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Datasheet for the decision of 13 December 2016

Case Number: J 0013/14 - 3.1.01

Application Number: XXXXXXXX.X

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

...

Applicant:

N.N.

Headword:

Relevant legal provisions:

EPC Art. 14(1), 14(2), 14(3), 70(2), 76(1), 90, 112(1)(a), 123(2)
EPC R. 36(2), 57(a), 58, 139
EPC 1973 R. 4

Keyword:
Application filed in the language of the earlier application (no) - translation required or admissible (no) - correction of inadmissible language (no) - amendment of inadmissible language (no) - application treated as divisional application (no)

Decisions cited:
G 0001/05, G 0004/08, G 0001/12, J 0005/81, J 0011/91, J 0022/95, J 0002/01, J 0017/04, J 0018/04, J 0026/10, J 0004/11, T 0271/85, T 0198/88, T 0642/12

Catchword:

1. For the purposes of Article 76(1), first sentence, and Rule 36(2), first sentence, EPC, a European divisional application of an earlier European patent application which was filed in an EPO official language must also be filed in the EPO official language of the earlier application. Otherwise, it is filed in an inadmissible language. In this case a correction of the language deficiency by means of a translation into the language of the proceedings for the earlier application is neither required under Rule 36(2), second sentence, EPC nor is it even admissible in view of the wording of that provision and the Enlarged Board's decision G 4/08. Nor is it possible for the applicant to remedy the language deficiency in its divisional application by means of a correction under Rule 139, first sentence, EPC or by means of an amendment under Article 123(2) EPC.

2. In accordance with the established jurisprudence of the boards of appeal, a European divisional application which was filed in an inadmissible language cannot be treated as a valid divisional application by analogous application of Article 90(2) EPC.

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Office européen des brevets

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Case Number: J 0013/14 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 13 December 2016

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: **Decision of the Receiving Section of the European Patent Office posted on 27 January 2014.**

Composition of the Board:

Chairwoman C. Vallet
Members: T. Karamanli
B. Müller

Summary of Facts and Submissions

I. On 1 October 2010, the present European patent application No. XX XXX XXX.X ("the application") was filed in **English** as a **divisional application** relating to the earlier European patent application No. YY YYY YYY.Y ("the parent application").

II. The **parent application** was filed in **German** as an international application on 30 October 2001 and was also published in **German** as ZZ ZZ/ZZZZZ A1.

On entry into the regional phase of the parent application before the EPO on 30 April 2003, the applicant ticked the first box underneath heading 7 entitled "Translations" of EPO Form 1200, and filed an **English translation** of the application documents as originally filed (cf. text for that box). In a letter dated 26 June 2003 and received on 27 June 2003, the appellant's representative clarified that the documents of the international application **as filed** formed the basis of the proceedings in the regional phase before the EPO. The EPO used **German** as the language of the proceedings in all its communications.

The mention of grant of a patent on the basis of the parent application was published on ....

III. By EPO communication pursuant to Rule 58 EPC or Rule 159 EPC (EPO Form 1050B) dated 4 November 2010, the Receiving Section informed the applicant in ANNEX B that "Some/The sheets" of the present application as filed contained "alterations or too many erasures (R. 49(12) EPC)". The applicant was requested to remedy this deficiency within two months after notification of this communication. The communication also contained

the note that, if the specified deficiency was not remedied in due time, the application was to be refused in accordance with Article 90(5) EPC.

IV. On 28 January 2011, the Receiving Section issued a communication entitled "Noting of loss of rights pursuant to Rule 112(1) EPC" (EPO Form 1044), informing the applicant: "*The above-mentioned European patent application is not being processed as a European divisional application (Rule 36(1) EPC),...*". The reasons for this finding were typed in the form and read as follows: "*see in NB below.*" and "*NB= the divisional application has NOT been filed in the language (GERMAN) of proceedings of the parent application.*"

V. By a reply dated 7 April 2011, the applicant requested an appealable decision and filed submissions which were to be taken into account in the requested decision. It filed further submissions by letters dated 2 October 2012 and 21 June 2013.

VI. On 27 January 2014 the Receiving Section issued an appealable decision.

The Receiving Section decided that

- the application was "not treated as valid European divisional patent application (Art. 90(2) and R. 36(2) sentence 1 EPC)",
- the request for correction under Rule 139 EPC was refused, and
- all fees paid for the application without a legal basis, if any, would be refunded once the decision had become final.

The reasoning of the decision under appeal can be summarised as follows:

In accordance with Article 14(3) EPC, the language of the proceedings of the application was **English** since it had been filed in that official language of the EPO.

