

Internal distribution code:

- (A) Publication in OJ
- (B) To Chairmen and Members
- (C) To Chairmen
- (D) No distribution

**Datasheet for the decision
of 1 September 2010**

Case Number: J 0018/09 - 3.1.01

Application Number: ...

Publication Number: -

IPC: ...

Language of the proceedings: EN

Title of invention:
XXX

Applicant:
N.N.

Opponent:
-

Headword:
-

Relevant legal provisions:
EPC Art. 2(1), 76, 150(2), 153(2)
EPC R. 36(1), 159

PCT
Art. 11(3), 22, 23(1)(2), 48(2), 64(4)

Relevant legal provisions (EPC 1973):
EPC Art. 150(3)
EPC R. 25(1)

Revision Act of 29 November 2000
Art. 7(1), 8

Decision of the Administrative Council of 28 June 2001
Art. 1(5)

Decision of the Administrative Council of 7 December 2006

Art. 2(1)

Keyword:

"Pending earlier European patent application (no)"

"Valid entry into the European phase of an international patent application as requirement for a pending earlier European patent application (yes)"

Decisions cited:

J 0017/99, J 0018/04, G 0001/09

Catchword:

An international application which does not fulfil the requirements according to Article 22 PCT for entering the European phase is not pending before the European Patent Office and therefore cannot be considered a pending earlier European patent application pursuant to Rule 36(1) EPC.



Case Number: J 0018/09 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 1 September 2010

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 17 February 2009.

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 17 February 2009, ruling that the present application should not be processed as a divisional application of the earlier Euro-PCT application No. XXXXXXXX.X.
- II. On 22 July 2008, the present European patent application No. YYYYYYYY.Y (the "Divisional Application") was filed as a divisional application to the international patent application PCT/000000/000000 (the "International Application"), which designated inter alia EP and for which the European Patent Office had allocated the European patent application No. XXXXXXXX.X and had drawn up a written opinion dated 20 June 2007 as International Searching Authority.
- III. The 31-month period prescribed under Rule 159(1) EPC for entering the European phase of the International Application expired on 23 July 2008, i.e. one day after the filing date of the Divisional Application. Since no steps as required under Article 22 PCT in conjunction with Rule 159(1) EPC were taken, the European Patent Office issued a notification under Rule 160(1) EPC that the application was deemed to be withdrawn. The applicant did not challenge the finding.
- IV. As regards the Divisional Application, the Receiving Section issued a communication noting a loss of rights pursuant to Rule 112(1) EPC on 15 October 2008 informing the appellant that the application would not be dealt with as a divisional application because the International Application could not be recognised as a

pending European patent application, since it had not validly entered into the European phase.

V. In response to the appellant's letter dated 29 October 2008 requesting an appealable decision, the Receiving Section informed the appellant by a communication pursuant to Article 113(1) EPC that as regards the International Application the minimum requirements as laid down in Article 22(1) PCT to enter the European phase had not been fulfilled within the prescribed time frame and that, therefore, the International Application was not considered a pending European patent application for the purposes of Article 76 EPC. The appellant did not accept this view and maintained his request for an appealable decision.

VI. On 17 February 2009 the Receiving Section issued the decision under appeal, deciding that the application would not be treated as a European divisional application 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 argued as follows:

Under the provisions of Article 76 EPC in conjunction with Rule 36(1) EPC, the applicant may file a divisional application in respect of any pending earlier European patent application. From this it is to be concluded that the earlier application must be a "European patent application" which is pending before the European Patent Office. For processing an international application and for it to maintain effect under Article 11(3) PCT before the European Patent

Office, Article 153(5) EPC stipulates that an international application shall be treated as a European patent application if amongst other things the conditions laid down in Rule 159 EPC have been fulfilled. Rule 159(1) EPC lays down the acts to be performed for the entering of an international application under Article 153 EPC into the European phase within a time limit of 31 months from the date of filing or, if one has been claimed, from the date of priority. In the present case the necessary acts to enter into the European phase could have been performed at any time before the expiry of the 31-month time limit on 23 July 2008. As none of the acts laid down in Article 22(1) PCT and Rule 159(1) EPC for entry into the European phase had been taken in respect of the International Application when the Divisional Application was filed, the International Application could not be regarded as a pending European patent application as required under Rule 36(1) EPC, which is a pre-condition for allowing a divisional application to be validly filed.

