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Datasheet for the decision of 19 May 2020

Case Number: J 0014/18 - 3.1.01

Application Number: 16174992.4

Publication Number: 3117861

IPC: A61M16/06, A61M16/00, A61M16/08

Language of the proceedings: EN

Title of invention:
INTERFACE COMPRISING A ROLLING NASAL BRIDGE PORTION

Applicant:
Fisher&Paykel Healthcare Limited

Headword:

Relevant legal provisions:
EPC Art. 76(2), 76(1), 79(1), 79(3)
RPBA 2020 Art. 25, 12(3), 12(4), 12(6), 13(1)
RPBA Art. 12(4)

Keyword:
Divisional application - designation of contracting states
Late-filed facts - submitted with the statement of grounds of appeal - admitted (no) - submitted during oral proceedings - admitted (no)

Decisions cited:
G 0001/18

Headnote:
Under Article 76(2) EPC only those Contracting States that had been designated in the earlier application at time of filing the divisional can be designated in the divisional.

A designated state forfeited in the parent application at time of filing the divisional cannot be revived in the divisional one.

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Juristische Beschwerdekammer

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Case Number: J 0014/18 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 19 May 2020

Appellant: (Applicant)	Fisher&Paykel Healthcare Limited 15 Maurice Paykel Place East Tamaki, Auckland 2013 (NZ)
Representative:	Gill Jennings & Every LLP SAH The Broadgate Tower 20 Primrose Street London EC2A 2ES (GB)
Decision under appeal:	**Decision of the Examining Division of the European Patent Office posted on 22 May 2018 in which the request to include the designation of Great Britain as a validly designated state for application 16 174 992.4 was refused.**

Composition of the Board:

Chairman	W. Sekretaruk
Members:	J. Hoppe
	A. Jimenez

Summary of Facts and Submissions

I. The appeal of the applicant (appellant) lies against the decision of the examining division posted on 22 May 2018 in which the request to include the designation of Great Britain as a validly designated state for the application was refused. The background of the appealed decision is as follows.

II. The present application was received on 17 June 2016. It is a divisional application deriving from the earlier application (parent) with the application number EP 12770681.0.

III. In the earlier application (parent) the applicant withdrew the designation of Great Britain (UK) on 22 April 2016. The EPO confirmed this withdrawal with a communication dated 29 April 2016.

The earlier application (parent) was granted and published on 22 June 2016 as EP 2696926 B1 without listing Great Britain as designated state.

IV. The divisional application was published on 18 January 2017 as EP 3117861 A1 without listing Great Britain as designated Contracting State.

V. With a letter dated 23 February 2018 the applicant expressed, without reasoning, the opinion that all EPC states were designated for the divisional application. It further requested that the EPO confirmed in a formal decision which states were considered not to be designated.

VI. With a communication dated 12 March 2018 the examining division informed the applicant that with respect to the divisional application Great Britain did not belong to the designated states because the divisional application was received after the designation of Great Britain had been withdrawn in the earlier application (parent).

VII. In response to the communication the applicant stated with a letter dated 4 May 2018 that it did not have any further comments and requested an appealable decision.

VIII. In the appealed decision, dated 22 May 2018, the examining division refused to include the designation of Great Britain as a validly designated state in the divisional application because the divisional application was received after the designation of Great Britain had been withdrawn in the earlier application (parent).

IX. With the notice of appeal, filed on 20 July 2018, the appellant requested that the decision be set aside and that the designation of Great Britain be included in the divisional application.

X. In the grounds of appeal, filed on 28 September 2018, the appellant explained that the designation of Great Britain was mistakenly withdrawn in the parent case before filing the divisional application due to an obvious error of the applicant’s representative.

As the earlier application (parent) was granted in the meantime, the applicant sought to correct the missing designation of Great Britain as a validly designated state in this divisional application.

The applicant argued that the requirements for a correction of a designation as set out in the case law of the Boards of Appeal (J 7/90; J 16/08 and J 10/87) were fulfilled.

In particular, the withdrawal of Great Britain as designated state was erroneous and the request was made without undue delay after the error was discovered on 23 August 2017. Moreover, the applicant argued that the request for a decision dated 23 February 2018 was received in sufficient time to enable the publication of a warning within an A8 publication of the divisional application.

XI. With letter dated 23 November 2018 the appellant submitted a declaration indicating that "on the condition that any final decision relating to the status of designations reached in EP 17179765.7 is also applied to ..." the application on file "... we withdraw the appeal on this application...".

XII. With a communication dated 4 December 2018 the board informed the appellant that the conditional withdrawal of the application filed with the letter of 23 November 2018 was not admissible and did not take any legal effect in the present appeal proceedings.

XIII. With letter of 2 August 2019 the appellant confirmed its wish to continue the appeal proceedings in this case and presented further details, in particular with regard to its policy of filing divisional applications.