The application did not fulfil the requirements of Article 76(1), first sentence, EPC and Rule 36(2), first sentence, EPC because, although the language of the proceedings of the parent application was **German**, the application was filed in **English** and thus not in the language of the proceedings of the parent application. Severe formal deficiencies in a divisional application could entail as a consequence that the application was invalid, i.e. had no legal effect, and accordingly was "not treated as valid divisional application by analogous application of Article 90(2) EPC (cf. G 1/05, op. cit., at 2.4; J 18/04, OJ EPO 2006, 560, at 39)". The principles of good faith did not apply since there was nothing in the first-instance proceedings that had violated the reasonable expectations of the applicant in the proceedings. Consequently, the application could not be treated as a valid divisional application by analogous application of Article 90(2) EPC.

The applicant's request under Rule 139 EPC that the application documents originally filed in English be replaced by the same documents in German was refused because choosing a "wrong" language for a document to be filed with the EPO and thus filing the document in an inadmissible language could not be equated with a "linguistic error" for the purposes of Rule 139 EPC (cf. T 642/12, point 28 of the Reasons).

VII. On 7 April 2014 the appellant filed a notice of appeal against the decision of the Receiving Section. The appeal fee was paid on the same date.

VIII. The statement setting out the grounds of appeal was filed on 6 June 2014.

IX. In its communication under Article 15(1) RPBA accompanying the summons to oral proceedings, the board expressed its preliminary opinion that, in the light of the applicable EPC provisions and the relevant jurisprudence, Rule 36(2) EPC did not provide for the alternative option to file a divisional application in an EPO official language other than the EPO official language in which the parent application had been filed and to file a translation into the language of the proceedings for the parent application at a later stage. Rather, the present application seemed not to fulfil the requirements of Article 76(1), first sentence, EPC and Rule 36(2), first sentence, EPC. It appeared that this deficiency in the present application with regard to the language could not be corrected and thus that there was no obligation for the EPO under Article 90(4) EPC to give the applicant an opportunity for correction. The board also indicated that adding another reason in EPO Form 1044 did not appear to be a procedural violation, which would justify setting aside the decision under appeal. Regarding the legal consequence of the failure to fulfil the requirements of Article 76(1), first sentence, and Rule 36(2) EPC, the board took the view that it would have to be discussed whether the present application should have been refused by analogous application of Article 90(3) and (5) EPC instead of not being treated as a valid divisional application by analogous application of Article 90(2) EPC. In the

board's view, however, the appellant's request seemed unallowable and, consequently, its appeal would have to be dismissed.

X. Oral proceedings were held before the board on 13 December 2016. They were not public.

During the oral proceedings the appellant handed in the following questions to be referred to the Enlarged Board of Appeal under Article 112 EPC:

" *- Do Art. 90(3) and (4) also apply to Rule 36(2) 1. sentence in case the applicant inadvertently filed a Divisional Application in an Official Language other than the Official Language of the earlier application?*

- In case the answer is no, is a correction of the application in view of languages possible under Rule 139?"

The appellant requested that
- the questions filed during the oral proceedings before the Legal Board be referred to the Enlarged Board of Appeal,
- the decision under appeal be set aside and the case be remitted to the Receiving Section for treatment of the application as a divisional application, and
- the appeal fee be reimbursed.

XI. The appellant's arguments, as far as they are relevant for the present decision, may be summarised as follows:

(a) The present application was filed in an inadmissible language in view of the provisions of Article 76(1) and Rule 36(2) EPC. However, no legal consequence was specified in Rule 36(2) EPC in the

event that the divisional application was, for example, filed in an official language other than the language of the parent application. It was only said that if the earlier application was not filed in an EPO official language the divisional could be filed in this language of the earlier application.

It was then mandated by Rule 36(2) EPC that a translation into the language of the proceedings must be filed within two months from the filing of the divisional application. This meant that, according to this rule, even if the parent application was, for example, already in an official language, it still was possible to use a language other than this official language and then to file the translation at a later time.

Further, compared to the wording of Rule 4 EPC 1973, the term "must" was replaced by the weaker expression "shall" in Rule 36(2) EPC. This amendment had to be considered, as did the possibility under Rule 4 EPC 1973 of filing a translation of the divisional application in a corresponding official language.

The Guidelines A-IV, 1.3.3, referred in particular to the language requirements for a divisional application and stated that "it is possible that a parent application was filed in a non-official language, but that the applicant may no longer use this non-official language for a divisional application." This statement contradicted Rule 36(2) EPC. This was also valid for the Guidelines A-VIII, 1.3, which stated that the applicant could not use the non-official language of the parent application for filing a divisional application.

(b) The appellant should be allowed to remedy the language deficiency in its application.

