) refers to the amendment to Form 2035.3 which had taken place on 7 February 2006, and which by this stage the appellant had discovered by inspection of the public file. In point 4.3 of its decision the Receiving Section said that in the notice of appeal the appellant had criticised the fact that the appellant had not received written notification of the correction, and that "thus" the appeal "had" to be interpreted as being directed against the missing notification. However, the notice of appeal does not contain any such criticism and there is nothing else in the notice of appeal which can be objectively construed as an appeal against any failure of the Office to notify the appellant of the decision. There was therefore no justification for interpreting the notice of appeal contrary to its plain wording. This is all the more so since that interpretation would indeed have resulted in the appeal being inadmissible (see J 06/08 loc. cit).

As a result of the foregoing considerations, the basis for the Receiving Section's interpretation of the notice of appeal as having been directed against a missing notification of the "decision" contained in Form 2035.3 falls away.

Hence, the appeal is to be construed as having been directed against the decision to grant of 26 January 2006 and appeal proceedings concerning the grant procedure were thereby initiated.

6. These errors both as to the legal status of the amendment to Form 2035.3 and as to the nature of the appeal led the Receiving Section to reach an incorrect conclusion as to the nature and effect of the decision



made by the Examining Division under Article 109(1) EPC on 12 June 2006. This conclusion is not in fact very clearly stated in the Receiving Section's decision but can be summarised as follows: since the order under Article 109(1) EPC was made in an appeal relating to an application to rectify a decision to grant under Rule 89 EPC, the order had the effect of rectifying the decision under Rule 89 EPC. This in turn meant that the application had not become pending, as would have happened if an admissible appeal had been filed against the decision to grant. This can be gathered from the rather confusing passages in paragraphs 4.4 and 5 of the decision, which run as follows:

*"The decision rectifying the decision under Rule 89 EPC in the framework of the interlocutory revision pursuant to Article 109(1) EPC does not state the grounds for ordering the rectification, but the title of the "Correction of a decision under Rule 89 EPC" issued on 21.06.2006 reflects this interpretation of the appeal by the examining division" (point 4.4 of the Reasons).*

*"The successful appeal resulting in the rectification of the decision to correct the decision to grant pursuant to Rule 89 EPC had only suspensive effect with regard to the decision to correct. Since the decision pursuant to Rule 89 EPC itself does not set aside the decision to grant ... the appeal did not reopen the possibility to file a divisional application" (point 5 of the Reasons).*

7. The Receiving Section's problem appears to have arisen from the fact that the Examining Division had rectified

the decision to grant under Rule 89 EPC 1973 and simultaneously had taken a decision to revise the decision to grant under Article 109(1) EPC.

However, the Receiving Section's reasoning that the successful appeal resulted in the rectification of the decision to correct the decision to grant pursuant to Rule 89 EPC 1973 had no legal basis in the EPC. The request for correction under Rule 89 EPC and the appeal have to be dealt with separately and differently.

Firstly, there is no procedural provision whereby an appeal can (if successful) result in a decision pursuant to Rule 89 EPC 1973, since the outcome of appeal proceedings is governed only by the provisions of Article 109 to 111 EPC 1973.

Secondly, as already explained, the starting point of the Receiving Section was already incorrect because the appeal was directed against the decision to grant dated 26 January 2006 and not against the alleged "decision" on EPO Form 2035.3 to correct the decision to grant.

8. Therefore, it is correct that a decision pursuant to Rule 89 EPC 1973 to correct the decision to grant was made by the Examining Division by using EPO Form 2051 on 12 June 2006 but it is not correct that a separate decision pursuant to Article 109 EPC 1973 was not also made in relation to the decision to grant on the same day. Once again, a decision of the Office such as this must be construed objectively having regard to the context of the proceedings. In the decision dated 12 June 2006 as recorded on Form 2701 the three examiners stated that:

- the appeal is allowable and well-founded;
- the decision is rectified (Article 109(1) EPC 1973); and
- reimbursement of the appeal fee is ordered.

This clear wording corresponds precisely to Article 109(1) EPC 1973 and from an objective viewpoint makes it clear that the Examining Division had decided to take a separate decision pursuant to Article 109(1) EPC 1973. Furthermore, the Examining Division clearly regarded the appeal proceedings as terminated by this procedural act: otherwise it would have referred the case to the Boards of Appeal (see Article 109(2) EPC).

9. What is not stated in the decision as set out in Form 2701 or in the subsequent communication to the appellant dated 21 June 2006 is what form the interlocutory revision, or rectification, took. However, what was ordered can only have been the interlocutory revision of the decision to grant so as to amend it in accordance with the appellant's letter of 3 February 2006. This follows having regard to the request which had been made in the notice of appeal which referred to the appellant's letter of 3 February 2006 and to which the order for interlocutory revision was a response. It also follows from the terms of the separate order for rectification made under Rule 89 EPC 1973, which forms part of the factual matrix in the context of which the order under Article 109(1) EPC was made. Therefore, the interlocutory revision of 12 June 2006 made pursuant to Article 109 EPC 1973 can only be construed as embracing an order for the grant of the patent in the form of the corrected documents.

