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**Datasheet for the decision
of 25 November 2011**

Case Number: J 0004/11 - 3.1.01

Application Number: 08012193.2

Publication Number: -

IPC: A23L2

Language of the proceedings: EN

Title of invention:

Water containing soluble fiber

Applicant:

Stillman, Suzanne Jaffe

Opponent:

-

Headword:

-

Relevant legal provisions:

EPC Art. 86(1), 122(3)
EPC R. 36(1), 112

Relevant legal provisions (EPC 1973):

EPC Art. 60(1), 60(3), 64, 67(1), 67(2), 67(4), 86(3), 106(1),
112, 121(1)
EPC R. 25(1), 69

Keyword:

"Divisional application"
"Pending earlier application (no)"
"Deemed withdrawal of application"
"Request for re-establishment"
"Request for referral of question to Enlarged Board of Appeal
(no)"

Decisions cited:

G 0001/90, G 0004/98, G 0001/09
J 0010/93, J 0018/04, J 0016/05

Catchword:

An application which has been deemed to be withdrawn for non-payment of a renewal fee is not pending within the meaning of Rule 25(1) EPC 1973 in the period for filing a request for re-establishment of rights under Article 122 EPC 1973 in respect of such non-payment or in the period after which such an application is filed in the event of such request being refused.



Case Number: J 0004/11 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 25 November 2011

Appellant:

Stillman, Suzanne Jaffe
1712 Barrington Avenue no. 4
Los Angeles
CA 90025 (US)

Representative:

Fiener, Josef
Patentanwalt J. Fiener et col.
P.O. Box 1249
D-87712 Mindelheim (DE)

Decision under appeal:

**Decision of the Receiving Section of the
European Patent Office of 30 September 2010.**

Composition of the Board:

Chairman: K. Garnett
Members: D. Prietzel-Funk
I. Beckedorf

Summary of Facts and Submissions

- I. This is an appeal against the decision of the Receiving Section posted to the appellant on 30 September 2010 refusing the appellant's request that the present application (No. 08012193.2) be treated as a divisional application.
- II. The parent application to the present application was itself filed as a divisional application (No. 06009035.4) of a grandparent application (No. 01914431.0) which was published on 30 August 2001. These applications will be referred to in this decision as the "present application", the "parent application" and the "grandparent application", respectively. Before the date when the parent application was filed, the grandparent application had been deemed to be withdrawn for non-payment of the renewal fee for the fourth year. However, a request for re-establishment of rights had been filed in the grandparent application before the filing date of the parent application. This request was later refused by the Examining Division (after the filing of the parent application) and an appeal against this refusal was subsequently dismissed.
- III. The Receiving Section concluded that the grandparent application was no longer pending when the parent application was filed. This was on the basis that a loss of rights as regards the grandparent application occurred on the expiry of the non-observed time limit and at this point the grandparent application was no longer pending.

IV. The appellant filed a notice of appeal in the present proceedings on 10 December 2010, paying the appeal fee, on the same day. A statement setting out the grounds of appeal was filed on 10 February 2011.

V. Following the sending of a communication with the Board's provisional opinion of the case, the appellant filed further submissions on 24 October 2011 together with a copy of an article from page 61 of "epi Information", issue 2/2011, entitled "Divisionals and Deemed Withdrawal. A Way out of the Mist?" by N. Bouche, et al (D1).

VI. Oral proceedings were held on 25 November 2011, during which the appellant filed a further article entitled "Divisionals - Peering into the Mist" by D. Visser and M. Blaseby published on page 32 of epi Information, issue 1/2011 (D2). D1 was in fact a follow-up article to D2.

VII. At the end of the oral proceedings the appellant made the following requests:

(1) That the decision under appeal be set aside and it be ordered that the present European patent application be treated as a divisional application.

(2) As an auxiliary request, that the following question be referred to the Enlarged Board of Appeal:

"In which way should the term "pending" in Rule 25(1) EPC 1973 (now Rule 36(1) EPC) be interpreted for the case where the parent application has been deemed to be withdrawn but a request for re-establishment of rights

was filed and a relevant appeal was pending at the time of filing of the divisional application?"

