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**Datasheet for the decision  
of 15 April 2011**

**Case Number:** J 0024/10 - 3.1.01

**Application Number:** ...

**Publication Number:** -

**IPC:** ...

**Language of the proceedings:** EN

**Title of invention:**

XXX

**Applicant:**

N.N.

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 64, 67(1), 97(3), 112(1)

EPC R. 36

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

EPC Art. 97(4)

EPC R. 25

**Keyword:**

"Pending earlier European patent application (no)"

"Pending status of the European patent application ceases on the day before the publication of the mention of its grant in the European Patent Bulletin"

**Decisions cited:**

G 0001/09, J 0007/04, J 0010/01, J 0021/96, T 0517/97

**Catchword:**

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Case Number: J 0024/10 - 3.1.01

**D E C I S I O N**  
of the Legal Board of Appeal 3.1.01  
of 15 April 2011

**Appellant:** N.N.

**Representative:** N.N.

**Decision under appeal:** Decision of the Receiving Section of the  
European Patent Office of 14 April 2010.

**Composition of the Board:**

**Chairman:** B. Günzel  
**Members:** S. Hoffmann  
F. Blumer

## Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Receiving Section posted on 14 April 2010, ruling that the present application should not be processed as a divisional application.
- II. On 24 September 2008 at 11:49, the present European patent application No. YYYYYYYY.Y (the "Divisional Application") was filed as a divisional application to the earlier European patent application No. XX XXX XXX.X (the "Parent Application").
- III. Based on the Parent Application, the European patent No. 0 000 000 was granted. The mention of the grant of the European patent was published in the European Patent Bulletin ../.. on dd.mm.yy.
- IV. In a letter filed together with the Divisional Application, the applicant (appellant) referred to decisions J 21/96 and J 10/01 in support of its assertion that it was not the date of the publication of the mention of the grant in the European Patent Bulletin which was decisive in determining when the earlier application ceased to be pending but rather the event of publication itself. As the publication of the mention of the grant of the European patent No. 0 000 000 had taken place only on dd.mm.yy at 14:00, it was still possible to file the Divisional Application on dd.mm.yy at 11:49.
- V. As regards the Divisional Application, on 20 October 2008 the Receiving Section issued a communication noting a loss of rights pursuant to Rule 112(1) EPC and

informing the appellant that the application would not be dealt with as a divisional application, because the earlier application had been pending only up to (but not including) the date on which the European Patent Bulletin mentioned the grant of the European patent. Reference was made to the Guidelines for Examination in the EPO, A-IV, 1.1.1 and the Notice from the EPO dated 9 January 2002 concerning amendment of Rules 25(1), 29(2) and 51 EPC 1973 (OJ 2/2002, 112).

VI. In response to this communication the appellant requested a decision by letter dated 28 November 2008. After receiving a communication pursuant to Article 113 EPC dated 10 July 2009, the appellant maintained its request for a decision, by letter of 14 August 2009. No further comments on the reasons given by the Receiving Section were added to appellant's requests.

VII. On 14 April 2010 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 argued essentially as follows:

Under Rule 36(1) EPC, the applicant could file a divisional application in respect of any pending earlier European patent application. Referring to decisions J 21/96, J 10/01, J 24/03 and J 18/04, the Receiving Section agreed with the appellant that Rule 36(1) EPC did not define a time limit but identified a point in the grant procedure after which a

divisional application could no longer be filed. The definition of this point in time, as from which an application was no longer pending, was regarded as the decisive question and answered in accordance with the Notice from the EPO dated 9 January 2002 concerning amendment of Rules 25(1), 29(2) and 51 EPC 1973 (OJ 2/2002, 112). According to that definition, an application was pending up to but not including the date on which that the European Patent Bulletin mentioned the grant of the European patent. Consequently, in order to fulfil the provisions of Rule 36(1) EPC, the present Divisional Application should have been filed before - not on - the day of the publication of the mention of the grant of the European patent.

