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Datasheet for the decision of 30 March 2015

Case Number: J 0023/13 - 3.1.01

Application Number: XXXXXXXX.X

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Title of invention:

...

Applicant:

N.N.

Headword:

Relevant legal provisions:

EPC R. 36
EPC 1973 Art. 67(4)
EPC 1973 R. 25
EPC Art. 108, 106, 67

Keyword:

Divisional application
Pending earlier application (yes)
Parent application finally refused (no)

Decisions cited:

G 0001/09, J 0028/94, J 0028/03, J 0003/04, J 0018/04, J 0005/08

Catchword:

Europäisches Patentamt
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Case Number: J 0023/13 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 30 March 2015

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: **Decision of the Receiving Section of the European Patent Office of 11 July 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 11 July 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 at the end of the oral proceedings held on 14 April 2010. The written decision was dated 4 June 2010.

III. Notice of appeal against the decision refusing the parent application was filed on 10 August 2010. The appeal fee was paid on the same day. The time limit for filing the statement of grounds of appeal expired on 14 October 2010. As no statement of grounds of appeal was filed, the appeal was rejected as inadmissible by decision of 20 May 2011 (T 0000/00).

IV. The application in suit, application No. XX XXX XXX.X, was filed on 22 September 2010 as a **divisional** application of the above-mentioned parent application No. YY YYY YYY.Y.

V. On 15 September 2011 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application because when it was filed, the pending earlier European patent application had been finally refused, withdrawn or deemed withdrawn.

VI. By letter filed with the EPO on 15 November 2011, the appellant requested *inter alia* that the noting of loss of rights pursuant to Rule 112(1) EPC be declared null and void

and, as an auxiliary request, that an appealable decision under Rule 112(2) EPC be issued. 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 argued 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). In so far, 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 procedure, 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 (points 9 of the reasons; decision also cited in G 1/09, point 3.2.4 of the reasons).

The Receiving Section was well aware that J 28/03 concerned a situation in which an appeal against a decision to grant was filed, whereas in the present case an appeal had been filed against a decision to refuse the application, 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. The application in suit was not to be treated as a divisional application.

VIII. The appellant filed an appeal against this decision of the Receiving Section on 17 September 2013 and paid the required appeal fee on the same day.

The appellant’s statement setting out the grounds of appeal filed by letter of 18 November 2013 can be summarised as follows:

There was no provision in the EPC which required for the suspensive effect of an appeal that the appeal must be admissible or that appeal proceedings must be successful. Therefore, the filing of the appeal meant that the suspensive effect prevented the decision to refuse the parent application from becoming final until the decision of the Board of Appeal, dated 20 May 2011, was taken. Accordingly, the parent application was pending until 20 May 2011 with the consequence that the divisional application has been timely filed. The

reasons of the Receiving Section were not convincing. Any arguments given which referred to decision G 1/09 were improper since the Enlarged Board of Appeal explicitly stated that the decision only covered cases in which no appeal was filed. The reasons of the Receiving Section were not supported by the cited decision J 28/03, in particular because there the Board emphasised that, while in a case in which an appeal was filed against a decision to grant the outcome of the appeal proceedings was relevant for the status of the divisional application, the situation was fundamentally different in the case of an appeal against a decision refusing a patent application, in that this led to a "particular suspensive effect" allowing a divisional application to be validly filed during appeal proceedings, independently of the outcome of such proceedings. Furthermore, the Receiving Section ignored the remaining case law, in particular decision J 5/08 (points 12, 15 to 17 of the reasons), which analysed the findings of decisions J 28/94 and J 3/04. All three decisions were consistent and allowed the conclusion that the present application had to be considered as a validly filed divisional application even though the appeal against the refused parent application was inadmissible.

IX. The appellant requested that the decision under appeal be set aside and that the noting of loss of rights pursuant to Rule 112(1) EPC of 15 September 2011 be declared null and void.