VIII. The appellant's arguments in support of these requests, both in writing and as developed during oral proceedings, can be summarised as follows:

(a) The parent application was still pending at the date of the filing of the present application or it was at least "provisionally" pending. At this date the grandparent was still alive, or there was a chance that it was still alive, given that the appeal against the refusal of the request for re-establishment of rights in respect of the grandparent had not yet been finally rejected.

(b) Two of the classes of cases where an application can still be pending are:

(i) Those where the parent application has not yet been finally refused.

(ii) Those where the parent application has not yet been finally withdrawn or finally deemed to have been withdrawn.

Although the Enlarged Board in G 1/09 (OJ EPO 2011, 336) dealt primarily with the first class of case, in its discussion of the legislative history regarding the amendment of Rule 25 EPC 1973 and Consultative Document CA/127/01, the second class of case was cited as an equivalent alternative, ie an application is "... pending ... until the date that an application is finally refused or

(deemed) withdrawn." (Paragraph 6 of CA/127/01). The appellant argued that the word "finally" relates not only to the word "refused" but also to the words "(deemed) withdrawn". Therefore an application is pending as long as the application is not finally deemed to be withdrawn.

- (c) The Enlarged Board in G 1/09 made reference to the status of a pending application as being one in which substantive rights are still in existence. The request for re-establishment still had a chance to maintain such substantive or provisional rights. Even if the grandparent application was "retroactively refused" back to the date of the deemed withdrawal, at the date of the filing of the present application the parent application was still alive, i.e., not finally refused, and at least "provisionally" pending, independent of its later destiny. In G 1/09 it was stated "The retroactive effect of a final decision ... does not influence the pending status of the application before such a decision is final." (Appellant's emphasis).

- (d) G 1/09 also states (point 3.2.5) that the filing of a divisional application is excluded only in 3 cases by *lex specialis*, including that in (new) Rule 36 EPC 2000, with a time limit of 24 months.

- (e) The substantive rights referred to by the Enlarged Board of Appeal in G 1/09 include not only the rights conferred by Article 67 EPC, which the Enlarged Board referred to, but also (a) the right to have a request under Article 122 EPC for re-

establishment considered and (b) the right of an inventor under Article 60 EPC.

(f) As regards the request for referral of a question to the Enlarged Board of Appeal, the appellant relied on the two articles D1 and D2 as showing that there is still uncertainty over the meaning of the term "pending" in the context of an application which has been deemed to be withdrawn, as opposed to one which has been refused. The point was one of fundamental importance within the meaning of Article 112 EPC given the similarity between a refusal and a deemed withdrawal of an application.

(g) Certain other arguments relating to the payment of renewal fees and assignation of filing dates were expressly withdrawn during oral proceedings.

IX. At the end of the oral proceedings the Board announced its decision dismissing the appeal and refusing the request for referral of a question to the Enlarged Board of Appeal.

Reasons for the Decision

1. The appeal is admissible.
2. The question to be decided is whether the parent application was pending when the present application was filed. This in turn depends on whether the grandparent application was still pending when the parent application was filed. The appellant accepts

that if the grandparent was not pending at this latter date, then the parent application was never a pending application, in which case the present application cannot be treated as a divisional application and the appeal must fail.

3. Because of the respective filing dates it was not in dispute that the applicable provisions are those of the EPC 1973. In the following discussion the Board only draws a distinction between the provisions of the EPC 1973 and EPC 2000 where it is necessary to do so.

Initial considerations

4. Rule 25(1) EPC 1973 provides that a divisional application may be filed relating to any "pending earlier European application". The EPC does not define "pending ... application" but the appellant accepted that the starting point for the discussion is the statement of the Enlarged Board of Appeal in G 1/09 that for the purposes of Rule 25(1) EPC 1973 a 'pending European patent application' is a "patent application in a status in which *substantive* rights deriving therefrom under the EPC are (still) *in existence*." See point 3.2.4 of the Reasons, emphasis by the Enlarged Board. In this context, the Enlarged Board also observed (point 3.2.3 of the Reasons) that the requirement of a pending earlier patent application reflects the applicant's substantive right under Article 76 EPC to file a divisional application on an earlier application if the subject matter of the earlier application is "still present" at the time when the divisional application is filed, citing G 1/05 (OJ EPO 2008, 271), point 11.2 of the Reasons.