- VII. The appellant filed an appeal against this decision of the Receiving Section on 31 March 2009 and paid the required appeal fee on the same day.

Appellant's statement setting out the grounds of appeal filed with letter of 26 June 2009 can be summarised as follows:

The International Application has to be regarded as an earlier pending European patent application pursuant to Rule 36 EPC. It was at least pending between the international filing date and the last day when the

time limit defined in Rule 159(1) EPC expired because, according to Article 11(3) PCT, an international patent application shall have the effect of a regular national application in each designated State as of the international filing date. As the time limit pursuant to Rule 159(1) EPC expired in the present case on 23 July 2008, the Divisional Application was validly filed on 22 July 2008.

The Receiving Section's reasoning, that the earlier application must be pending before the European Patent Office, has no legal basis in Rule 36 EPC and cannot be used to support the decision. The impugned decision appears to contend that Article 153(5) EPC means that the earlier application can only be treated as a pending European application if the requirements of Rule 159(1) EPC are met within the specified time limit. Such a view is contrary to Article 11(3) PCT and it is to be noted that in the event of conflict between the provisions of the PCT and EPC, then, according to Article 150(2) EPC, the provisions of the PCT shall prevail.

The effect of Article 11(3) PCT is a wide one. It provides for only one exception, namely that stated in Article 64(4) PCT relating to the effect of prior art. This is a clear indication that for all other purposes a PCT filing is equivalent to a European filing, and as such can properly form the basis for a European divisional application. According to Article 24(1)(iii) PCT, the effect of an international application provided for in Article 11(3) EPC ceases, with the same consequences as with the withdrawal of any national application, if the applicant fails to perform the acts

referred to in Article 22 PCT within the relevant time limit. In the present case, this time limit expired after the date on which the Divisional Application had been filed.

Non-compliance with the requirements of Article 22 PCT and Rule 159 EPC does not have any retroactive effect. Rather, an international application is deemed to be withdrawn only after the last day on which the acts could have been carried out. It is established case law that the fate of a divisional application is independent of that of its parent application. As such, the deemed withdrawal of the International Application after the date on which the Divisional Application was filed is not relevant to the validity of the filing of the Divisional Application (see G 4/98, OJ EPO 2001, 131).

VIII. In response to the Board's communication dated 2 June 2010 and also during the oral proceedings held on 1 September 2010 the appellant reinforced its arguments by the following submissions:

The Divisional Application fulfilled the necessary requirements of Article 11(3) PCT and was accordingly accorded an international filing date. It is, therefore, to be treated as having the effect of a regular national application, as is also stipulated by Article 153(2) EPC. The status of a PCT application which designates EP and has been accorded an international date of filing is to be treated as equivalent to a regular European application. The legal status of an international application does not change upon entering the European phase. According to decision

J 17/99 (points 3 and 5 of the Reasons) the effect of Article 11(3) PCT does not cease before the international application is deemed to be withdrawn. Until that point in time the EPO has jurisdiction and the international application is pending before the European Patent Office without the need for entering the European phase.

Article 23 PCT ("Delaying of National Procedure") does not govern the status of treatment of a PCT application upon filing or upon failure to request regional processing. It merely precludes a national office from processing or examining the application before a certain time period. In other words, although the respective international application is pending before the national/regional office, that office is precluded from examining the application. Were it not otherwise enacted, one potential consequence of the equivalence between a Euro-PCT and a regular European application would be for the Euro-PCT application to have a prior art effect under Article 54(3) EPC. The fact that Article 64(4) PCT specifically permits Contracting States to make an exception from such prior art effect shows that if the reservation were not provided for, the prior art effect would follow, and thus that the Euro-PCT application otherwise has the procedural status equal to a regular European application as from the international filing date.