(i) Article 90 EPC corresponded to examination on filing and examination as to formal requirements. Article 90(2) EPC referred to the filing date and Article 76 EPC pertained to divisional applications, i.e. a divisional application should not contain subject-matter extending beyond the content of the earlier application. If this requirement was not fulfilled, correction was possible according to decision G 1/05, for example.

Furthermore, according to Article 90(4) EPC, in cases of deficiencies which could be corrected, the EPO should give the applicant an opportunity to correct them. According to Rules 57 and 58 EPC, if a translation required under Rule 36(2) EPC was not filed within the prescribed period, the applicant was invited to correct this deficiency. In order to avoid discriminating against an applicant who filed a divisional application in an EPO official language other than the EPO official language of the parent application, a corresponding correction of this deficiency should have been requested by the EPO after receiving the present application. In the present case, it also followed from the EPO communication pursuant to Rule 58 EPC or Rule 159 EPC (EPO Form 1050B) dated 4 November 2010 that a date of filing had

been accorded to the present application. Therefore, the EPO should have examined the language requirements during the examination as to formal requirements in accordance with Article 90(3) and Rule 57(a) EPC and should have informed the applicant of the language deficiency and invited it to correct this deficiency in accordance with Article 90(4) and Rule 58 EPC, as it had done with regard to the deficiency specified in its communication dated 4 November 2010.

Regarding Rules 36(2) and 58 in connection with Rule 57 EPC, the error was not grave in view of such a difference of languages, as it was still possible, for example, to file a translation into an EPO official language for an application submitted in a non-official language. Accordingly, where an applicant had filed an application in one EPO official language, it should also be given the opportunity to file a translation of it into another EPO official language.

(ii) Another basis for remedy was Rule 139, first sentence, EPC or Article 123(2) EPC in view of decision G 1/05.

The appellant did not intend to file the application in the wrong language. This was a mistake in the application and the appellant should be allowed to correct that mistake under Rule 139, first sentence, EPC.

In decision G 1/05, there was a general reference to a "Right to Amend". In particular, it was said in point 3.2 of the Reasons that for all applications "it is an important principle under the EPC that the question whether or not an application complies with the substantive requirements of the EPC is to be decided on the text finally submitted or agreed by the applicant after any objections have been drawn to his attention and he has been afforded an opportunity to comment and also an opportunity to overcome the objection by means of an amendment". Further, it was held in point 3.3 of the Reasons that this principle of affording an opportunity for amendment would apply unless there was some specific provision to the contrary. However, there was no such contrary provision in the EPC. In point 3.4 of the Reasons, it was further said that not complying with a provision could not raise an automatic presumption that the application was to be refused without any prior possibility of amendment being afforded to the applicant. According to Article 123 EPC, it was possible to amend a European patent application in proceedings before the EPO, in accordance with the Implementing Regulations, and, in any event, the applicant should be given at least one opportunity to amend the application of his own volition. Article 123(2) EPC only stated that a European patent application could not be amended in

such a way that it contained subject-matter which extended beyond the content of the application as filed. However, submitting a translation of the application in another EPO official language was of course not a violation of Article 123(2) EPC.

(iii) To summarise, the filing of the divisional application in a language other than the EPO official language of the parent application was not a grave error which was excluded from correction under the EPC, and the applicant should therefore have the opportunity to overcome a corresponding objection by means of a correction or an amendment.

(iv) If the board did not consider Article 90(3) and (4) EPC applicable to Rule 36(2), first sentence, EPC or a correction under Rule 139 EPC to be possible, the questions filed in oral proceedings before the board should be referred to the Enlarged Board of Appeal under Article 112 EPC since they concerned an important point of law.

(c) The principle of legitimate expectations was not being relied on.

(d) The finding in the decision under appeal on the legal consequences of filing the application in the wrong language was not correct. No legal consequence was specified in Rule 36(2) EPC in the event that the divisional application was, for example, in an EPO official language other than the language of the parent application. Cited decision

J 2/01 did not refer to requests concerning language, but only to substantive requests for an application.

Moreover, the reasons for not processing an application as a divisional application were all listed in EPO Form 1044. This form was not intended to allow the addition of other reasons for not processing a patent application as a European patent application, such as those added in the present case in the EPO Form 1044 dated 28 January 2011.

XII. At the end of the oral proceedings, the chairwoman announced the board's decision.

Reasons for the Decision

Admissibility of the appeal

1. The appeal is admissible.

Allowability of the appeal

2. The first question in this appeal case is whether the present application fulfils the EPC language requirements for divisional applications.

3. Applicable EPC provisions

3.1 It is established jurisprudence of the boards of appeal that a divisional application is a new application which is separate from and independent of the earlier application. Therefore, divisional applications are to be treated in the same manner as ordinary applications and are subject to the same requirements, unless

specific provisions of the EPC require something different (see G 1/05, OJ EPO 2008, 271, points 3.1, 8.1, 9.1 of the Reasons).