VIII. On 21 April 2010, the appellant filed an appeal against this decision of the Receiving Section and paid the appeal fee.

The appellant's statement setting out the grounds of appeal, filed with letter of 16 July 2010, can be summarised as follows:

The European Patent Convention allowed the filing of a divisional application relating to "any pending earlier European patent application" in Rule 36(1) EPC, which literally corresponded to Rule 25(1) EPC 1973. The Convention did not define any further time limit, or any time frame which could be considered as being excluded from that period. It was the legislator's intention when drafting Rule 25(1) EPC 1973 to extend the notion of "pending" to include the period between the decision to grant and the publication of the

mention of grant. The *travaux préparatoires* for this provision (CA/127/01) did not mention excluding the day on which the publication of the mention of grant took place from the period for filing a divisional application. Furthermore, several decisions of the Boards of Appeal, in particular J 21/96 and J 10/01, confirmed that Rule 36(1) EPC (or Rule 25(1) EPC 1973) referred to a very specific event and did not set a time limit. According to the legislator's intention, that event could only be the actual publication of the mention of grant of the European patent in the European Patent Bulletin. In the present case, this publication took place on dd.mm.yy at 14:00 hrs, i.e. after the filing of the present application at 11:49 hrs. The appellant referred to decision T 517/97, stating that the chronological order in which procedural events occurred was relevant for the question how long an application was pending. Setting an arbitrary shorter time limit for filing a divisional application, as done by the EPO's Notice of 9 January 2002, has no legal basis in the law and even contravened the law. Furthermore, it was not clear why this Notice made a distinction between grant of a European patent and rejection of a European patent application, in particular as regards the day on which the respective event took place. Therefore, because the Divisional Application had been filed before any event had taken place which could have changed the status of the Parent Application from pending application to granted patent, it has to be treated as a divisional.

IX. The Legal Board summoned the appellant to oral proceedings for 15 April 2010 and referred in an attached communication to decisions G 1/09 and J 7/04

of the Enlarged Board of Appeal and the Legal Board respectively.

- X. With letter dated 13 April 2011 the appellant informed the Board that it would not be attending oral proceedings and suggested that if the Board was in any doubt about the interpretation of Article 97(3) EPC it should refer a question to the Enlarged Board of Appeal.
- XI. Oral proceedings were held on 15 April 2011 in absence of the appellant.

During the oral proceedings the Board noted that the appellant:

- requested in writing that the decision under appeal be set aside and that the patent application be treated as a validly subsisting European patent application,
- and suggested in writing that, if the Board had the slightest doubt as to when a decision to grant a European patent took effect, i.e. whether a day was the smallest unit of time to be considered or whether Article 97(3) EPC only required it to be at some point of time during the day of publication, and if the Board of Appeal did not consider the question sufficiently answered by the *obiter dictum* given in decision G 1/09 of the Enlarged Board of Appeal of 27 September 2010, this question as to the pendency of applications for which a decision to grant a European patent had been issued should be referred to the Enlarged Board of Appeal.

## Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 99 EPC and is therefore admissible.

The appellant's suggestion that the Board refer a question to the Enlarged Board of Appeal if the Board is in doubt which event ends the pendency of an application for which a European patent is granted is not to be treated as an inadmissibly conditional request but as a mere suggestion that the Board might exercise of its own motion its discretion to refer a point of law of fundamental importance to the Enlarged Board under Article 112(1)(a) EPC. Therefore, the Board holds that the appellant's request that the Divisional Application be treated as a validly subsisting European patent application is its sole request.

2. The main issue in the present case is whether or not the Parent Application was still pending within the meaning of Rule 36 EPC on the date on which the Divisional Application was filed. More precisely, did the publication of the mention of the grant of the patent in the European Patent Bulletin on dd.mm.yy exclude the pendency of the Parent Application for this entire day or only as from 14:00, when the European Patent Bulletin ../.. became publicly available via the internet?
3. The Board finds that this question has already been answered by decision G 1/09 of the Enlarged Board of Appeal dated 27 September 2010.