According to the decision of the Enlarged Board of Appeal G 1/05 (OJ EPO 2008, 271, points 12.2, 13.1 and 13.3 of the Reasons), no further restrictive conditions other than those stipulated for by Rule 25 or Article 76(1) EPC 1973 can be imposed by the boards of

appeal or other departments of first instance of the European Patent Office to restrict an applicant's rights to file divisional applications. In particular, a condition cannot be imposed that the applicant should perform the necessary acts to enter into the European phase pursuant to Article 22 PCT and Rule 159(1) EPC before the divisional application is filed during the required 31 month time limit.

Even if the Board were to construe the term "pending earlier European application" in Rule 36 EPC in such a way that, as a minimum requirement, a request for entering the European phase pursuant to Article 23(2) PCT must have been filed, the Divisional Application can be construed as such an implicit request.

The purposes of the PCT also require the Divisional Application to be treated as having been validly filed for reasons of cost effectiveness and having regard to the procedural possibilities in the United Kingdom and the United States of America. In the former case, an application can enter into the national phase on the basis of unsearched subject matter in the PCT application on payment of a further search fee. In the latter case, the applicant can do this by filing a continuation-in-part application based on the PCT application (i.e., without entering the national phase for the parent). Upon entry into the European phase, a comparable procedural situation to that in the UK as described above existed under the EPC before the EPC 2000 entered into force. As regards the economic purposes of the PCT, it is unreasonable that the new provisions of the Implementing Regulations to the EPC should force the appellant to enter the regional phase

for the sole purpose of enabling the filing of a divisional application on the unsearched invention.

It is contrary to the principle of non-discrimination that upon entry into the regional phase some applicants are, while others are not, allowed to proceed with unsearched subject-matter of the international application, depending on whether or not the European Patent Office has drawn up the International Search Report.

If the Board were minded not to find that the Divisional Application has been validly filed, the issue should be referred to the Enlarged Board of Appeal on the basis that a point of law of fundamental importance is involved, for the following reasons:

The possibility of a cost-effective method of pursuing inventions which have not been searched in the international phase is of general interest to European applicants. This is all the more so since international applicants (and those from certain states in Europe) can achieve protection for inventions which are unsearched in the international phase without having to file a parent and a divisional application.

The meaning of "pending earlier European patent application" under Rule 36 EPC is the subject of a reference to the Enlarged Board of Appeal in reference G 1/09. Although the referring decision J 2/08 addresses a slightly different legal point, the decision concerns the same issues as in the present case, namely whether the term "pending" under Rule 36 EPC refers to pending substantive rights (point 13 of

the Reasons) or whether it is sufficient that the application exists as such (point 30 of the Reasons) or whether the term defines a condition of a substantive nature (point 18 of the Reasons) or whether the term "pending earlier ... application" can be equated automatically to "pending proceedings" (point 40 of the Reasons). These issues are closely linked to the points of law to be answered in the present case.

IX. The appellant requested as its main request that:

(1) The decision under appeal be set aside and the Receiving Section be ordered to treat the Divisional Application as a validly filed divisional application;

and as an auxiliary request that:

(2) The following point of law be referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC:

Where a European application arises from a PCT application, and before the expiry of the time limits under Rule 159 EPC for the application, can the application be an "earlier European patent application" within the meaning of Article 76(1) EPC and Rule 36 EPC?

Reasons for the Decision

Applicable provisions

1. The Board agrees with the appellant and the Receiving Section that the provisions of EPC 2000 and its

Implementing Regulations apply to the Divisional Application and to the International Application. In this respect the Board refers to Article 7(1), first sentence and Article 8 of the Revision Act of 29 November 2000 (OJ EPO 2001, Special Edition No 4, 50), Article 1(5), first sentence of the Decision of the Administrative Council of 28 June 2001 and Article 2 of the Decision of the Administrative Council of 7 December 2006 amending the Implementing Regulations to the European Patent Convention 2000 (OJ EPO 2007, Special Edition No 1, 89).