3.2 The present application was filed on 1 October 2010, i.e. after entry into force of the revised European Patent Convention (EPC) on 13 December 2007. Thus, on the latter date, the present application was not pending. Therefore the transitional provisions do not apply in accordance with Article 7(1), second sentence, of the Revision Act of 29 November 2000 and the decisions of the Administrative Council of 28 June 2001 (Special edition No. 1, OJ EPO 2007, 197) and 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89). However, said transitional provisions do apply to the parent application, which was pending at the time the revised EPC entered into force.

3.3 Since the present application was filed as a divisional application on 1 October 2010, the applicable provisions are those of Rule 36(2) EPC, as amended by the Decision of the Administrative Council CA/D 2/09 of 25 March 2009 (OJ EPO 2009, 296), which **entered into force on 1 April 2010** (cf. Article 1, point 1, and Article 2, points 1 and 2, of said decision). The respective version of this provision is of relevance because Rule 36(2) EPC as in force **before** 1 April 2010 allowed the filing of a divisional application only in the language of the proceedings for the earlier application, irrespective of whether the language of filing of the earlier application was an EPO official language or not.

4. Language of the proceedings

4.1 Present application

The present application was filed in **English**, which is one of the EPO official languages pursuant to Article 14(1) EPC. Article 14(3) EPC stipulates that the EPO official language in which the European patent application is filed must be used as the language of the proceedings in all proceedings before the EPO. Accordingly, the language of the proceedings in the present case is **English**. This means that, in written proceedings on the present application, EPO departments cannot use an EPO official language other than **English** (see also G 4/08, OJ EPO 2010, 572, Headnote, Question 2, and section 4 of the Reasons).

4.2 Parent application

The parent application was filed and published as an international patent application under the PCT in **German**, which is one of the EPO official languages pursuant to Article 14(1) EPC 1973. Therefore, a translation of the international application was not to be filed under Article 22(1) PCT and Article 158(2) in conjunction with Rule 107(1)(a) EPC 1973. Accordingly, **German** is the language of the proceedings for the parent application.

5. Language regime with respect to the filing of a divisional application

5.1 Article 76(1), first sentence, EPC provides that a European divisional application must be filed directly with the EPO "in accordance with the Implementing Regulations".

The language regime for divisional applications is laid down in the first and second sentences of Rule 36(2) EPC, which read:

"*A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application.*"

5.2 The first sentence of Rule 36(2) EPC lays down the principle that a divisional application must be filed in the language of the proceedings for the earlier application. However, there is an **exception** to this strict legal obligation **if the earlier application was not filed in an EPO official language**. In this case, the second sentence of Rule 36(2) EPC foresees the additional possibility of filing a divisional application in the non-EPO language of the earlier application, provided a translation into the language of the proceedings for the earlier application (which is one of the EPO official languages) is then filed within two months of the filing of the divisional application.

5.3 The first and second sentences of Rule 36(2) EPC clearly deal with two different factual situations and their wording is unequivocal on the language in which a divisional application must be filed in each respective situation. This wording also shows that only the first sentence of Rule 36(2) EPC applies in the present case, where the parent application was filed in German, thus

in an EPO official language. It follows clearly from the foregoing that the present application should have been filed in no other language than **German** in order to meet the requirements of Article 76(1), first sentence, and Rule 36(2), first sentence, EPC. Therefore, the present application was filed in an inadmissible language.

6. Allowability of filing a translation of the present application into the correct EPO official language

6.1 The appellant essentially argued that, even in a case where the earlier application was filed in an EPO official language, it was still possible under Rule 36(2) EPC to use a language other than this EPO official language for the divisional application and to file the translation into the EPO official language of the earlier application at a later point in time.

6.2 The board notes that, first of all, it follows from the above that the unambiguous wording of the second sentence of Rule 36(2) EPC excludes the appellant's interpretation that this provision also applies where the earlier application was filed in an EPO official language. The second sentence of Rule 36(2) EPC requires a translation only if a divisional application is filed in the original non-EPO language of the earlier application. However, that is not the case here.