XIV. With letter of 15 April 2020 the appellant stated that its new submissions relating to a correction under Rule 139 EPC should be admitted because Article 12(4) RPBA 2007 instead of Article 12(4) RPBA 2020 had to be

applied. The board's discretion under Article 12(4) RPBA 2007 was limited, as the submissions had already been filed with the grounds of appeal. This submission could not have been presented earlier because the four parallel cases involving the same issue (J 12/18; J°13/18, J 14/18, J 3/20) were not dealt with by the same department of first instance which could have led to inconsistent conclusions. It was thus appropriate for the board to handle all the cases. Neither the Receiving Section nor the Examining Division were competent to make a decision in relation to the matter of reinstating a designated state as this was a matter of law.

Moreover, the appellant argued that Article 76(2) EPC did not specify that only the Contracting States designated in the earlier application shall be deemed to be designated. Instead, Article 76(2) EPC set the minimum number of possibly designated states.

XV. During the oral proceedings the appellant explained that the new submissions relating to Rule 139 EPC should be admitted because the appellant did not make any mistake.

Moreover, the appellant considered that the wording of Article 76(2) EPC did not exclude the designation of Contracting States in a divisional application even if the designation of these states had already been withdrawn in the earlier application at the time of filing the divisional application.

Furthermore, the appellant stated that it had relied on the communication dated 10 August 2016. With that communication the EPO had informed the designated inventors inter alia about the designated states in the

divisional application. The EPO had listed Great Britain as designated Contracting State in that communication, although Great Britain had been withdrawn in the parent application before filing the divisional application. The applicant had trusted this information and therefore did not recognize the erroneous withdrawal of designated Contracting States in the parent application earlier. The principle of the protection of legitimate expectations would thus require the designation of further Contracting States in the divisional application. The appellant further stated that this new objection and the facts underlying it had not been presented earlier because the communication dated 10 August 2016 only came to light when preparing the oral proceedings.

XVI. The appellant finally requested that the decision under appeal be set aside and that the designation of Great Britain be included in the divisional application as validly designated state.

Reasons for the Decision

1. Article 76(2) EPC

1.1 As correctly pointed out in the appealed decision, the inclusion of Great Britain as validly designated state in the divisional application on file was not possible because the appellant had withdrawn the designation of this state in the earlier application (parent) previously, before the time of filing the divisional application.

1.2 According to Article 76(2) EPC all the Contracting States designated in the earlier application (parent) at the time of filing of a European divisional application shall be deemed to be designated in the divisional application. The appellant considered that the wording of this provision does not exclude the designation of Contracting States in a divisional application even if the designation of these states had already been withdrawn in the earlier application at the time of filing the divisional application.

1.3 The appellant's assumption is based on an arbitrary interpretation of the wording of Article 76(2) EPC. This view ignores that the EPC, and thus Article 76(2) EPC, has to be interpreted in accordance with the rules of interpretation as laid down in the Vienna Convention concluded on 23 May 1969 (G 1/18, OJ 2020, 26, reasons III). From Articles 31 and 32 Vienna Convention it follows that the provisions of a treaty (in this case the EPC) initially have to be interpreted in accordance with the "ordinary" meaning to be given to the terms in their context and in the light of the treaty's object and purpose (G 1/18, OJ 2020, 26, reasons III). Moreover, it follows from Article 32 Vienna Convention that the travaux préparatoires and the circumstances in which the EPC was concluded have to be taken into consideration in order to confirm a meaning or to determine a meaning when the initial interpretation according to the ordinary meaning would lead to an ambiguity or an absurd result (G 1/18, OJ 2020, 26, reasons III).

1.3.1 The appellant seems to understand the wording of Article 76(2) EPC to mean that it merely restricted the legal fiction that all the Contracting States

designated in the earlier application (parent) at the time of filing of a European divisional application are designated in the divisional, without limiting the applicant's possibility to explicitly designate further states in the divisional.

However, the wording of Article 76(2) EPC rather requires a different interpretation that would limit the designation of states not only as regards the legal fiction but in general to those designated in the parent application at the time of filing the appeal. The fact that the application is referred to as a "divisional" application implies by definition that it is divided from the earlier application and thus at the time of filing it cannot be broader than the earlier application it derives from. Only after the filing of the divisional application is its fate separated from changes concerning the earlier application. Therefore, only after the filing of the divisional application the withdrawal of designated states for the earlier application no longer has any influence on the proceedings concerning the divisional application.

1.3.2 The required systematical interpretation of Article 76(2) EPC involves establishing its meaning, considering its position and functions within a coherent group of related legal norms. In this context, it needs to be noted once again that the nature of a divisional application, which is derived from a parent application thereby benefiting from the parent's date of filing and priority rights, implies that the divisional cannot be broader then the parent application, neither its subject-matter (Article 76(1) EPC) nor its geographical cover. Thus, for a systematical interpretation of Article 76(2) EPC, Article 79 EPC, which governs the requirements for the

designation of Contracting States in the earlier application (parent), has to be taken into account.