The International Application is also subject to the provisions of the PCT and its Regulations.

The different opinions with respect to Rule 36 EPC

2. Rule 36(1) EPC as in force when the Divisional Application was filed reads as follows:

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

In the present case, the main question to be answered is how the term "any pending earlier European patent application" is to be understood. In the appealed decision a different conclusion was reached to that argued for by the appellant.

3. The appellant submitted that the International Application was at least pending between the international filing date and the last day when the time limit defined in Rule 159(1) EPC expired because,

according to Article 11(3) PCT, an international patent application shall have the effect of a regular national application in each designated State as of the international filing date. As the time limit pursuant to Rule 159(1) EPC expired in the present case on 23 July 2008, the Divisional Application was validly filed on 22 July 2008.

4. The reasons in the appealed decision are mainly based on the grounds that:

(a) the term "pending earlier European patent application" in Rule 36(1) EPC includes the requirement that the parent application must be pending before the European Patent Office; and

(b) an international application which has not fulfilled the requirements of Rule 159(1) EPC for entering the regional phase is not pending before the European Patent Office and therefore cannot be considered a pending earlier European patent application pursuant to Rule 36(1) EPC.

The meaning of the term "pending earlier European application" in Rule 36(1) EPC

5. The Board notes that the term "pending" in Rule 36(1) EPC is defined neither in the higher-ranking Article 76 EPC (concerning the filing of divisional applications) nor in any other provision of the European Patent Convention. The established case law also does not provide a definition for the term "pending earlier European patent application" as a general dogmatic concept but only by reference to decisions on specific

procedural situations concerning whether or not a particular application was pending. In this regard the Board points out that this wording of Rule 36(1) EPC is identical to the wording of the former Rule 25(1) EPC 1973 and, therefore, the corresponding case law can be taken into account.

6. The present Board agrees with the statement of the Legal Board of Appeal in decision J 18/04 that the term "*pending earlier European patent application*" in Rule 25 EPC 1973 did not establish a time limit having a point in time at which the pending status of an application begins and ends, but rather stipulates a substantive requirement (J 18/04, OJ EPO 2006, 560, points 7 and 8 of the Reasons). However, even though the term stipulates a substantive requirement and not a time limit, the requirement is still not thereby exhaustively defined and its meaning must be construed in the context of other relevant procedural provisions and in accordance with general accepted rules of interpretation and, if appropriate, in the light of the higher ranking provisions of the Patent Cooperation Treaty (PCT). This is because in the case of conflict, the provisions of the PCT and its Regulations prevail over the provisions of the EPC (Article 150(2), third sentence EPC).

The literal interpretation of the term "pending application" indicates a procedure that has been initiated before the competent authority and is not yet completed. Thus, as a minimum requirement, proceedings must have been initiated before the competent authority. It appears to be obvious and needs no further explanation that proceedings are not initiated when an

application is filed with an incompetent authority.

The present Board shares the opinion of the Receiving Section that the term "*pending earlier European patent application*" under Rule 36(1) EPC includes the requirement that the application must be pending before the European Patent Office acting as patent granting-authority according to the EPC. This can be deduced from the word "European" and the context of the EPC in which Rule 36 EPC is embedded.

A European patent application is directed towards the grant of a European Patent on the basis of the proceedings according to the Provisions of the EPC (cf. Art. 2(1) EPC). Thus, in principle, only applications pending before the European Patent Office can be European patent applications.

The possibility of filing a European patent application not only with the European Patent Office but also with other competent authorities as stipulated by Article 75(1) (a) EPC does not change the legal fact that an application filed with one of those authorities is the subject of proceedings according to the EPC before the European Patent Office.

7. From the foregoing it can be concluded that an international application filed according to the provisions of the PCT is pending before the competent PCT authorities (Receiving Office, International Searching Authority, International Preliminary Examining Authority), one of which may be the European Patent Office. However, the European Patent Office does not act as European patent granting-authority during

the international phase and at this stage international applications designating EP are not regular European patent applications in accordance with Rule 36(1) EPC (which refers to "earlier European patent application[s]") and are, therefore, not pending before the European Patent Office but rather before an International Authority according to the PCT.