6.3 The appellant's interpretation is furthermore not supported by the explanatory remarks to the amendment of Rule 36(2) EPC which entered into force in 2010 (CA/145/08, page 8). The relevant part concerning the language of divisional applications reads:

"*The text of Rule 36(2) in force since December 2007 says that a divisional application must be written in the language of the proceedings for the earlier application in order to simplify and streamline the procedure. In practice, divisional applications have virtually always been filed in the language of the proceedings for the parent application, even though EPC 1973 allowed them to be filed in the original language of the parent application, for instance Spanish or Dutch.*

However, the option of using any language for filing European patent applications could have increased demand for divisional applications in the original language of the parent application, given that Article 14(2), second sentence, EPC allows the translation of an application to be adapted to the original text at any stage of the grant procedure. But Rule 36(2) EPC as currently worded has eliminated the possibility of adapting the divisional application, which has to be filed in the language of the proceedings for the parent application, to the latter's original text, which of course forms the basis for the wording of the divisional application. Moreover in the case of divisional applications filed under Rule 40(2) and (3) EPC with a reference to the earlier European application in a non-EPO language, it is fundamentally unsatisfactory to have to refer not to the original text of the earlier application but to its translation into the language of the proceedings. It is therefore proposed that Rule 36(2) EPC be amended to enable divisional applications to be filed in the language of the proceedings or the original language of the parent application."

The text does not explicitly say that the "original language of the parent application" must have been a non-EPO language. However, Spanish and Dutch, the two languages given as examples of the "original language of the parent application", are not EPO official languages. Moreover, the text refers to Article 14(2), second sentence, EPC, which "*allows the translation of an application to be adapted to the original text at any stage of the grant procedure*".

However, the second sentence of Article 14(2) EPC has to be read together with its first sentence. Article 14(2), first sentence, EPC, stipulates that "*[a] European patent application shall be filed in one of the EPO official languages, or, if filed in any other language, translated into one of the EPO official languages in accordance with the Implementing Regulations.*" Thus a translation only has to be filed if the "original language" of an application is not one of the EPO official languages. Finally, the text of the explanatory remarks clearly distinguishes between the language of the proceedings for the earlier application and its original language; see for example the very last sentence of the explanatory remarks. If, however, the earlier application is filed in one of the EPO official languages, then, pursuant to Article 14(3) EPC, this language must be used as the language of the proceedings in all proceedings before the EPO. That means that, in such cases, there is no difference between the language in which the earlier application was filed and the language of the proceedings for it. The only case in which the (non-EPO) language in which the earlier application was filed differs from the language of the proceedings for it under Article 14(3) EPC is where the application has to be translated into

one of the EPO official languages in accordance with Article 14(2) EPC.

6.4 In the light of the foregoing, the board cannot share the appellant's view that Rule 36(2) EPC provides for the alternative option to file a divisional application in an EPO official language other than the EPO official language in which the earlier application was filed (i.e. the language of the proceedings for the earlier application) and then to file a translation into the language of the proceedings for the earlier application at a later time.

6.5 The appellant's interpretation of Rule 36(2) EPC would also go against the ruling of the Enlarged Board of Appeal on the language of the proceedings.

In its decision G 4/08, the Enlarged Board ruled that if an international application has been filed and published under the PCT in an official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages, and it clarified that EPO departments cannot use, in written proceedings on a European patent application or an international application in the regional phase, an EPO official language other than the language of the proceedings used for the application under Article 14(3) EPC (G 4/08, Headnote, Questions 1 and 2, points 2 to 4 of the Reasons).

It is true that, in decision G 4/08, the primary question was whether, for an international application which was filed and published in an EPO official language, the applicant can, on entry into the European phase, choose another EPO official language by filing a

translation of the international application in a different official language (see point 2, in particular, point 2.2 of the Reasons). However, the Enlarged Board noted that the basis for answering this question was Article 14(3) EPC 1973 and that this provision assumed "*a language of filing that has already been defined and will be the language of the subsequent proceedings*" (points 2.1 and 2.2 of the Reasons). In point 2.4 of the Reasons, the Enlarged Board referred to the principle of equivalence between European applications and international ones for which the EPO acts as designated or elected Office, which was expressly laid down in Article 150(3) EPC 1973 and implemented in particular by Article 158 EPC 1973, and held: "*Under Article 150(3) EPC 1973, an international application for which the EPO acts as designated or elected Office is deemed to be a European application. Allowing a change of language when a Euro-PCT application published in an EPO official language enters the regional phase would mean supposedly identical applications being treated differently depending on whether they are international or direct European filings.*" The Enlarged Board also analysed the provisions of "EPC 2000" (G 4/08, point 3 of the Reasons) and concluded in point 3.11 of the Reasons that the EPC 2000 could not be interpreted "as allowing, on entry into the European phase, a Euro-PCT application published in an EPO official language to be replaced by its translation into another such language".

For the sake of completeness, it should also be mentioned that the Enlarged Board referred to some decisions by EPO boards of appeal which had allowed the language of the proceedings to be changed. However, the Enlarged Board held that the abolition of Rule 3(1) EPC

1973, which entered into force on 1 June 1991, removed all legal basis for the previous practice and that the texts in force left no room for a free interpretation which would be tantamount to restoring Rule 3 EPC 1973 (G 4/08, point 4 of the Reasons, in particular, points 4.5 and 4.10).