Reasons for the Decision

1. The appeal is admissible.

2. The version of Rule 36 EPC applicable in the present case (in the following "Rule 36 EPC") is that which entered into force on 1 April 2010 since the present application was filed on 22 September 2010 (see Article 2 of the Decision of the Administrative Council of 25 March 2009, OJ EPO 2009, 296). Rule 36 EPC in this version provides that a divisional application may be filed in relation to any “pending earlier European patent application”.

3. The question to be decided is therefore whether the parent application was still pending within the meaning of Rule 36 EPC when the present divisional application was filed. 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 differentiated between pending proceedings and pending applications and held that a pending earlier European patent application, in the specific context of Rule 25 EPC 1973 (now Rule 36 EPC), is a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence (see points 3.2.2 to 3.2.4 of the reasons).

4. 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 (rechtskräftig, passée en force de chose jugée),(point 4.2.1 of the reasons).

5. The Enlarged Board´s decision was concerned with the situation in which a patent application has been refused and no appeal is filed. It held that in these circumstances an application is to be considered as “finally refused” when the time limit for filing an appeal expires, since it is at this point that the decision to refuse the application becomes final. Since the point of law referred to the Enlarged Board only concerned cases in which no appeal was filed, the Enlarged Board restricted its analysis to these cases and declined to provide an answer for the situation in which an appeal is filed (see point 4.3.3 of the reasons).

6. However, 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, have to be the starting point for the assessment of the present case as well.

7. The decisions of the Legal Board which were cited in these proceedings by the appellant and the Receiving Section appear to be of less assistance. None of them dealt with a situation comparable to the present one in which the parent application has been refused and an appeal has been 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.

8. Applying the reasoning of G 1/09 to the present case, it follows that the parent application was still pending at the point in time when the divisional application was filed.

8.1 The Examining Division refused the parent application at the end of the oral proceedings held on 14 April 2010 and dispatched the written reasons of this decision on 4 June 2010. Notice of appeal against this decision was timely filed and the appeal fee was timely paid on 10 August 2010 (see Article 108, 1st and 2nd sentences, and Rule 131(4) EPC). Thus, a valid appeal was filed, which according to Article 106(1) EPC shall have suspensive effect, and, accordingly, by the end of the time limit for filing the notice of appeal the decision to refuse the parent application had not yet become final. The divisional application was filed on 22 September 2010, i.e. within the period for filing the statement of grounds of appeal, which expired on 14 October 2010 (Article 108, 3rd sentence and Rule 131(4) EPC). Since no grounds were filed, the Board of Appeal rejected the appeal as inadmissible in its decision dated 20 May 2011.

8.2 In its decision, the Receiving Section took the view, with reference to J 28/03, that irrespective of any suspensive effect, an application was only pending after an appeal was filed if the appeal was admissible and thus the application was

subject to a substantive examination. This view cannot be reconciled with the Enlarged Board's assessment in G 1/09. The decisive point in time which has to be looked at is the date of filing of the divisional application. On this date, i.e. on 22 September 2010, there were still substantive rights in existence since at that time the refusal was not yet final. As outlined by the Enlarged Board, the retroactive effect which a final decision to refuse has on the rights conferred upon the applicant under Article 67 EPC does not influence the pending status of the application before such a decision becomes final (see point 4.2.3 of the reasons) and this effect ensues.

8.3 In the present case, 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 a substantive examination. The subject-matter of the earlier application was "still present", as the Enlarged Board put it in G 1/09, point 3.2.3 of the reasons. The fact that the appeal was later rejected as inadmissible cannot change the fact that, on the date when the divisional was filed, substantive rights were still in existence. The 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, the decision is not yet final and only becomes final upon expiry of the period for filing the grounds of appeal if the second step, i.e. filing of the grounds of appeal, is not performed. 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.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The application is to be treated as a divisional application of European patent application No. YY YYY YYY.Y.

The Registrar: The Chairwoman:

C. Eickhoff P. Schmitz

Decision electronically authenticated