This can also be deduced from Article 11(3) PCT which reads as follows:

"Subject to Article 64(4), any international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) and accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State."

If an international application (designating EP) were *ipso facto* a regular European patent application the legal fiction stipulated for by Article 11(3) PCT would not be necessary. Hence, in accordance with Article 11(3) PCT an international application designating EP is not as such a European patent application but only has the effect of such by virtue of the legal fiction contained in Article 11(3) PCT.

Scope of the legal fiction in Article 11(3) PCT in the context of other provisions of the PCT

8. Therefore, it remains to be decided what legal consequences must be drawn from the stipulated legal

fiction according to Article 11(3) PCT that an international application shall have the effect of a regular national application as of the international filing date.

It must be noted that the wording of Article 11(3) PCT does not refer to the pendency of a national application but only to the legal effect resulting from a national application, e.g., the substantive rights to a specific priority, filing date or designation. This is the reason why this provision needs to contain the reference to Article 64(4) PCT, this reference acting as a restriction on the equating, for prior art purposes, of the priority date claimed under the Paris Convention with the actual filing date of the application.

The appellant takes the view that the legal fiction of Article 11(3) PCT includes the procedural consequence that an international application is to be regarded as pending before the European Patent Office as from the international filing date because Article 11(3) PCT contains no procedural restriction other than the reference to Article 64(4) PCT.

In the Board's view, this interpretation is incorrect and would contradict other provisions of the PCT, in particular Article 23(1) PCT, which stipulates for a delay of national procedure, and is not in line with the common understanding of the procedure under the PCT, as it will be explained in the following paragraphs.

9. The Board does not dispute that a Euro-PCT application remains the same application through both the

international and European phases. However, the application is subjected to different procedures under the PCT and under the EPC. It is the very essence of the unitary filing system drawn up by the PCT that in the international phase the international application is subject to the procedural rules of the PCT and not to those of the national laws (possibly divergent from those of the PCT) which may become applicable once the international application has entered the national or regional phase before the competent national or regional office.

This is also brought out by Article 150(2) EPC, where it is stated:

"International applications filed under the PCT may be the subject of proceedings before the European Patent Office".

The grant-proceedings before the European Patent Office concerning a Euro-PCT application can only be initiated either by a request for abandoning the PCT-route under Article 23(2) PCT or by performing the procedural acts stipulated by Article 22 PCT. In the present case no such request was filed nor was the required national fee (filing fee) according to Article 22(1) PCT in conjunction with Rule 159(1)(c) EPC paid by the appellant. In contrast, in case J 17/99 (points 3 and 5 of the Reasons) referred to by the appellant a request for early entry into the regional phase before the European Patent Office was filed and the necessary fees were paid (cf. above, facts and submissions, point VI and the last sentence of point X). Thus, in that case proceedings before the European Patent Office as

European patent granting-authority were validly initiated by this request and, therefore, the legal situation was different to the present application and cannot be taken as a basis for deciding the present case.

10. The present Board has scrutinised the *travaux préparatoires* concerning the EPC and the amendments to the different versions of Rule 25(1) EPC 1973 and Rule 36(1) EPC respectively since the EPC entered into force. It has, however, not found any indication that the European Patent Office or the respective law maker ever considered an international application which had not entered the European phase to be an earlier application pursuant to Rule 36(1) EPC or Rule 25(1) EPC 1973 respectively.

Accordingly, the EPO Guidelines for Examination (A-IV, 1.1.1.1, version in force before April 2010) simply informed the public that:

"A European patent application may be divided when it is pending. In order to divide a European application, the applicant files one or more European divisional applications. It is irrelevant what kind of application the European patent application which is divided, i.e. the parent application, is. The parent application could thus itself be an earlier divisional application. In the case of the parent application being a Euro-PCT application, a divisional application can only be filed once the Euro-PCT application is pending before the EPO acting as a designated or elected Office, i.e. the Euro-PCT application must have entered the European phase." (Underlining by the Board).