Finally, the board refers to G 4/08, point 2.4 of the Reasons, where it is held: "*Language is not a mere procedural matter, after all; it goes to the heart of the patent's substance. Translations are – legitimately – suspect; that justifies precautions, exemplified by the way in which the original application remains the point of reference in case of translation (Article 14(2) EPC) and by Rule 46.3 PCT governing the language of amendments.*" In the board's view, these considerations apply equally to the translation of an application filed as a divisional application. This is clearly reflected in the provisions of Rule 36(2) EPC. In case of a translation under Rule 36(2), second sentence, EPC the original parent and the original divisional application also remain the point of reference (see Article 70(2) EPC).

6.6 The board accordingly concludes from the above interpretation and explanation by the Enlarged Board of the relevant EPC provisions that, if a direct European patent application has been filed in an EPO official language, which is then the language of the proceedings, it is not possible to change this language in the subsequent proceedings by translating the application into another EPO official language. In the board's view, the same applies to a direct European patent application filed as a divisional application and, therefore, the appellant's interpretation of Rule 36(2), second sentence, EPC must fail.

6.7 The board now turns to the appellant's argument on Rule 4 EPC 1973. This provision likewise concerns the language of a European divisional application, but under the EPC 1973, and reads:
"*European divisional applications or, in the case referred to in Article 14, paragraph 2, the translations thereof, must be filed in the language of the proceedings for the earlier European patent application.*"

The board takes the view that there is no difference in substance between the term "must" in Rule 4 EPC 1973 and the term "shall" in Rule 36(2) EPC. This also follows clearly from the other two language versions of the latter provision, where the terms "ist ... einzureichen" and "doit être déposée" are used. Moreover, in the revised EPC the term "must" in the provisions of EPC 1973 has been replaced by the term "shall" without any change in substance according to the respective travaux préparatoires (see for example Articles 76(1) and 83 EPC). It is also clear from the reference to Article 14(2) EPC 1973 in Rule 4 EPC 1973 that the translation of European divisional applications which were filed in an admissible non-EPO language in accordance with Article 14(2) EPC 1973 had to be filed in the language of the proceedings for the earlier European patent application. Quite apart from that, Rule 4 EPC 1973 is not applicable to the present case (see point 3.2 above).

6.8 Regarding the appellant's submissions on the correctness of the Guidelines A-IV, 1.3.3 and A-VIII, 1.3, the board first notes that it is not bound by the Guidelines. Apart from that, the appellant cited a version of the Guidelines which reflects the provisions

of Rule 36(2) EPC as in force **before** 1 April 2010, which allowed the filing of a divisional application **only** in the language of the proceedings for the earlier application, irrespective of whether the language of filing of the earlier application was a non-EPO language.

The respective parts of the Guidelines for Examination in the European Patent Office (**status April 2010**) obviously took into account Rule 36(2) EPC as in force **on** 1 April 2010. They read:

"*Language requirements*

As indicated in VIII, 1.3, a divisional application must be filed in the language of the proceedings of the parent application. Alternatively, if the earlier (parent) application was filed in a language other than an official language of the European Patent Office, the divisional application may be filed in that language. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see III, 14)." (A-IV, 1.3.3), and
"*Any European divisional application must be filed in the language of the proceedings of the earlier application from which it is divided. Alternatively, if the earlier (parent) application was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see A-III, 14).*" (A-VIII, 1.3)

6.9 It follows from the above that it is not correct to say that a translation of the present application into the language of the proceedings for the parent application is required under Rule 36(2), second sentence, EPC. Nor is such translation admissible in view of the wording of Rule 36(2) EPC and the Enlarged Board's decision G 4/08.

7. Remedy of the language deficiency by means of a correction or an amendment under the EPC

Since the present application was filed in English and thus not in an admissible language as explained above, it contains a deficiency with regard to the language. The appellant argued that this deficiency could be remedied by means of a correction or an amendment, and based its view on different lines of argument (see point XII, (b), (i)-(iii) above). However, the board does not share the appellant's view for the reasons set out below.

7.1 Correction in reply to an invitation from the EPO under Rule 58 EPC in conjunction with Rule 57(a) EPC

Article 90(4) EPC stipulates that, where the EPO in carrying out the examination under Article 90(1) or Article 90(3) EPC notes that there are deficiencies which may be corrected, it must give the applicant the opportunity to correct them. Hence, Article 90(4) EPC concerns **correctable** deficiencies which were noted during the examination under Article 90(1) or (3) EPC.

If the European patent application has been accorded a date of filing, the EPO must examine, in accordance with Article 90(3) EPC, whether a translation of the application required under Rule 36(2), second sentence,

EPC has been filed in time (Rule 57(a) EPC). Where the EPO notes that this requirement of Rule 57(a) EPC has not been complied with, it informs the applicant accordingly and invites him to correct this deficiency within two months (Rule 58, first sentence, EPC).