5. The question is thus whether substantive rights deriving from the grandparent application were still in existence when the parent application was filed. The Enlarged Board did not give any definition of the expression "substantive rights" in this context. The Board nevertheless extracts the following points from the Enlarged Board's reasons:

- (a) "Substantive rights" in this context include the provisional protection conferred after publication of the application by virtue of Article 67(1) EPC, which in turn refers to the protection conferred by Article 64 EPC. See point 4.2.1 of the Reasons. The combined effect of these two articles is to provisionally confer on an applicant the same rights in the designated Contracting States as would be conferred by a national patent granted in those States. The Board will refer to these rights as the Article 64 rights.
- (b) The Enlarged Board did not expressly say (and did not need to say) whether there might be other relevant types of substantive rights.
- (c) A patent application involves two different aspects. On the one hand a patent application is an object of property as set out in Articles 71 to 74 EPC, conferring on the applicant, *inter alia*, the provisional Article 64 rights. On the other hand it involves procedural rights which the applicant is entitled to exercise by virtue of Article 60(3) EPC 1973. The expression "European patent application" may therefore stand for

substantive rights as well as for procedural rights of the applicant. See point 3.2.1 of the Reasons. Since Rule 25(1) EPC 1973 (see now Rule 36(1) EPC) refers to "any pending patent application" and not to pending proceedings before the EPO, it is not relevant for the purposes of Rule 25(1) EPC 1973 whether proceedings are pending before the EPO. Pending proceedings cannot be equated with a pending application. See points 3.2.2 and 4.2.5 of the Reasons.

(d) Article 67(4) EPC provides for the point in time when the Article 64 rights must end and thereafter are no longer still in existence. This is when, in the words of Article 67(4) EPC, the application has "been withdrawn, deemed to be withdrawn or finally refused."

6. The Enlarged Board also noted (point 3.2.5 of the Reasons) that there are circumstances where an application may be pending but the right to file a divisional application relating to it may be excluded by procedural provisions, as *lex specialis*. The appellant referred to this point, but it does not help the present Board to decide whether the grandparent application was pending when the parent application was filed because the expressly named exceptions do not apply to the case in hand.

7. From this starting point the Board will deal with the question which it has to answer in the following stages:

(a) Given that following publication of the grandparent application the substantive rights of

the appellant under that application included at least the provisional Article 64 rights, what, *prima facie*, was the effect on these rights of the deemed withdrawal of the grandparent application?

(b) Is the answer to this question affected by either:

(i) the possibility (and indeed the fact) of a request being made under Article 122 EPC for re-establishment of rights in the grandparent application following its deemed withdrawal, or

(ii) the possibility of an applicant using Rule 69 EPC 1973 (see now Rule 112 EPC) to challenge the notice of loss of rights?

(c) If the answers to these questions mean that the Article 64 rights were no longer in existence when the parent application was filed, was the appellant entitled to any other substantive rights and, if so, were such rights under the grandparent application still in existence when the parent application was filed?

The prima facie effect of deemed withdrawal on the Article 64 rights

8. Article 67(4) EPC provides that a European patent application shall be deemed never to have had the effects set out in Articles 67(1) and (2) EPC when it has been (a) withdrawn, (b) deemed to be withdrawn or (c) finally refused. The Enlarged Board in G 1/09 was concerned with the case of the refusal of an

application by the Examining Division: for the purposes of Article 67(4) EPC, at what point in time is an application to be considered as "finally refused" where no appeal is filed against the decision refusing the application? The Board concluded that this is when the time limit for filing an appeal against a decision refusing the application expires, since it is at this point that the decision to refuse the application becomes final. The retroactive effect of a decision dismissing the appeal does not alter the pending status of the application. See points 4.2.1 and 4.2.2 of the Reasons. Up until this point a substantive right under the application therefore still subsists. This was sufficient to answer the question which had been referred to the Enlarged Board.