From this it appears that the European Patent Office has always considered an international patent application that has not yet entered the European phase not to be a pending European patent application in the sense of Rule 36(1) EPC.

11. It is also the case that the Contracting States of the PCT discussed over many years the introduction of provisions into the PCT which would allow the filing of a divisional application during the international phase of an international patent application (see, e.g., WIPO, Patent Cooperation Treaty (PCT), Working Group on Reform of the Patent Cooperation Treaty, fifth Session, Geneva, November 17 to 21, 2003, Meeting Code PCT/R/WG/5/6, on internet page http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=18422).

These discussions concerned the division of an international application into two different international applications under the PCT during the international phase. It is to be noted that this procedural situation is to be distinguished from the question whether or not the filing of a divisional application under the national patent law is possible when the parent application is still in the international phase.

However, it is to be pointed out that the working group justified the proposed amendment to the PCT in point 11 of this document on the basis that:

"Obviously, the introduction of a procedure allowing the applicant to file an international application as a divisional application of an initial international application ("divisional application") would greatly simplify, from the applicant's perspective, the processing of the international application where the International Searching Authority or the International Preliminary Examining Authority makes a finding of lack of unity of invention, replacing the need to individually file, after national phase entry, divisional (national) applications with each designated or elected Office concerned." (Underlining by the Board).

Apparently, the possibility of filing a national (regional) divisional application during the international phase of an international application was never considered. The same line of reasoning is repeated in point 33 of this document:

"While that result could be achieved by proceeding into the national phase with the internally divided initial international application, to be followed by its division separately during the procedure before each national Office, it would be simpler to enable the initial international application to proceed into the national phase, from the outset, as separate divisional applications." (Underlining by the Board).

Both cited passages indicate that the working group took the view that as a matter of law a national (regional) divisional application relating to an initial international application can only be filed when the international application is the subject of

proceedings before the national (regional) Office. This view includes the perception that an international application is not pending before the national (regional) Office before its entry into the national (regional) phase and that the pendency before the national Office is an important requirement for filing a national divisional application.

12. The European Patent Office's view, namely that as a matter of law an international application which has not entered the European phase is not pending before the European Patent Office, was originally supported by the wording of Article 150(3) EPC 1973, which stated that:

"An international application, for which the European Patent Office acts as designated Office or elected Office, shall be deemed to be a European patent application."

It is self-explanatory that the European Patent Office could only act as designated or elected Office after an international application had entered the European phase. However, the wording of Article 150(3) EPC 1973 was amended by the new Article 153(2) EPC implemented by the Revision 2000 of the EPC, and now reads as follows:

"An international application for which the European Patent Office is a designated or elected Office, and which has been accorded an international date of filing, shall be equivalent to a regular European application (Euro-PCT application)."

The latter wording appears to correspond better to the wording in Article 11(3) PCT but, as with that provision, does not contain any reference to the pendency of a Euro-PCT application as a European patent application. The new wording only reflects the intention of the PCT that an international patent application shall be treated as equal to a national or regional application unless specific provisions of the PCT require or allow a different treatment. The PCT's legislative intent of equal treatment can furthermore be deduced for example from Article 48(2)(a) PCT, which stipulates that:

"Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit."

However, this very same article also reflects the existence of a potentially different procedural treatment of an international application in its international phase as compared with a national application, because the benefit of a national provision excusing "any delay in meeting any time limit" cannot be claimed during the international phase but only after the international application has entered the national (regional) phase.

Therefore, Article 48(2) PCT stipulates a procedural restriction not mentioned in Article 11(3) PCT. The appellant's contention that the legal fiction in Article 11(3) excludes the application of procedural restrictions according to other PCT provisions is, therefore, incorrect.