In the board's view, a correction of the language deficiency in the present application under Rule 58 in conjunction with Rule 57(a) EPC is not possible since these provisions do not apply. The reason for this is that a correction of the language deficiency in the present application by a translation into the language of the proceedings for the parent application is neither required under Rule 36(2), second sentence, EPC nor admissible for the reasons explained under point 6 above. Thus the language deficiency in the present application cannot be corrected. Consequently, there is no legal basis in the EPC upon which the EPO could have invited the applicant to correct this deficiency.

7.2 Nor is a correction under Rule 139 EPC or an amendment under Article 123(2) EPC possible. In the board's view, the Enlarged Board's interpretation and explanation of the relevant EPC provisions in its decision G 4/08 apply *mutatis mutandis* where an applicant wishes to change the language of the proceedings by means of a correction under Rule 139, first sentence, EPC or by means of an amendment under Article 123(2) EPC. Therefore, the "Right to Amend" in decision G 1/05 does not exist with regard to the language of the proceedings.

Moreover, in the present case, the conditions would not be met for a correction of a "linguistic error" under Rule 139 EPC or for an amendment according to Article 123(2) EPC.

As to Rule 139 EPC, choosing the "wrong" language for a document to be filed with the EPO cannot be equated with a "linguistic error" for the purposes of Rule 139, first sentence, EPC (see also T 642/12, point 28 of the Reasons). The same must apply if the intended correction concerns the description, claims or drawings (Rule 139, second sentence, EPC).

According to Article 123(2) EPC, the European patent application may be amended. It may still be amended during examination proceedings so as to comply with the requirements of Article 76(1) EPC, provided, however, that the amendment complies with the other requirements of the EPC (see G 1/05, point 7 of the Reasons). Such a requirement is laid down in Rule 3(2) EPC, which stipulates that amendments to a European patent application have to be filed in the language of the proceedings. The board concludes from this that the language of the proceedings cannot be changed by means of an amendment under Article 123(2) EPC.

8. Legitimate expectations

The issue of legitimate expectations was addressed in the decision under appeal (see points 11 to 12 of the Reasons). The appellant has provided no arguments as to why this finding was wrong and even confirmed during the oral proceedings before the board that it was not relying on this procedural principle. Thus there is no reason for the board to deal with this issue in its decision.

9. Legal consequences of non-compliance with the language requirements

9.1 The board understands from the appellant's submissions that it objects to the finding in the decision under appeal that "*[s]evere formal deficiencies in a divisional application may entail as consequence that the application is invalid, i.e. has no legal effect and accordingly it is not treated as valid divisional application by analogous application of Article 90(2) EPC (cf. G 1/05, op. cit., at 2.4; J 18/04, OJ EPO 2006, 560, at 39).*" The appellant argued that no legal consequence was specified in Rule 36(2) EPC in the event that the divisional application was, for example, filed in an EPO official language other than the EPO official language in which the earlier application was filed. It also submitted that decision J 2/01 did not refer to language requirements. Rather, a correction of the deficiency in respect of the language requirements was possible according to decision G 1/05 (in particular, points 3.2 to 3.4 of the Reasons).

9.2 Under Article 90(1) EPC, the EPO is responsible for examining whether, on filing, a European patent application satisfies the requirements for the accordance of a date of filing. These requirements for a filing date are laid down in Article 80 EPC and the related provisions of the Implementing Regulations. However, since the present application was filed as a divisional application, it must first and foremost comply with the specific requirements of Article 76(1), first sentence, EPC and the related provisions of the Implementing Regulations, which contain conditions within the meaning of Article 4G(2), second sentence, Paris Convention. It is established EPO jurisprudence that if these specific requirements are not fulfilled, this situation is comparable to the case dealt with in Article 90(2) EPC, so that an analogous application of that provision is justified, with the legal consequence

that the application at issue is not to be dealt with as a divisional application (see J 2/01 and J 18/04, point 39 of the Reasons, referring to J 11/91, point 4.2 of the Reasons; this last decision has been followed in later decisions such as J 26/10 and J 4/11).

9.3 As far as decision G 1/05 is concerned, it has to be noted that one of the questions the Enlarged Board ruled upon was whether it would indeed follow from accepting the "invalidity" of a divisional application **containing added matter** that such an application could not be made valid by a later amendment removing the added matter with retroactive effect (emphasis added). The passages cited by the appellant concern this issue and, indeed, it was decided that a divisional application which at its date of receipt contains subject-matter extending beyond the content of any earlier application as filed can be amended later in order that its subject-matter no longer so extends, even at a time when the earlier application is no longer pending.