Article 79(1) EPC establishes that all the Contracting States party of the Convention at the time of filing the European patent application shall be deemed to be designated in the request for grant of a European patent. According to Article 79(3) EPC the applicant may also withdraw the designation of a Contracting State at any time up to the grant of the European Patent. Further possibilities, in particular the addition of a Contracting State, which had previously been excluded by withdrawal, is not foreseen in Article 79 EPC. This reflects the principle that the geographical cover of a European patent application is confined to the states designated on filing and cannot in principle be extended after the withdrawal of designated states. Rather, a revival of the withdrawn designation can only be achieved under particular circumstances if the requirements for a correction under Rule 139 EPC are fulfilled (cf. for a correction as regards the designation of Contracting States: Case Law of the Boards of Appeal, 9th edition, IV.A.7.3).

Considering the nature of a divisional application as set out above, this principle - the restriction to those states that have been designated at the time of filing and the impossibility of subsequent re-expansion - must for reasons of consistency also apply to a divisional derived from the earlier application.

Interpreting Article 76(2) EPC in the systematical context with Article 79 EPC thus shows that only those Contracting States which were designated for the earlier application at the time of filing of the

divisional application can be designated in the divisional.

Hence, Contracting States which were not any longer designated for the earlier application (parent) at the time of filing of the divisional application cannot be designated in the divisional, neither by legal fiction nor explicitly.

1.3.3 A teleological interpretation, i.e. an interpretation of the meaning in the light of the purpose of Article 76(2) EPC, leads to the same conclusion. The intention of Article 76(1) and (2) EPC is to limit the content of the divisional application to that of the earlier application at the time of filing the divisional. Nothing suggests that beyond that an extension of the divisional's scope compared to the parent application was intended by the legislator.

1.3.4 These findings are confirmed when taking into consideration the circumstances in which Article 76(2) EPC in its current version was included in the convention and the travaux préparatoires set out in this context (historical interpretation).

Nothing in the travaux préparatoires suggests that the amendment to the wording of Article 76 (2) EPC was made with the intention of allowing a divisional application to have a broader geographical scope than that of the parent application at the date of filing of the divisional application.

In the travaux préparatoires in CA/PL 25/00 Rev.1 e, page 61 No.4 and CA 100/00e page 61 No.4 it is stated as follows:

"The designation system contained in Article 79 EPC has been modified, thereby entailing a consequential amendment of Article 76(2) EPC. Whereas Article 79(1) EPC currently provides that Contracting States for which protection is sought shall be designated in the request for grant, new Article 79(1) EPC stipulates that all the Contracting States party to this Convention at the time of the filing of a European patent application shall be deemed to be designated in the request for grant. However, the designation of a Contracting State may be withdrawn by the applicant at any time or deemed withdrawn through non-payment of the designation fee. Therefore, Article 76(2) EPC is amended accordingly, to ensure that only those Contracting States which remain designated in the earlier application at the time of filing of a divisional application are deemed to be designated in the divisional application."

In CA/PL PV 14 e page 6 No.29 it is further stated (emphasis added by the board):

"The Office replied that here the Convention was not being changed. The geographical cover of a European patent application was confined to the states designated on filing; no designation could be added which did not appear in the original application or had been validly waived. A designated state forfeited in the parent application could not be revived in the divisional one."

1.4 In conclusion, an interpretation of Article 76(2) EPC in accordance with recognised rules of interpretation shows that only those states that had been designated in the earlier application at time of filing the

divisional can be designated in the divisional. Hence, the reasoning in the appealed decision and the guidelines cited therein (Guidelines Part A IV.1.3.4) are in line with this interpretation of Article 76(2) EPC.

1.5 Consequently, adding Great Britain as designated Contracting State for the divisional application as requested by the appellant would contravene Article 76(2) EPC because this state was withdrawn as designated Contracting State in the earlier application at the time of filing the divisional application.

2. New submissions concerning Rule 139 EPC

2.1 In its statement of grounds of appeal the appellant presented submissions concerning Rule 139 EPC which had not been presented before. The board used its discretion under Article 12(4) RPBA 2007 not to admit these new submissions into the appeal proceedings.

2.2 Article 25(2) RPBA 2020 stipulates that the admittance of new submissions filed with the grounds of appeal has to be assessed under Article 12(4) RPBA 2007 if - as in the present case - the statement of grounds of appeal had been filed before 1 January 2020.

2.3 Under Article 114(2) EPC and Article 12(4) RPBA 2007 the board has the discretion not to admit facts and evidence which could and should have been presented in the first instance proceedings.