13. The wording in Article 11(3) PCT "...shall have effect of a regular national application in each designated State as of the international filing date..." is a legal fiction which does not lead to the result that the proceedings under the PCT become national ones. On the contrary, the proceedings in the international phase under the PCT are special ones and are governed by the provisions of the PCT. Proceedings under national law are expressly excluded during the international phase of an international application. This can be deduced from Article 23(1) PCT (the article being headed "Delaying of National Procedure"), wherein it is stated that:

"No designated Office shall process or examine the international application prior to the expiration of the applicable time limit under Article 22."

Apparently, Article 23(1) PCT restricts the procedural effect of an international application in the international phase, as regards the applicability of national law, and thereby also limits the legal effect of the international application stipulated for by Article 11(3) PCT if this provision were to be interpreted in the way claimed by the appellant.

Insofar as paragraph 2 of Article 23 PCT allows any designated Office to process or examine an international application at any time, it must be noted that the required express request of the applicant to proceed in this way has the effect that the international phase, and thus the proceedings under the PCT, are terminated. As already stated under point 9 above, in the present case such an express request

under Article 23(2) PCT had not been filed and cannot be regarded as implicit from the mere filing of the Divisional Application, as the appellant argued during the oral proceedings. Such an interpretation does not comply with the requirement of an express request according to Article 23(2) PCT and for the European Patent Office it would not have been clear that the appellant intended the application to enter the regional phase. Thus, in the present case, the filing of the divisional application cannot be construed as a request under Article 23(2) PCT to process or examine the international application. As in the present case this requirement of an express request was not met it does not have to be decided what further acts under Rule 159 EPC have to be performed to initiate an earlier entry in the regional phase (cf. with respect to possible different views: Singer/Stauder (Hesper), EPC, 5th ed., Art. 153 notes 78 to 80).

The wording of Article 150(2) EPC also reflects the separate nature of international and regional proceedings, where it is stated:

"International applications filed under the PCT may be the subject of proceedings before the European Patent Office".

In the Board's view the distinction between pending proceedings during the international phase and those during the regional phase of an international patent application is therefore justified by the EPC as well as the PCT. As regards an international patent application designating EP, proceedings before the PCT authorities are initiated as from the filing date and

proceedings before the European Patent Office only as from the day on which the requirements for entering the regional phase prescribed by Article 22(1) PCT have been fulfilled.

14. The reasoning of the Receiving Section that the term "pending earlier European patent application" refers to proceedings pending before the European Patent Office as the competent authority to decide on the earlier application under the EPC is, therefore, absolutely correct. The procedural term "pendency" in the sense of Rule 36 EPC implies that the European Patent Office has become competent to decide on the request for grant.

15. A further restriction for filing a divisional application relating to an international application under Rule 36 EPC derives from Article 23(1) PCT. As already explained in point 13 above, according to Article 23(1) PCT the European Patent Office has no competence during the international phase of an international application to proceed and examine an application under the provisions of the EPC with respect to the patentability of the subject matter claimed by the international application or with respect to procedural requirements. The European Patent Office only becomes competent as European patent granting-authority when the requirements for the entry into the European phase according to Article 22(1) PCT are fulfilled or an express request for entry into the European phase pursuant to Article 22(2) PCT has terminated the international phase of an international application. It must be noted that the time limit of 30 months according to Article 22(1) PCT is extended to 31 months by virtue of Rule 159(1) EPC. The prohibition on

proceeding and examining the Euro-PCT application during the international phase has a direct procedural effect as regards the required examination of the related divisional application filed with the European Patent Office, as explained in the following paragraph.

16. The filing of a divisional application under Rule 36(1) EPC requires that the Receiving Section of the European Patent Office examines, immediately after the filing, whether or not a filing date can be accorded to the divisional application. This examination includes a decision on the procedural status of the earlier European application. If the earlier application is an international one which is still in the international phase, the Receiving Section cannot take such a (implicit) decision on the international application because Article 23(1) PCT forbids a designated Office from examining the international application during this phase. Therefore, it appears from the PCT that Rule 36(1) EPC must be construed in the sense that the term "pending earlier European patent application" refers to an application pending before the European Patent Office as competent EPC authority. This interpretation follows from the term "European" and is consistent with the legal fiction in Article 11(3) PCT being restricted by Article 23(1) PCT.