However, the Enlarged Board acknowledged that severe formal deficiencies in an application as filed may thus, even if only in the extreme case and if so provided in the EPC, entail as a consequence that the application has no legal effect (G 1/05, points 2.3 and 2.4 of the Reasons). Moreover, as explained above, under the EPC provisions and in the light of decision G 4/08, amending the language of the proceedings for the present application is not possible.

9.4 The appellant further argued that EPO Form 1044, which was used for the EPO communication dated 28 January 2011 (see point IV above), contained a pre-

printed exhaustive list of reasons for not processing an application as a divisional application and that, therefore, a further reason for such non-processing could not be added. The board notes that it is the EPC that provides the law governing the processing of European patent applications, and not any form that the EPO may have created, including EPO Form 1044. The contents of any such form must be properly based on the EPC. Apart from that, the board does not share the appellant's view that EPO Form 1044 entitled "Noting of loss of rights pursuant to Rule 112(1) EPC" contains an exhaustive list of reasons which justify not processing an application as a divisional. There is no indication of an exhaustive list in that form. Although one could argue that the sentence added to it does not refer to the relevant EPC provision, i.e. Rule 36(2) EPC, the information as such must have been clear and unambiguous for the applicant, as can be seen from its reply dated 7 April 2011. Moreover, there is nothing in the form issued to the applicant which might have justified a different interpretation of the text of the EPO form in accordance with the principle of the protection of legitimate expectations. Therefore, the present case differs from that underlying decision J 17/04, in which the pre-printed text in the EPO form at issue (EPO Form 1001) was ambiguous and could be misinterpreted.

9.5 For the above reasons and in accordance with the above-cited established jurisprudence, the present application cannot be treated as a valid divisional application by analogous application of Article 90(2) EPC because it does not fulfil the requirements of Article 76(1), first sentence, and Rule 36(2), first sentence, EPC.

10. Request for referral to the Enlarged Board of Appeal

10.1 The appellant requested that certain questions be referred to the Enlarged Board of Appeal (see point X above). The appellant based its request for a referral on the argument that an important point of law was concerned since the legal consequence of non-compliance of a divisional application with Rule 36(2) EPC was not regulated in the EPC, and that the matter touched on the possibility for the applicant to correct the language deficiency in its application, which was filed as a divisional application.

10.2 According to Article 112(1)(a) EPC, a board may, either of its own motion or following a request from a party, refer any question of law to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law, or if an important point of law arises.

10.3 An "important point of law" within the meaning of Article 112(1)(a) EPC 1973 arises if that point is of fundamental importance in that it is relevant to a substantial number of similar cases and is therefore of great interest not only to the parties to the appeal in hand but also to the public at large (see e.g. T 271/85, OJ EPO 1988, 341; G 1/12, OJ EPO 2014, A114, Reasons, point 11). However, even in such a situation, the board should make a referral only if it considers that a decision by the Enlarged Board is required. A question regarded as an important point of law does not need to be referred to the Enlarged Board of Appeal if the question can be answered beyond all doubt by the board itself (see for example J 5/81, OJ EPO 1982, 155; T 198/88, OJ EPO 1991, 254; J 22/95, OJ EPO 1998, 569).

10.4 The present board considers that cases in which the issue is a correction of an inadmissible language in which a divisional application has been filed will occur only extremely infrequently, so that the number of cases which might be negatively affected provides no reason for a referral. Moreover, the board dealt with the issues of whether Article 90(4) EPC or Rule 58 EPC in conjunction with Rule 57(a) EPC apply in the present case and whether a correction under Rule 139 EPC was possible (see section 7 above). The board was able to reach its conclusions on the basis of the wording of the provisions of the EPC and the existing EPO jurisprudence and to decide on these issues free from any doubt. Hence, no important point of law arises or needs to be clarified by the Enlarged Board of Appeal.

10.5 For the above reasons, the appellant's request for a referral to the Enlarged Board of Appeal must be refused.

11. Conclusion on the allowability of the appeal

In view of the above, the appellant's request that the case be remitted to the Receiving Section for treatment of the application as a divisional application is unallowable and, consequently, its appeal must be dismissed.

Request for reimbursement of the appeal fee

12. Pursuant to Rule 103(1)(a) EPC, a prerequisite for reimbursement of the appeal fee is that the appeal is deemed to be allowable. Since the appeal must be dismissed (see previous point 11), the appellant's request for reimbursement of the appeal fee is to be refused.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board of Appeal of the questions filed during the oral proceedings before the Legal Board is refused.

2. The appeal is dismissed.

3. The request for reimbursement of the appeal fee is refused.

The Registrar: The Chairwoman:

C. Eickhoff C. Vallet

Decision electronically authenticated