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**Datasheet for the decision
of 28 June 2013**

Case Number: J 0009/12 - 3.1.01

Application Number: ...

Publication Number: -

IPC: -

Language of the proceedings: EN

Title of invention:

-

Applicant:

N.N.

Headword:

Filing of a divisional application during stay of proceedings

Relevant legal provisions:

EPC Art. 61, 76

EPC R. 14, 36

Keyword:

"Application filed after the effective date of the stay of proceedings concerning the parent application, but before communication of stay, to be treated as divisional application (no) "

Decisions cited:

G 0001/09, J 0028/94, J 0007/96, J 0036/97, J 0002/01,
J 0010/02, J 0015/06, J 0020/05



Case Number: J 0009/12 - 3.1.01

D E C I S I O N
of Legal Board of Appeal 3.1.01
of 28 June 2013

Appellant: N.N.

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office dated 24 November 2011 refusing to treat European patent application No. 00000000.O as a divisional application of the earlier application No. XXXXXXXX.X.

Composition of the Board:

Chairwoman: B. Günzel
Members: L. Bühler
C. Heath

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Receiving Section of 24 November 2011 refusing to treat European patent application No. 00000000.O as a divisional application of the earlier application No. XXXXXXXX.X (hereinafter the "parent application").
- II. The parent application was filed on 13 April 2005 as international patent application WO 2005/YYYYYY. The requirements for entry into the European regional phase were fulfilled on 20 December 2006. Examination under Article 94 EPC 1973 was requested.
- III. On 17 May 2010, following examination of the parent application, the examining division issued a decision pursuant to Article 97(1) EPC 1973 to grant European patent No. Z ZZZ ZZZ. The applicant was informed that the mention of grant would be published in European Patent Bulletin ... of
- IV. With letter of 26 May 2010, a third party requested that the proceedings for grant relating to the parent application and a divisional application thereof (European patent application No. IIIIIIII.I) be stayed pursuant to Rule 14(1) EPC on the grounds that proceedings concerning the entitlement to the European patent application in suit had been initiated before a national court. The request was supplemented by letter of 3 June 2010.
- V. On 8 June 2010, the applicant filed European patent application No. 00000000.O in suit as a divisional application of the parent application.

- VI. The mention of the grant of European patent No. Z ZZZ ZZZ (for the parent application) was published in European Patent Bulletin ... of
- VII. With communication of 10 June 2010, the Legal Division informed the applicant and the third party that proceedings for grant relating to the parent application (and divisional application No. IIIIIIII.I) had been stayed as from 26 May 2010. The Legal Division furthermore announced that the mention of grant for the parent application published in European Patent Bulletin ... of ... would be corrected in due course.
- VIII. In the European Patent Bulletin ... of ..., in section II.12(12) under the heading "Date of publication of the specification of the European Patent (B1) (Art. 98)", the European Patent Office published the following correction regarding the grant of European patent No. Z ZZZ ZZZ for the parent application: "patent not yet published".
- IX. On 30 November 2010, the Receiving Section sent a communication pursuant to Rule 112(1) EPC informing the applicant that the application in suit, i.e. European patent application No. 00000000.0, could not be treated as a divisional application of the parent application due to the stay of proceedings concerning the latter application. With letter of 10 February 2011, the applicant contested the findings of the Receiving Section and requested that a decision be issued pursuant to Rule 112(2) EPC.
- X. With decision posted on 24 November 2011, the Receiving Section refused to treat European patent application

No. 00000000.0 in suit as a divisional application of the parent application. The Receiving Section found that a stay of proceedings took immediate effect on the date on which a third party provided evidence that it had instituted national entitlement proceedings. In the present case, this condition was considered to have been met on 26 May 2010 and the grant proceedings relating to the parent application were accordingly stayed as from said date. The Receiving Section further argued that the applicant could not validly perform any procedural acts while the proceedings were suspended. According to decision J 20/05, this included the filing of a divisional application under Rule 36 EPC.

- XI. The applicant (appellant) lodged an appeal against this decision on 31 January 2012. The appeal fee was paid on the same day. The statement setting out the grounds of appeal was filed on 4 April 2012.

- XII. With communication of 21 May 2012, the Legal Division informed the appellant and the third party that proceedings for grant relating to the parent application (and divisional application No. IIIIIIII.I) would be resumed pursuant to Rule 14(3) EPC on 3 September 2012.

- XIII. Summons to oral proceedings accompanied by a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA, OJ EPO 2007, 536) were dispatched on 24 January 2013.

- XIV. With letter dated 10 May 2013, the appellant withdrew its request for oral proceedings and requested a decision based on its written submissions. With

communication of 21 May 2013, the appellant was informed that the oral proceedings had been cancelled.

XV. The arguments of the appellant can be summarised as follows:

- (a) The filing of a divisional application was not a procedural act in the proceedings for grant concerning the parent application. There was thus no basis in the European Patent Convention for refusing to process the application in suit as a divisional application on the grounds that the grant proceedings relating to the parent application had been stayed.
- (b) Notwithstanding decision J 20/05, the purpose of a stay of the grant proceedings - namely to protect the rights of a person who claimed an entitlement - did not justify the legal consequence of refusing to process the application in suit as a divisional application after staying the proceedings in respect of the parent application. The rights of a third party claiming entitlement to the invention could also be preserved by just extending *ex officio* the stay of the proceedings with regard to the parent application to the newly filed divisional application. Decision J 20/05 should thus be reconsidered.
- (c) The decision to grant a patent for the parent application had indicated that the mention of grant would be published on 9 The last opportunity to file a divisional application was thus 8 At that time, the public was not aware

of the stay of the proceedings for grant concerning the parent application. A correction of the decision to grant was published in the European Patent Bulletin only later (point VIII above). The requirements of Article 76 and Rule 36 EPC had been fulfilled on the date of receipt of European patent application No. 00000000.0 and the subsequent stay of the proceedings for grant concerning the parent application had no impact on the validity of the divisional application.

XVI. The appellant requested in writing that the decision under appeal be set aside and that the Receiving Section be ordered to allow European patent application No. 00000000.0 to proceed as a divisional application of earlier application No. XXXXXXXX.X.

Reasons for the Decision

1. European patent application No. 00000000.0 was filed as a divisional application on 8 Rule 36 EPC as amended by the decisions of the Administrative Council of 25 March 2009 (OJ EPO 2009, 296) and 26 October 2010 (OJ EPO 2010, 568), which entered into force on 1 April and 26 October 2010 respectively, is applicable in the present case.

Legal basis

2. The Receiving Section held that an applicant may not validly perform any procedural acts while the proceedings are stayed pursuant to Rule 14(1) EPC, and that this included the filing of a divisional application under Rule 36 EPC. The appellant objected

to this finding, and argued that there was no legal basis for extending the effects of a stay of the grant proceedings concerning the parent application to the filing of a divisional application.

3. It is established jurisprudence with regard to Article 76 and Rule 25 EPC 1973 that it is the entitlement acquired by virtue of the parent application that gives the right to file a divisional application. This means that the rights derivable for the divisional application from the earlier application correspond to, but are also limited to, the rights existing in respect of the parent application at the filing date of the divisional application. The entitlement to file a divisional application according to Article 76 and Rule 25 EPC 1973 is thus a procedural right that derives from the applicant's status as applicant under the earlier application (J 2/01, OJ EPO 2005, 88, points 5.1 and 6 of the Reasons; J 20/05 of 6 September 2007, point 2 of the Reasons). Therefore, as well as examining the other formal requirements for the filing of a divisional application, the Receiving Section has also to examine whether the applicant is entitled to file the divisional application by virtue of being the applicant in the earlier application (J 20/05, point 2 of the Reasons). As a consequence, Rule 13 EPC 1973 was found to prevent, as *lex specialis*, the filing of a divisional application if the proceedings for grant concerning the pending earlier application had been stayed (J 20/05, headnote and point 3 of the Reasons; see also G 1/09, OJ EPO 2011, 336, point 3.2.5 of the Reasons, confirming this finding).

4. The principles set out in this jurisprudence are still pertinent under the revised law. Rule 13(1) EPC 1973 was streamlined and its wording aligned with the revised EPC. It was not changed in substance. Rule 36(1) EPC as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89) and the amended versions which entered into force on 1 April and 26 October 2010 (see decisions of the Administrative Council of 25 March 2009, OJ EPO 2009, 296, and of 26 October 2010, OJ EPO 2010, 568) continue to be based on the principle that a divisional application may be filed "relating to any pending earlier European patent application". Therefore, the right to file a divisional application still follows from the entitlement acquired by virtue of the parent application.
5. The board sees no reason to depart from the finding of decision J 20/05 (headnote and point 3 of the Reasons), confirmed by decision G 1/09 (OJ EPO 2011, 336, point 3.2.5 of the Reasons), that Rule 14 EPC prevents the filing of a divisional application if the proceedings for grant concerning the earlier application are stayed. Even if the filing of a divisional application during stay of the proceedings for grant regarding an earlier application is not expressly excluded by the European Patent Convention, it is consistent with the purpose of Rules 14 and 36 EPC. Since the rights in respect of a divisional application can be derived only from the earlier patent application, such patent application cannot form a sufficient basis for a right to file a divisional application if the right of the applicant to the grant

of a European patent in respect of the earlier application is disputed and the proceedings for grant stayed under Rule 14(1) EPC. Furthermore, to allow the filing of a divisional application by an applicant whose entitlement is challenged would be inconsistent with and contrary to the fundamental objective of Rule 14(1) EPC, which is to preserve any potential rights a third party may have to the grant of a patent for the earlier application in dispute.

No automatic extension of the stay to any divisional application

6. The appellant argued that the rights of a third party claiming entitlement to the invention for which protection is sought in an earlier application could also be preserved by extending *ex officio* the stay of the proceedings in regard to the earlier application to any subsequently filed divisional application. Decision J 20/05 of 6 September 2007 should be reconsidered in this respect.

7. The board cannot agree. Up to the grant of a European patent, the applicant alone has the status of party to proceedings before the European Patent Office. A person other than the applicant is not a party to the proceedings for grant (Article 115, second sentence, EPC, despite the use of the term "third party"). He may acquire party status in these proceedings in limited instances only, where the European Patent Convention provides for a right of a person other than the applicant to submit requests in respect of a patent application. Rule 14 EPC, which is based on Article 61 EPC, is one such example. As decision J 20/05 (point 6

of the Reasons) pointed out, it is not possible for a person seeking a decision within the meaning of Article 61 EPC to apply to the European Patent Office under Rule 14(1) EPC for an automatic and immediate suspension of proceedings regarding any divisional application deriving from an earlier application by way of an extension of the stay of the proceedings regarding the earlier application. The European Patent Office is entitled to stay the proceedings for grant under Rule 14(1) EPC only if there is clear and unambiguous proof that the claimant's request in the proceedings before the national court is for judgment that he is entitled to the grant of the European patent application which is to be suspended, and not for any other application, however related it may be. Moreover, only proceedings for grant may be stayed which concern European patent applications pending at the date of filing of the request for stay. Furthermore, proceedings for grant cannot be stayed before the publication of the European patent application. Therefore, Rule 14(1) EPC cannot be regarded as conferring on the departments of the European Patent Office the power to extend *ex officio* a stay of the grant proceedings concerning an earlier application to any divisional application proceedings filed thereafter. The European Patent Convention thus leaves no room for the alternative interpretation put forward by the appellant. In conclusion, the board agrees with the findings of decision J 20/05 that, in order to preserve the rights of a third party claiming entitlement to the invention for which protection is sought in an earlier application, and to prevent the applicant from prejudicing the third party's possible rights, a European patent application which is filed under

Rule 36 EPC while the proceedings for grant of the earlier patent application are stayed may not be processed as a divisional application.

Immediate effect of the stay of proceedings for grant

8. There remains the appellant's argument that the requirements of Article 76 and Rule 36 EPC had been fulfilled on 8 June 2010, the date of receipt by the European Patent Office of European patent application No. 00000000.0 in suit, and that the subsequent communication ordering the stay of the proceedings concerning the parent application had no impact on the validity of the divisional application. The appellant thereby contests the lawfulness of a stay of the proceedings for grant under Rule 14(1) EPC which is communicated after the date of publication of the mention of grant of the patent for an earlier application and affects a divisional application filed in the interval between the filing of a request for a stay of proceedings and the communication of the stay to the parties involved.

9. The board notes that the appellant has neither objected to the communication from the Legal Division of 10 June 2010 nor requested an appealable decision. The board has thus no power to review the order for the stay of the proceedings for grant concerning the parent application. The further issue addressed by the appellant requires an answer in this decision only in as far as it raises the question of whether a stay of proceedings for grant communicated after the publication of the mention to grant is to be regarded as automatically null and void.

10. The contested decision of the Receiving Section relied on decisions J 28/94 (OJ EPO 1997, 400, point 3.1 of the Reasons), J 7/96 (OJ EPO 1999, 443, headnote and points 2.1, 3, 8 and 11 of the Reasons) and J 10/02 of 22 February 2005 (point 3.1 of the Reasons) to justify the stay of the proceedings for grant concerning the parent application as from the receipt of the allowable request for a stay on 26 May 2010. However, these decisions do not explicitly deal with the situation where a divisional application is filed before the date of publication of the mention of grant and a stay in regard to the parent application is communicated thereafter.

11. The jurisprudence of the Legal Board of Appeal is nevertheless consistent in that a request for stay of the proceedings under Rule 14(1) EPC may be filed up to the day before the date of the mention of grant of the European patent in the European Patent Bulletin (with regard to Rule 13(1) EPC 1973 see J 7/96, OJ 1999, 443, headnote and points 2.1 and 3 of the Reasons; J 36/97 of 25 May 1999, point 3 of the Reasons). A stay of proceedings under Rule 14(1) EPC takes immediate effect as from the date on which an allowable request is filed, i.e. as from the date the European Patent Office is provided with satisfactory evidence that national proceedings have been instituted against the applicant seeking a decision within the meaning of Article 61(1) EPC (with regard to Rule 13(1) EPC 1973 see J 28/94, OJ EPO 1997, 400, points 2.1 and 3.1 of the Reasons; J 7/96, OJ EPO 1999, 443, point 2.1 of the Reasons; J 36/97 of 25 May 1999, point 2 of the Reasons; J 10/02 of 22 February 2005, point 3.1 of the Reasons).

Furthermore, the European Patent Office is responsible for the grant proceedings up to the date of the publication of the mention of grant of the patent. This competence includes the publication of any necessary correction of a publication of the mention of grant (J 15/06 of 30 November 2007, point 11 of the Reasons). As a consequence, the publication of the mention of grant does not take away the competence of the Legal Division to issue a communication and, if requested, a decision ordering a stay of the grant proceedings, provided that an allowable request is filed before publication (see J 15/06 of 30 November 2007, point 14 of the Reasons with reference to decisions J 33/95 of 18 December 1995 and J 36/97 of 2 May 1999). It would moreover be contrary to the purpose of Rule 14(1) EPC if procedural acts taken in the interim period between the filing of a request for stay and the decision of the Legal Division on this request were to produce legal effect irrespective of the final decision on the stay of the proceedings (see J 7/96, OJ EPO 1999, 443, point 8 of the Reasons). For the above reasons, the board cannot accept the argument that a stay of proceedings for grant communicated after the publication of the mention of grant is to be regarded as automatically null and void.

12. In the present case, an allowable request for a stay of the grant proceedings concerning the parent application was received on 26 May 2010. As from that date, the grant proceedings had to be stayed without the European Patent Office having to take a formal decision. The publication of the mention of grant of a patent for the parent application on 9 ... did not take away the competence of the Legal Division to separately issue a

communication on the order of the stay as from 26 May 2010. The application in suit, i.e. European patent application No. 00000000.0, was received by the European Patent Office on 8 ..., i.e. after the effective date of the stay of the grant proceedings concerning the parent application. Rule 14(1) together with Rule 36(1) EPC thus prevented the valid filing of the application in suit as a divisional application of the parent application. As a consequence, the appeal must fail.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairwoman:

C. Eickhoff

B. Günzel