9. The present Board is concerned with a different case, namely a deemed withdrawal of an application.

10. Article 67(4) EPC provides that an application is deemed never to have had the effects provided for under Articles 67(1) and (2) EPC when it is deemed to be withdrawn. The Enlarged Board took the position (point 4.2.3 of the Reasons) that Article 67(4) EPC is a self contained provision indicating the point in time at which "substantive rights conferred by a European patent application and therefore its pending status must end." The wider implications of this statement are considered later but so far as concerns the Article 64 rights, these rights must therefore have come to an end in the present case when the grandparent was deemed to be withdrawn. Indeed, this is simply what the article says. If it were otherwise there would be no point in

giving a person the right under Article 122 EPC to file a request to "have his rights re-established."

11. As to the point in time when this deemed withdrawal took place, Article 86(3) EPC 1973 (see now Article 86(1) EPC) simply provides that if the renewal fee (and any additional fee) is not paid in due time, the application shall be deemed to be withdrawn. Although the applicant must be informed of the loss of rights (Rule 69(1) EPC 1973, see now Rule 112(1) EPC) the withdrawal takes place at that point in time as a matter of law without any decision of the Office. As explained in G 1/90 (OJ EPO 1991, 275), in such a case the loss of rights occurs on expiry of the time limit that has not been observed (point 6 of the Reasons). See also G 4/98 (OJ EPO 2001, 131), point 3.3 of the Reasons.

12. Prima facie, therefore, the Article 64 rights under the grandparent application were no longer subsisting when the time for payment of renewal fee expired, which was before the date when parent application was filed.

The effect of the possibility (and the fact) of the filing of a request to grant re-establishment of rights.

13. If the Board were to accept the appellant's arguments, which are based on an analogy with the situation of "final refusal" of an application, it would follow that an application would remain pending after it had been deemed to be withdrawn for as long as the period for making a request to grant re-establishment of rights continued to run. Further, if and when such a request was made, the application would remain pending at least

until the date when the request for re-establishment was finally determined.

14. By way, first, of a general remark, the wording in Article 67(4) EPC appears to the Board to have been chosen with care, particular the positioning of the word "finally". In the case of a refusal of an application, the filing of an appeal will have the effect of suspending the effect of the order refusing the application (Article 106(1) EPC). It is logical therefore to speak of the "final" refusal of an application in this context, since the effect of the refusal of the application by the Examining Division is suspended in the event of an appeal. In such a case the suspensive effect of an appeal is ended in the event of a decision dismissing the appeal, from which point the appealed decision retrospectively takes full effect. At the point of dismissal of the appeal, the application can be said to be finally refused and the decision of Examining Division is made final.

15. On the other hand, in a case where an application is deemed to be withdrawn under Article 86(3) EPC 1973 for non-payment of a renewal fee it does not appear to the Board to be logical to speak of the "final" deemed withdrawal of the application. As already noted, the point in time when the application is deemed to be withdrawn is the point when the due time for payment of the renewal fee expires; the loss of rights occurs on the expiry of the time limit that has not been observed and, as such, is final in itself.

16. The question is then whether, nevertheless, there are any provisions of the EPC which have the effect that

the filing of a request for re-establishment of rights provisionally revives a deemed withdrawn application. In other words, does the application thereupon become pending once again? As to this, the filing of a request for re-establishment does not have any suspensive effect equivalent to the suspensive effect under Article 106(1) EPC of the filing of an appeal against refusal of an application for a grant. Not only is there no provision in the EPC providing for such equivalent effect but also the nature of an order granting a request for re-establishment is inconsistent with it. The effect of re-establishment is to put the applicant back in the position which he would have been in had the omitted act been performed as it should have been and thus, in accordance with wording of Article 122(1) EPC, to re-establish the rights which have been lost. The act belatedly performed (for example, as here, the payment of the renewal fee) is then deemed retroactively to have been performed in time so that the application which was deemed to have been withdrawn is deemed not to have been withdrawn (see Singer/Stauder on the European Patent Convention, 3rd (English) edition, Commentary on Article 122 at para. 144). This is now stated expressly in Article 122(3) EPC: "If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued." Although this provision was not in force at the relevant time, the *travaux préparatoires* to the EPC 2000 give no indication that any change in the law was intended, something which the Board considers would almost be bound to have been the case if this had been the intention. The Board considers this provision to be an accurate statement of the previous position. The effect

of filing a request for re-establishment is thus merely to make a reversal of the deemed withdrawal possible. The effect of an unsuccessful request for re-establishment is that the application stays deemed withdrawn.

17. In G 1/09 the Enlarged Board, when dealing with the issue of when an application should be considered to be (finally) refused, referred to and relied on the jurisprudence of Contracting States, pursuant to which "decisions do not become final until the expiry of the respective period for seeking ordinary means of legal redress." (See point 4.2.2 of the Reasons). In effect, the appellant argues that the right to seek re-establishment is a right of redress, so that while the period for seeking such redress against the deemed withdrawal of the application was still running, the deemed withdrawal was not a final withdrawal. The Board considers that this is not a correct analysis. First, the argument overlooks the distinction, already discussed, between a refusal, which requires a decision by the Office which is then challengeable by way of an appeal, and a deemed withdrawal, which takes place automatically by operation of law. The above statements by the Enlarged Board in G 1/09 were made in the express context of a decision by a department of first instance refusing an application: see point 4.2.2 of the reasons. Second, the Board considers that the concept of redress is appropriate only in the context of correcting a wrong. Thus while it is appropriate to speak of seeking redress against an allegedly wrong decision of the Office refusing an application, it is not appropriate to speak of seeking redress against the deemed withdrawal of an application. A person

requesting re-establishment of rights does not seek correction of a wrong, ie allege that the deemed withdrawal was wrong as a matter of law. Rather he requests that he should be excused the consequences of the withdrawal in the particular circumstances of the case. In contrast, the procedure under Rule 69 EPC 1973 (now Rule 112 EPC) by which a person can challenge a notice of loss of rights (see point 22, below) is a process for seeking ordinary means of legal redress against an alleged wrong of the Office. This conclusion appears to be fully consistent with the position under French, German and Swiss national law, as summarised in D1, points 4.1 to 4.3.

18. The Board also considers that the appellant is wrong in the inference which is sought to be drawn from Consultative Document CA/127/01. This document was drawn up for the Administrative Council when deciding on the amendment of Rule 25 EPC 1973 in 2001. The relevant passage at point 6 states in full: "Grant proceedings are pending until the date that the European Patent Bulletin mentions the grant (cf. J 7/96, OJ 1999, 443), or until the date that an application is finally refused or (deemed) withdrawn." The appellant argues that therefore one can legitimately speak of an application being "finally (deemed) withdrawn." However, even if the wording in CA/127/01 in this respect might be ambiguous, this part of the document was not specifically addressed to the question of when a deemed withdrawal of an application takes place but was concerned with the pending status of an application in the case of grant (see G 1/09, point 4.2.5 of the Reasons). In any event, the wording of Article 67(4) EPC is quite unambiguous in this respect.

From the *travaux préparatoires* containing the successive drafts of what became Article 67 it can be seen that the distinction between a (deemed) withdrawal and a final refusal was consistently made. It follows from what is said in points 14 and 15, above, that the Board also considers that such a distinction was made for good reason. The Board would add that in the Notice published by the Office explaining inter alia the changes subsequently made to Rule 25(1) EPC 1973 (OJ EPO 2002, 112), it was stated that "An application is pending up to (but not including) the date that ... the application is refused, withdrawn or deemed withdrawn; ...".

19. The conclusion which the Board has reached also appears to be fully consistent with the opinion of the Enlarged Board in G 4/98, where the Board decided inter alia that the deemed withdrawal of a designation of Contracting States takes effect upon expiry of the time limit set out in the relevant articles and rules, and not upon expiry of a grace period. In other words, the existence of a grace period does not defer the effect of the loss of rights to the end of the grace period. The Board said (see point 7.2 of the Reasons):

"The question therefore is whether the deemed withdrawal takes effect upon expiry of the regular time limits or upon expiry of the grace period pursuant to Rule 85a EPC. ... Rule 85a EPC does not prolong the normal time limits, but contains what its name says, namely a grace period, a possibility to remedy an otherwise potentially fatal non-observation of a time limit. The conclusion that the relevant date is not the expiry of the grace period, but the expiry of the

normal period was reached in J 4/86 concerning the failure to file a request for examination of a European patent application. The well-reasoned decision is fully convincing and since there are no reasons to distinguish the case at hand from the situation underlying J 4/86, there is nothing more to add. The practice of the EPO (Guidelines for Examination in the EPO, A-III, 12.5, 2nd paragraph) is confirmed."

20. The Board therefore considers that the appellant is incorrect in saying that the question is: when was the grandparent application "finally withdrawn"? In doing so, the appellant tries to equate the factual situation of the present case with the factual situation before the Enlarged Board in G 1/09 and ignores the fact that here the application was deemed to be withdrawn, not refused.

21. The Board thus concludes that the mere existence of the right to file a request for re-establishment of rights in a deemed withdrawn application does not mean that the application is still pending while the period for filing such a request is running. For the same reasons, the Board concludes that the fact that a request for re-establishment of rights is actually filed cannot thereupon make the application once again become pending.

The effect of the right of an applicant to challenge the notice of loss of rights.

22. Although this was not something argued for by the appellant, the Board considers that the above conclusions are not altered by taking into account the procedure by which an applicant can challenge a notice of loss of rights by way of requesting an (appealable) decision (Rule 69 EPC 1973, now Rule 112 EPC). If the decision in effect confirms the loss of rights, the loss of rights will still have occurred when the relevant time limit expired. There is no mechanism by which the application can have become pending again in the interim period and then become no longer pending. If the Office agrees with the applicant, then the effect of the procedure is that the Office acknowledges that no loss of rights ever occurred; the application will have been pending throughout.

Further processing

23. The Board is not concerned with the possible effect on the pendency of an application of a request for further processing under Article 121 EPC. These provisions of the EPC 2000 do not apply to the grandparent application (see point 3, above).

Did the appellant enjoy other substantive rights in the grandparent application which were (still) subsisting when the parent application was filed?

24. As to whether the appellant enjoyed any other substantive rights after the grandparent application was deemed to be withdrawn on the expiry of relevant

time limit, the appellant argues that (a) the right of the inventor under Article 60 EPC and (b) the right to have a request under Article 122 EPC for re-establishment of rights considered are both substantive rights within the meaning of G 1/09 which were still subsisting under the grandparent application when the parent application was filed. The Board will consider these in turn together with a further possible candidate for a substantive right, namely the right to file a divisional application itself.

The Article 60 right

25. The substantive right which the appellant relies on is said to be the right under Article 60 EPC to a patent, which right belongs to the inventor (or his employer or successor in title) and which, by virtue of Article 60(3) EPC, the applicant is deemed to be entitled to exercise. The Board will refer to this as the Article 60 right.
26. As the Board understands it, the right which the appellant relies on is in effect, and speaking broadly, the right of an applicant to have its application for the grant of a patent examined in accordance with the EPC and, subject to the application meeting the requirements of the EPC, to have a patent granted.
27. The Board inclines to the view that Article 60 EPC does not confer a substantive right *per se*, but rather a procedural right, which, once having been exercised, may lead to the conferring of proprietary rights under Article 64 EPC. This appears to follow from the wording of Article 60 EPC, which, according to the headline of

Chapter II of the EPC, is concerned with who is entitled (or deemed to be entitled) to apply for and obtain a European patent. See also the statement by the Enlarged Board in G 1/09 that: "... in proceedings before the EPO a European patent application also involves procedural rights which the applicant is entitled to exercise (Article 60(3) EPC 1973)." (point 3.2.1, emphasis added).

28. The Board acknowledges, however, that it is not always easy to say precisely what constitutes a procedural right and what constitutes a substantive right. As the Legal Board pointed out in J 18/04 (OJ EPO 2006, 560), procedural rights touch upon substantive rights and drawing a clear separation between the two concepts may be difficult.
29. In addition, as already noted (see point 5(c), above), the Enlarged Board in G 1/09 said that a patent application is an object of property conferring on the proprietor of the application, inter alia, the provisional Article 64 rights. By the use of the words "inter alia", the Enlarged Board appears to have been careful not to say that the substantive rights conferred on such proprietor were restricted to the provisional Article 64 rights, although the Board did not say what such other rights might be. In the light of this the Board will assume in the appellant's favour, but without deciding, that a patent application as an object of property does confer other substantive rights on the inventor, these being rights which the applicant is deemed to be entitled to exercise by virtue of Article 60(3) EPC. The Board will further assume in the appellant's favour, but again without deciding, that

one such right is the Article 60 right which the appellant relies on.

30. The question is then whether this right was still subsisting when the parent application was filed. In the Board's view the answer to this question is no. The short reason is that in G 1/09 the Enlarged Board said that Article 67(4) EPC "... is a self-contained provision indicating the point in time at which substantive rights conferred by a European patent application and therefore its pending status must end." See point 4.2.3 of the Reasons (emphasis added by the Board). Although this statement was made in the context of the discussion of the continuing subsistence of the Article 64 rights, it is perfectly general in its terms. More significantly, if there were in fact other substantive rights which continued to exist beyond this time, it would mean that the application would remain pending while these other rights remained subsisting despite the ending of the Article 64 rights. But this would be inconsistent with the Enlarged Board's statement that Article 67(4) EPC indicates the point in time at which the pending status of a European patent application must end.

31. However, the Board will again assume (in the appellant's favour) that the only substantive rights that the Enlarged Board was talking about here were the provisional Article 64 rights. See, for example, the unambiguous references to this right in point 4.2.1 of the Reasons. In the appellant's favour it can also be said that the Board did not expressly consider whether there might be other substantive rights and, further, did not need to consider the point. It was sufficient

to have enabled the Enlarged Board to reach the conclusion which it did for it to have restricted its consideration to the Article 64 rights. This is because the Board found such rights still to be subsisting in the case in question and so on this basis the Board could answer the question referred to it positively. The Board thus did not need to consider the position of other possible rights.

32. So far as concerns the Article 60 right, it is true that there is no provision in the EPC equivalent to Article 67(4) EPC setting out expressly when and in what circumstances the Article 60 right ceases to exist. However, this is presumably because such a provision is unnecessary. In the case of the Article 64 rights, Article 67(1) confers only provisional protection. The legislator therefore apparently considered it necessary to spell out what would happen to such provisional protection in the event that no patent was granted on the application, since otherwise the position would (at least arguably) have been uncertain. Article 60 EPC, on the other hand, does not provisionally confer rights. The Article 60 right exists unconditionally as from the moment when the application is filed. As to when such right ceases to exist, the position appears to the Board to be clear: the right ceases to exist if and when the application is finally refused, or is withdrawn or deemed to be withdrawn, as the case may be. At that point the applicant no longer has a right to have his application examined or to have a patent granted. Nor does the possibility of an application being made for re-establishment or the fact of such an application alter this conclusion. The reasoning is the same as in the case of the Article 64 rights, dealt

with in points 16 to 21, above. The statement by the Enlarged Board in G 1/09 that Article 67(4) EPC "... is a self-contained provision indicating the point in time at which substantive rights conferred by a European patent application and therefore its pending status must end" appears therefore to be fully applicable.

The right to request re-establishment as a substantive right

33. The right to have a (final) decision on the request for re-establishment of rights in the grandparent application was clearly still subsisting when the parent application was filed. The Board does not accept, however, that this right was a substantive right as this expression is used by Enlarged Board in G 1/09. In this respect the present Board has already referred to the distinction drawn by the Enlarged Board in G 1/09 between substantive and procedural rights, and to the Enlarged Board's statement that the fact that there may be pending proceedings in the application does not necessarily mean that the application is pending.

34. Although drawing a clear separation between procedural rights and substantive rights may be difficult, the right which the appellant relies on is in the Board's view a purely procedural and not a substantive right in the sense meant by the Enlarged Board. This is confirmed by the decision in J 10/93, where the Legal Board was concerned with the transfer of an application after the application had been deemed to be withdrawn. The Board said:

"3. First, it is to be taken into consideration that deemed withdrawal of a patent application does not

result in a complete and immediate loss of all the applicant's rights.

Although it is true that the grant procedure as such is terminated by a communication noting the deemed withdrawal (see G 1/90, OJ EPO 1991, 275, points 5 and 6 of the reasons), there still remains a bundle of procedural rights, as e.g. the applicant's right to apply for a decision under Rule 69(2) EPC (followed by the possibility to file an appeal having suspensive effect) and his right to avail himself of any of the legal remedies provided for in Article 121, Article 122, Rule 85a or Rule 85b EPC, as the case may be. Thus, following deemed withdrawal, there is a period of time during which the applicant is entitled to make use of his procedural rights referred to above with the aim of having his patent application restored." (Emphasis added by the Board).

35. The point was affirmed in J 16/05, where the Board said about a similar point (point 2.1 of the Reasons):

"Also, the fact that the application was declared deemed to be withdrawn does not prevent the Board from considering the effect of the transfer. As long as procedural rights remain outstanding, which the applicant is entitled to make use of, a successor to the applicant is entitled to have a transfer registered (see J 10/93, OJ EPO 1997, 91, point 3 of the Reasons)."

36. The Board therefore rejects this argument of the appellant.

The right to file a divisional application as a substantive right

37. Although the appellant did not rely on such a right, the Enlarged Board in G 1/09 referred to the right to file a divisional application relating to an earlier application as being a substantive right arising under the earlier application (see point 3.2.3 of the Reasons). The argument that the continued existence of such a right means that the earlier application will still be pending is nevertheless obviously circular in the present context.
38. The circle can be broken, however, by taking into account the Enlarged Board's qualification to this statement, namely that the right only existed "if the subject matter of the earlier application is "still present" at the time the divisional application is filed", quoting G 1/05. See point 3.2.3 of the Reasons. The requirement that the subject matter be "still present" was equated in the next paragraph of the Enlarged Board's reasons with the requirement that, for an application to be pending, substantive rights deriving therefrom must (still) be in existence. The present Board concludes that the right to file a divisional application therefore depends on some other substantive right under the earlier application (still) being in existence at the date of filing of the divisional application. So far as concerns the grandparent application, this condition, for the reasons already given, was not satisfied.

Referral of a question to the Enlarged Board of Appeal

39. In support of the request for the referral of a question to the Enlarged Board, the appellant cited the two articles D1 and D2, and said that they demonstrate that the position is uncertain. This is enough, it was argued, to mean that the question is an important one for the purposes of Article 112 EPC.
40. The authors of D2 argue (see page 34, point 3) that although the reasoning in G 1/09 implies that in the case of a deemed withdrawal the pending status ends at the expiry of the non-observed time limit, this is in conflict with the principle endorsed by the Enlarged Board of "pendency until expiry of the remedial period" (the authors' words). Alternatively, the authors argue that because of the similarity between a refusal and a deemed withdrawal it is reasonable to apply to the case of deemed withdrawal the principle endorsed by the Enlarged Board that a decision does not become final until the expiry of the period for seeking ordinary means of redress. In D1 and also in Visser, The Annotated European Patent Convention, 9th edition (2011), para. 2.1.3 (the author being one of the authors of D1 and D2) it is suggested that it is arguable that an application is still pending in the period during which a request for re-establishment can be filed. In D1, the authors also suggest a way of resolving what they see as the uncertainties arising out of G 1/09.
41. While the Board treats with due respect the views of academics and practitioners, the Board has been able to reach a conclusion in this case, including the above

points discussed in D1 and D2. The existence of doubts expressed in such articles is not in itself enough to make the question, even assuming that it is important, one which should be referred to the Enlarged Board. So far as the Board is aware, there are no other decisions of the boards of appeal in which a different conclusion has been reached.

Conclusion

42. For the above reasons the appeal must be dismissed and the request for referral of a question to the Enlarged Board is refused.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for referral of a question to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:

C. Eickhoff

K. Garnett