10. Any perceived inconsistency of the Examining Division issuing two decisions on the same day both concerning the same correction of the decision to grant cannot alter the procedural fact that two decisions were taken. The fact that one of the decisions may have been incorrect does not mean that that decision must be construed as having a different meaning and effect from that which, on an objective basis, it clearly had. From the appellant's point of view it cannot be said that one decision, in particular the decision under Article 109(1) EPC, was less valid than the other.

It follows that the Examining Division simultaneously issued (a) a decision pursuant to Rule 89 EPC 1973 (on Form 2051) and (b) an interlocutory revision decision pursuant to Article 109(1) EPC 1973 (on Form 2701), both decisions relating to the decision to grant dated 26 January 2006.

*The pending status of the parent application*

11. The question is then, what was the effect of these actions with respect to the issue of whether the (parent) application remained pending within the meaning of Rule 25(1) EPC 1973?

As regards the meaning of "pending application" in Rule 25(1) EPC 1973, one interpretation, which is not binding on the Boards of Appeal, is given in the *Information from the European Patent Office* dated 9 January 2002 (OJ EPO 2002, 112). There it is stated as follows:

"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 (see Guidelines for Examination in the European Patent Office, Chapter A-IV, 1.1.4)"

However, this official information contains only the statement that the cited procedural situations determine the end of the pendency of a European patent application but the statement does not state specific criteria which can be used to define the pendency/non-pendency of an application in other procedural situations, for example as in the present case where an appeal was filed against the decision to grant.

12. Article 106(1), second sentence EPC 1973 stipulates that an appeal shall have suspensive effect. The suspensive effect of a (timely filed) appeal which is referred to the Board of Appeal is generally construed so as to ensure that the contested decision does not take effect until the final decision is delivered by the Board of Appeal. *"Although not changing the date of the contested decision, this [suspensive] effect prevents it from having any legal consequences. It further means that the earliest date at which the decision under appeal could have any such consequences (provided it was upheld) would be the date of a decision by a Board of Appeal."* (T 01/92, OJ EPO 1993, 685, point 3.1 of the Reasons).

If the result of an appeal against a decision to grant is that the appealed decision has no legal effect it would be strange if the application was not still pending during the appeal proceedings.

13. In the present case, the appeal was filed after the publication of the mention of the grant but within the two month time limit for filing an appeal according to Article 108, sentence 1 EPC 1973. Therefore, the question arises whether the "taking effect" of the decision to grant according to Article 97(3) EPC can override the suspensive effect of an appeal pursuant to Article 106, second sentence EPC 1973. It must be noted that the validity of the publication of the decision to grant pursuant to Article 97(3) EPC 1973 must depend on the validity of the decision to grant. If no effect ensues from the decision to grant because of the suspensive effect of the appeal the publication of the mention of the grant cannot have legal effect either, even if the appeal is filed after the publication. The present European Patent Office practice to publish the mention of the grant of a patent before the two month time limit for filing an appeal has expired is based on the fact that the grant of a patent must have been based on agreed documents but seems to involve the risk that the publication of the decision to grant will become retroactively invalid by reason of an appeal. In any event, however, this practice cannot be a legal basis for negating the suspensive effect of appeal stipulated for by Article 106(1), sentence 2 EPC 1973. Hence, in the present case the fact of the publication of the mention of grant on 8 March 2006 is not a valid reason for denying the pendency of the grant proceedings after the appeal was filed.

14. On the other hand, it cannot be said that the clear jurisprudence of the Boards of Appeal is that the suspensive effect of an appeal ensues in all circumstances and has, equally in all circumstances, the consequence that the grant proceedings remain pending in the sense of Rule 25 EPC 1973 during the appeal proceedings.
  
15. Admittedly, two decisions of the Boards of Appeal appear to say that this is indeed the case. In decision J 28/94 (OJ EPO 1995, 742, point 2.2 of the Reasons), the Board took the view that the appeal's suspensive effect meant the contested decision did not have legal effect before the date of the decision of the Board of Appeal. In decision J 3/04, dated 20 September 2005, it was said (point 5 of the Reasons) that the suspensive effect does not depend on the admissibility of the appeal or on the answer to the question whether an appellant is adversely affected according to Article 107, first sentence EPC 1973.

On the basis of these views that the appealed decision does not take effect before the date of the decision of the Board of Appeal (or, implicitly, the date of an order made under Article 109(1) EPC), the grant proceedings and thereby the application must still be pending up to this latter date.

16. However, a (partly) different view was taken in the decision J 28/03 (OJ EPO 2005, 597), where the appeal was dismissed as inadmissible by the Board of Appeal.