Appeal proceedings are a judicial review intended to give the appellant the opportunity to contest the

decision of the department of first instance. Thus, according to the established case law of the Boards of Appeal (Case Law of the Boards of Appeal, 9th edition, V.A.4.11.1) the appeal proceedings should normally be based on the facts, evidence and requests which led to the decision under appeal.

In the present case the appellant submitted its request for a correction of the withdrawal of Great Britain as designated state and the facts underlying this request for the first time with the grounds of appeal. During the first instance proceedings it did not give the slightest hint that the representative had withdrawn the designation of Great Britain in the earlier application (parent) contrary to the applicant's true intention, nor did it request a correction of the withdrawal. Rather in the first instance proceedings the appellant merely expressed its "position that all EPC states were designated for this application", although at that time the applicant was already aware of the relevant facts and thus could and should have presented them.

Thus, the appellant presented a completely fresh case for the first time in the appeal proceedings, which is tantamount to treating the appeal as a new independent proceeding rather than as a judicial review based on the facts presented in the first instance.

2.4 Contrary to the appellant's view, the board's discretion is not limited merely because the submission has been filed with the grounds of appeal. Rather, this is the typical situation for Article 12(4) EPC 2007 to be applied.

2.5 Moreover, the fact that different departments (Examining Division, Receiving Section) were responsible in the first instance proceedings for deciding upon four cases concerning related legal issues, does not justify the late filing.

The appellant did not refer to a lack of competence of the department that took the contested decision under the applicable legal provisions setting out the responsibilities of the different departments (Articles 16 ff EPC, Rule 10, 11 EPC) Rather it questioned the ability of the Receiving Section and the Examining Division to deal with legal matters and the appropriateness of different departments deciding on the four related cases.

Contrary to the appellant’s assumption, the possibility that different departments might come to different conclusions in different independent cases, even when they involve similar issues, is inherent in a legal system and does not deprive a party from the duty to submit the relevant facts in the first instance proceedings. The appellant's subjective feeling that the departments did not have the necessary knowledge can much less justify the late filing in a legal system guided by objective provisions for responsibilities.

2.6 Therefore, the board used its discretion not to admit the submissions concerning a correction under Rule 139 EPC into the appeal proceedings.

3. New submissions concerning the protection of legitimate expectations

3.1 During the oral proceedings the appellant presented submissions concerning the protection of its legitimate expectations which had not been presented before.

3.2 In the present case the summons to oral proceedings had been notified before the RPBA 2020 came into force. Hence, according to Article 25(3) RPBA 2020, Article 13(2) RPBA 2020 does not apply. However, Article 12(4) to (6) RPBA 2020 applies according to Article 25(1) RPBA 2020 because the exception in Article 25(2) RPBA 2020 only covers submissions in the statement of grounds of appeal, but not subsequent submissions in the appeal proceedings. Moreover, Article 13(1) RPBA 2020, which further refers to Article 12(4) to (6) RPBA 2020, applies according to Article 25 (1) RPBA 2020 for submissions presented for the first time after filing the grounds of appeal.

3.3 Under Articles 12(4) and (6) and 13(1) RPBA 2020 the board has the discretion not to admit new submissions.

In the case on file the board used its discretion not to admit the new submissions because the appellant could and should have presented the facts that form the basis for the alleged protection of legitimate expectations earlier in the proceedings.

In the oral proceedings before the board the appellant stated that the communication dated 10 August 2016 only came to light when preparing the oral proceedings. This does not justify the late filing because the appellant must have known the relevant facts already during the

first instance proceedings. If the appellant had really trusted the content of the communication addressed to the inventors and sent by the EPO on 10 August 2016, it would have been aware of this fact from the moment of taking note of that information. Hence, the appellant *could* have submitted these facts already during the first instance proceedings.

The complexity of the new objection would require the assessment of several issues (causal link between the erroneous information addressed to the inventors and the reaction (passivity) of the appellant in spite of several other correct communications of the EPO, requirement of proof therefore, and reasonableness of the appellant's reaction) that would be detrimental to procedural economy. Moreover, the objection does not seem to be suited to address the issues which led to the decision under appeal as it would introduce a completely new aspect on which the assessment and the reasoning in the appealed decision were not focused.

Moreover, a party has to present the complete case already with the statement of grounds of appeal (Article 12(3) RPBA 2020) which requires a complete preparation considering all the relevant documents that are available. Thus, no reasons are apparent that could justify why the appellant presented the new objection and the underlying facts for the first time at such a late stage of the proceedings thereby counteracting principles of procedural economy. Therefore, the appellant *should* have filed the new submissions already during the first instance proceedings.

3.4 Hence, the board used its discretion not to admit these new submissions into the appeal proceedings.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

C. Eickhoff W. Sekretaruk

Decision electronically authenticated