Summing up the above arguments and conclusions, the present Board confirms the statement of the Receiving Section that, on the basis of the provisions of the PCT and EPC, a Euro-PCT-application not having entered the European phase is not a pending earlier European application in the sense of Rule 36(1) PCT.

Discussion of appellant's further arguments relating to the term "earlier pending European application" and its right to file a divisional application

17. The appellant's conclusion that the European Patent Office's communication, which allocated a European application number to its International Application designating EP, makes it clear that the earlier application was a pending European application is incorrect because the allocation of such an application number is simply an administrative act to make it easier for the European Patent Office to handle any incoming documents. Such a purely administrative act cannot be taken as a basis for interpretation of the term "pending earlier European patent application" in Rule 36(1) EPC.

18. Furthermore, it is true that the European Patent Office issued a communication in relation to the earlier application indicating:

"The European patent application cited above is deemed to be withdrawn".

However, even if the use of the term "European patent application" in that statement corresponds to the wording in Rule 160(1) EPC, the statement that the European patent application was deemed to be withdrawn was not a constitutive procedural act but only a declaratory one with respect to the non-pendency of the proceedings before the European Patent Office. Such a statement did not initiate grant proceedings before the European Patent Office as is required by Rule 36(1) EPC for the International Application but made it clear

that the International Application was not being proceeded with under the EPC and only informed the applicant that the International Application had not become pending before the European Patent Office to be further prosecuted as a European patent application.

19. Furthermore, the Board points out that the PCT does not provide a right to file a divisional application or to proceed with unsearched matter during the regional phase.

In addition, the appellant's reference to American and British patent law and procedure is not an appropriate basis for interpreting Rule 36(1) EPC.

The appellant's submissions concerning cost effectiveness and equal treatment relate to the International Application as such and are arguments which at best could be used to question the restriction of the International Application to subject matter which was dealt with in the international search report.

Consequently, if the requirements according to Rule 36 EPC are not fulfilled, a right to file a divisional application cannot be based on arguments of cost effectiveness and non-discrimination or be justified by reference to the procedural possibilities which are provided by national foreign law.

Referral to the Enlarged Board of Appeal

20. As regards the appellant's request for referral of a point of law of fundamental importance, the Board has explained in the above paragraphs how the answer to

this question can be deduced directly and unequivocally from the provisions of the EPC and PCT. The necessity to interpret Rule 36(1) EPC in the light of the provisions of the PCT does not limit the Board's competence to decide itself on this question and does not mean that this question requires a decision of the Enlarged Board of Appeal. Therefore, the situation in the present case does not correspond to the situation which led to the reference of a legal question to the Enlarged Board of Appeal in case G 1/09. Furthermore, the Board does not know of any decisions which run contrary to the present Board's conclusions and which would necessitate a ruling by the Enlarged Board of Appeal with a view to ensuring uniform application of the law (Article 112(1) EPC).

21. In summary, neither the request for treating the Divisional Application as a validly filed divisional application nor the request for referral of a point of law to the Enlarged Board of Appeal is allowable.

Order

For these reasons it is decided that:

1. The request to refer a point of law to the Enlarged Board of Appeal is refused.

2. The appeal is dismissed.

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: J 0018/09 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
correcting errors in the decision
of the Legal Board of Appeal 3.1.01
of 14 April 2011

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 17 February 2009.

Composition of the Board:

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

Pursuant to Rule 140 EPC, the decision given on 1 September 2010 in case J 0018/09 - 3.1.01 is hereby corrected as follows:

In Facts and Submissions, point VII:

The sentence "...the effect of an international application provided for in Article 11(3) EPC ceases..."

is corrected to:

".....the effect of an international application provided for in Article 11(3) **PCT** ceases..."

In Reasons, point 6, last paragraph:

The sentence "...as stipulated by Article 75(1) (a) EPC..."

is corrected to:

"...as stipulated by Article 75(1) **(b)** EPC..."

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel