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**Datasheet for the decision
of 1 September 2015**

Case Number: J 0022/13 - 3.1.01

Application Number: XXXXXXXXX.X

Publication Number: null

IPC:

Language of the proceedings: EN

Title of invention:

...

Applicant:

N.N.

Headword:

Relevant legal provisions:

EPC R. 36

EPC 1973 Art. 67(4)

EPC Art. 112(1)

Keyword:

Divisional application

Pending earlier application (no)

Parent application finally refused (yes)

Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0001/09, J 0028/94, J 0028/03, J 0003/04, J 0018/04,

J 0005/08, J 0023/13

Catchword:



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Chambres de recours**

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Case Number: J 0022/13 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 1 September 2015

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the
European Patent Office of 10 September 2013.

Composition of the Board:

Chairwoman P. Schmitz
Members: S. Fernández de Córdoba
O. Loizou

Summary of Facts and Submissions

- I. The appeal is directed against the decision of the Receiving Section dated 10 September 2013 that European patent application No. XX XXX XXX.X will not be treated as a divisional application of the earlier European patent application No. YY YYY YYY.Y.
- II. The earlier European patent application No. YY YYY YYY.Y (the **parent** application) was refused by the Examining Division by decision dated 24 January 2012.
- III. Notice of appeal against that decision was filed on 20 March 2012. The appeal fee was paid on the same day. The time limit for filing the statement of grounds of appeal expired on 3 June 2012. As no statement of grounds of appeal was filed, the appeal was rejected as inadmissible by decision of 22 October 2012 (T 1491/12).
- IV. The application in suit, application No. XX XXX XXX.X, was filed on 29 August 2012 as a **divisional** application of the above-mentioned parent application.
- V. On 21 November 2012 the Receiving Section issued a communication "Noting of loss of rights pursuant to Rule 112(1) EPC" informing the appellant that the application was not being processed as a divisional application because when it was filed, the earlier European patent application had been finally refused, withdrawn or deemed withdrawn.
- VI. By letter filed with the EPO on 23 January 2013, the appellant requested a decision under Rule 112(2) EPC. After having informed the appellant of its preliminary opinion on the matter and after the appellant had filed

a reply to the communication, the Receiving Section issued the decision under appeal.

VII. In the reasons for this decision, the Receiving Section mainly reasoned as follows:

The decisions of the Boards of Appeal referred to by the applicant, i.e. J 28/94, J 3/04 and J 5/08, were not entirely clear with regard to the issue whether the suspensive effect of an appeal has, in all circumstances, the consequence that grant proceedings and thereby the application remain pending (J 5/08, reasons 14 and 15). Two decisions of the Legal Board of Appeal (J 28/94 and J 3/04) appeared to confirm that this was indeed the case. In particular, in decision J 3/04 it was said that the suspensive effect did not depend on the admissibility of the appeal (point 5 of the reasons). However, in G 1/09 it was held that the issue of pendency was to be assessed independently of the suspensive effect of an appeal (point 4.3.2 of the reasons). To that extent, the Enlarged Board confirmed the approach taken in J 28/03. In this decision the Board clarified (point 11 of the reasons) that an appeal which could be expected to be inadmissible should not benefit from the possibility to file a divisional application during the appeal proceedings, it being irrelevant whether the appeal might have been obviously inadmissible from the very beginning or if it was rejected as inadmissible at a later stage (point 18 of the reasons). Therefore, J 28/03 could be interpreted in the sense that, irrespective of any suspensive effect, a parent application was only pending within the meaning of Rule 36 EPC after a notice of appeal has been filed if the appeal was admissible and thus the application was subject to substantive examination.

This approach was further in line with legal textbooks and with the general statements made in J 18/04 that pendency was not only a mere procedural issue, but to a large degree also a substantive requirement (point 9 of the reasons; decision also cited in G 1/09, point 3.2.4 of the reasons).

The Receiving Section noted that, whereas in the present case an appeal had been filed against a decision to refuse the application, J 28/03 concerned a situation in which an appeal against a decision to grant was filed, which appeal was rejected by the Board of Appeal as inadmissible. It was also aware that G 1/09 had explicitly left cases such as the present one unanswered. Nevertheless, the Receiving Section considered that the principles developed in J 28/03 were of a general nature and confirmed its approach. Accordingly, the earlier application was not pending within the meaning of Rule 36 EPC when the application in suit was filed, hence the application in suit was not to be treated as a divisional application.

VIII. The appellant filed a notice of appeal against this decision of the Receiving Section on 7 November 2013, paid the appeal fee and filed the statement setting out the grounds of appeal on the same day.

The appellant's arguments can be summarised as follows:

The crucial question was whether the parent application was still pending at the time of filing of the current divisional application. This issue was left unanswered by the Enlarged Board of Appeal in decision G 1/09, which explicitly stated that the decision only covered cases in which no appeal was filed. In particular, the

Enlarged Board of Appeal only referred to "appeal" as such and did not make a distinction between an inadmissible or admissible appeal (G 1/09, point 4.2.4). Thus, the Enlarged Board of Appeal implied that it is possible to file a divisional application as long as appeal proceedings were ongoing in the parent application, regardless of the admissibility of the appeal. Further, decision J 28/03, cited by the Receiving Section, concerned the very different situation of an appeal filed against a decision to grant and could therefore not provide support for the current case, which related to the refusal of a pending application. The same applied to decision J 18/04, which was not relevant for the current case.