It was stated that "in the intermediate period between the filing of an appeal and the final decision of the Board of Appeal the fate of the appealed decision is pending although the contested decision as such still exists" (point 12 of the Reasons). According to this decision the suspensive effect meant that actions which normally take place after a decision are "frozen" but does not have the effect of setting aside the contested decision to grant a patent. If the appeal is dismissed as inadmissible the appellant "is put back to the legal situation existing at the time of the grant of the patent as if no appeal had been filed" (point 17 of the Reasons). This view leads to the result that when an appeal is dismissed as inadmissible by the Board of Appeal, the grant proceedings are to be considered as not having been pending during the appeal proceedings.

17. In the present case the Receiving Section argued, with reference to decision J 12/85 (OJ EPO 1986, 155, point 3 of the Reasons), that the appeal against the decision to grant was inadmissible because the appellant was not adversely affected by the appealed decision. If the reasoning of decision J 28/03 is then additionally applied to the present case, it would mean that the grant proceedings were no longer pending during the appeal proceedings.
  
18. However, in the present case the controversial opinions on the effect of a timely filed but inadmissible appeal with respect to the pendency of an application have no bearing on the outcome of the present case since the fact that the Examining Division issued a revision decision under Article 109 EPC 1973 makes this legal question moot.



19. According to the established European Patent Office practice interlocutory revision under Article 109 EPC 1973 can either be such as to annul the decision (a "*rein kassatorische Abhilfe*", or purely "cassatory" act) or it can be a "reformatory" revision (see T 919/95, point 2 of the Reasons, and Singer/Stauder (Joos), EPC, 4th German ed., Art. 109 note 11). In both cases, and whether or not the cancellation of the appealed decision is expressly ordered, the appealed decision is set aside by the department of first instance, in the first case by a "cassatory" procedural act, e.g. by a communication providing for the further examination of the application or, in the second case, by a revision decision immediately revising the appealed decision. In the present case, by their decision of 12 June 2006 the Examining Division ordered an immediate "reformatory" revision.
  
20. Where a decision is taken on the allowability of an appeal, the present Board holds that an application is pending in terms of Rule 25 EPC 1973 at least up to the point in time when the decision is taken. There is no need for the Board to consider what the position is where an appeal has been rejected as inadmissible.
  
21. The Receiving Section stated under point 3 of the reasons of their decision that a decision to correct the decision to grant does not "re-open" the grant procedure and does not "re-open" the possibility to file a divisional application. However, in the present case this conclusion is only correct with regard to a decision to correct the grant decision pursuant to Rule 89 EPC 1983, since such a decision does not

involve a substantive amendment to the decision. It was not correct with regard to a revision decision under Article 109 EPC 1973, which has the effect that the appealed decision is set aside.

22. The decision of the Examining Division under Article 109(1) EPC in the present parent application included findings that the appeal was both admissible and allowable. These findings were not only expressed by the words "*the appeal is allowable and well-founded*" but they were also an indispensable condition for the further decision to grant interlocutory revision: see Article 109(1) EPC and the decision of the Enlarged Board of Appeal, G 3/03 (OJ EPO 2005, 344, point 3.3. of the Reasons).
  
23. As such, a revision decision pursuant to Article 109 EPC 1973 opens up the possibility that the patentability of the claimed subject matter will be completely re-assessed, independently of whether or not the cancellation of the appealed decision is expressly ordered or the written reasons are restricted to a specific legal question. Such a decision cannot be limited to a single legal question or issue as e.g. the question whether or not a decision to grant can be corrected. This is the decisive difference from a decision under Rule 89 EPC 1973, which does not affect the date and legal existence of the decision to be corrected.
  
24. In the present case, the "reformatory" revision decision under Article 109 EPC 1973 was restricted to the correction of the decision to grant. However, the lack of any exhaustive statement in respect of the

patentability of the subject matter did not limit the appeal proceedings to the allowed correction, because the decision to grant was replaced by the revision decision on 12 June 2006 and the grant proceedings were not terminated before this date.

In the Board's view, it seems to be obvious and self-evident that the grant proceedings having been terminated by the revision decision on 12 June 2006 were still pending up to this date of the revision decision.

25. As the present divisional application was filed after the appeal in the parent application had been filed and before the revision decision was taken by the Examining Division in the parent application, the parent application was pending at the filing date of the divisional application. Hence, the divisional application fulfilled the requirement pursuant to Rule 25(1) EPC 1973 that the earlier application No. 01113197 was pending at that date. Therefore, the appeal is allowable and the present application is to be treated as a divisional application to application No. 01113197.

26. The legal question referred to the Enlarged Board of Appeal in case J 02/08 concerns the status of a parent application after its refusal and until the expiry of the period for appeal, if no appeal is filed. The outcome of these proceedings cannot affect the foregoing reasoning and, therefore, a stay of the present proceedings was neither justified nor appropriate.

**Order**

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

1. The decision under appeal is set aside.
2. The application is to be treated as a divisional application on application No. 01113197.

The Registrar:

The Chairman:

S. Fabiani

B. Günzel