According to its *obiter dictum* under point 4.3.2 of the Reasons, the Enlarged Board of Appeal held that in the procedural situation when a patent is granted "*the pending status of the European patent application normally ceases on the day before the mention of its grant is published since from that point in time substantive rights under the EPC are no longer derived from the patent application, but now derive from the granted patent*".

Although this statement was given as an *obiter dictum* the procedural situation underlying the present case was fully considered by the Enlarged Board of Appeal and the Board has not the slightest doubt as to the correctness of this statement and the applicability of this line of reasoning to the present case.

Consequently, it must be stated that the pendency of the Parent Application ended with the day before the mention of the grant of the European patent in the European Patent Bulletin.

4. It must be added that the above statement of the Enlarged Board of Appeal relates only to the wording of Rule 25(1) EPC 1973 but it is clear from the further deliberations in the reasons for this decision that the same interpretation also applies to the wording of Rule 36(1) EPC applicable to the present case.
5. As a further reason why the applicant cannot file a divisional application on the date on which the mention of the grant of a patent for the parent application is published in the European Patent Bulletin, it was already pointed out in the reasons of decision J 7/04 of the Legal Board that:

*"With the mention of the grant of the earlier patent, the applicant and the EPO no longer exercise any influence over the patent, which becomes autonomous and has to be treated as though it had been conferred by a national authority in accordance with Article 64(1) EPC. On the date of the publication of the mention of the grant of the earlier application the patent is deemed to be outside the EPO's jurisdiction, and a divisional application could not be filed on the same date because the application is definitively removed from the EPO's sphere."*

The other decisions cited by the appellant do not deal with the procedural situation after grant of the European patent and its publication and are, therefore, not appropriate to answer the question as to the pendency of an application in the present case.

6. The cited decisions J 7/04 and G 1/09 are based on the wording of former Article 97(4) EPC 1973 (now Article 97(3) EPC). According to this wording the smallest time unit is the date (German version: *der Tag*; French version: *la date*) as such and not an hour or the chronological order of events on a specific date. Furthermore, Article 64(1) EPC stipulates that the date of the publication and not the event of publication as such is the precondition for conferring the protection provided for by that Article.

Apparently, the lawmaker's intention was to implement an incontestable and foreseeable point in time at which jurisdiction passes to the national instances and at which the patent confers on its proprietor the rights

defined in Article 64(1) EPC in relation to third parties. In order to provide legal certainty for the applicant, the decision to grant a patent regularly contains the scheduled date of the mention of the grant of the European patent so that the applicant is informed beforehand of this date.

7. Summing up the foregoing considerations, the Board comes to the conclusion that in the present case the Parent Application was no longer pending before the European Patent Office on dd.mm.yy, the date on which the publication of the mention of the grant of the patent took place. Therefore, the requirement of a pending (parent) application pursuant to Rule 36 EPC was not fulfilled at the filing date of the present application.
  
8. As regards the appellant's suggestion for referral of a point of law of fundamental importance to the Enlarged Board of Appeal, 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 from the *obiter dictum* in case G 1/09. Furthermore, as none of the decisions cited by the appellant runs contrary to the present Board's conclusions, in which case a further ruling by the Enlarged Board of Appeal with a view to ensuring uniform application of the law might have been necessary (Article 112(1) EPC), referral to the Enlarged Board of Appeal would actually be inadmissible. Therefore, the Board does not follow the appellant's suggestion in this respect.

9. In summary, the request that the Divisional Application be treated as a validly filed divisional application is not allowable, and the appeal is therefore dismissed.

**Order**

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

The appeal is dismissed.

The Registrar:

The Chairman:

C. Eickhoff

B. Günzel