- IX. The appellant requested, as its main request, that the present application be considered a validly filed divisional application and be awarded the same filing date as the parent application and, as an auxiliary request, that the question as posted by the President of the EPO but left unanswered in G 1/09 be referred to the Enlarged Board of Appeal.

- X. The Board issued a preliminary opinion by communication dated 19 May 2015. The appellant did not file a reply thereto.

Reasons for the Decision

- 1. Rule 36 EPC, in the applicable version of 26 October 2010, provides that a divisional application may be filed from any "pending earlier European patent application". The EPC does not define the term "pending application". However, in its decision G 1/09 (OJ EPO 2011, 336) the Enlarged Board of Appeal thoroughly

analysed and clarified the question as to how this term should be interpreted. It held that a pending earlier 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).

2. The Enlarged Board further observed that the substantive rights of an applicant include provisional protection, pursuant to Article 67 EPC 1973, conferred by the European patent application after publication. Article 67(4) EPC 1973 clearly indicates until when such substantive rights deriving from a European patent application are in existence if a patent is not granted. In particular, it provides that the European patent application shall be deemed never to have had the effects of provisional protection when it has been withdrawn, deemed to be withdrawn or "finally refused" (German version: "rechtskräftig zurückgewiesen" - French version: "rejetée en vertu d'une décision passée en force de chose jugée").

Substantive rights of the applicant under Article 67 EPC 1973 may therefore continue to exist after refusal of the application until the decision to refuse becomes final (point 4.2.1 of the reasons).

3. The general principles which the Enlarged Board developed in its legal analysis, in particular the interpretation of the term "pending" in the light of Article 67(4) EPC, as well as its application and further development by the Legal Board in decision J 23/13 of 30 March 2015, have to be the starting point for the assessment of the present case as well.

4. In J 23/13 a valid notice of appeal, but no statement of grounds of appeal, was filed against the decision to refuse the parent application. The divisional application was filed while the time limit for filing the grounds of appeal was still running. The Board decided that since a valid appeal had been filed which had suspensive effect, the decision to refuse the application had not yet become final by the end of the time limit for filing the notice of appeal. The decisive point in time which had to be looked at was the date of filing of the divisional application. The divisional application was filed while the time limit for filing the grounds of appeal was still running. At that time, the applicant could still exercise his substantive rights and the possibility was still open that the application would be subject to substantive examination.

5. In the present case, however, the divisional application was filed after expiry of the time limit for filing the grounds of appeal. At that time, the parent application could no longer be subject to substantive examination and therefore was already finally refused.

The Legal Board of Appeal stated in J 23/13 (point 8.3 of the reasons) that "(t)he EPC provides for a two-step procedure if an applicant wants to have a decision to refuse an application reviewed by the Boards of Appeal. Within two months after notification of the decision a notice of appeal must be filed and within four months a statement of grounds of appeal must be provided (Article 108 EPC). If the notice of appeal is not filed by the end of the two-month period, the decision becomes final upon expiry of that period and the application is then no longer pending. If, however,

notice of appeal is validly filed but the second step, i.e. filing of the grounds of appeal, is not performed within the period for filing the grounds of appeal, the decision only becomes final upon expiry of this period. It is only after expiry of this period that no ordinary means of legal redress exist any longer and the subject-matter becomes *res iudicata* (c.f. G 1/09 point 4.2.2 of the reasons) and thus no longer pending."

Accordingly, the present application cannot be treated as a divisional application.

6. The decisions which were cited by the appellant appear to be of less assistance. None of them dealt with a situation comparable to the present one in which the parent application was refused and an appeal was filed against the decision refusing it. In particular, decisions J 28/03 (OJ EPO 2005, 597), J 3/04 of 20 September 2005 (not published in the OJ) and J 5/08 of 9 July 2009 (not published in the OJ) all dealt with situations where the parent application was granted and an appeal was filed against the decision to grant. Decisions J 28/94 (OJ EPO 1995, 742, dealing with the concept of suspensive effect) and J 18/04 (OJ EPO 2006, 560, stating that the term "pending .. patent application" in Rule 25 EPC 1973 does not establish a time limit, but rather a substantive requirement) are even more remote. Moreover, these decisions were issued before G 1/09 and do not take the principles established therein into account.

7. As regards the appellant's request for referral to the Enlarged Board of Appeal, the Board sees no need to do so as the answer regarding the present case can be deduced directly and unequivocally from the decision of the Enlarged Board G 1/09 as well as from its further

application by the Legal Board in J 23/13. Furthermore, the Board is not aware of any decision of the boards of appeal taken after G 1/09 which runs 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).

8. For the above reasons the appeal must be dismissed and the request for referral to the Enlarged Board is rejected.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for referral to the Enlarged Board is rejected.

The Registrar:

The Chairwoman:



C. Eickhoff

P. Schmitz

Decision electronically authenticated