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**Datasheet for the decision
of 16 April 2024**

Case Number: J 0001/24 - 3.1.01

Application Number:

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

ELECTRONIC DEVICE WITH METAL FRAME ANTENNA

Patent Proprietor:

N.N.

Headword:

Divisional patent application

Relevant legal provisions:

EPC Art. 64(1), 67, 67(4), 106(1), 106(2)

EPC R. 14(1), 36(1), 112(1)

EPC 1973 R. 25

Keyword:

Admissibility of appeal - interlocutory decision - separate
appeal allowed (yes)

Divisional application - pending earlier European patent
application (yes)

Decisions cited:

G 0001/09, J 0028/03

Catchword:



Juristische Beschwerdekammer
Legal Board of Appeal
Chambre de recours juridique

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: J 0001/24 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 16 April 2024

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: Interlocutory decision of the Receiving Section of the European Patent Office posted on 14 September 2023 refusing European patent application No. XXXXXXXX.X to be proceeded as European divisional application pursuant to Rule 36(1) EPC.

Composition of the Board:

Chairman I. Beckedorf
Members: M. Millet
D. Rogers

Summary of Facts and Submissions

- I. The appeal is directed against the interlocutory decision of the Receiving Section dated 14 September 2023 that the European patent application EP XX XXX XXX.X will not be treated as a divisional application of the earlier European patent application EP XX XXX XXX.X. The Receiving Section allowed a separate appeal against the decision under Article 106(2) EPC.
- II. On 24 May 2021, the request for grant of the European patent application EP XX XXX XXX.X was filed as a divisional application of EP XX XXX XXX.X (the "parent application").
- III. A decision to grant was issued for the earlier European patent application EP XX XXX XXX.X (the "parent application") on 18 February 2021, setting an original date of publication of the mention of the grant as 17 March 2021.
- IV. On 16 April 2021, the applicant filed a notice of appeal against the decision to grant the earlier application and paid the appeal fee.
By a brief communication dated 6 May 2021, the Examining Division, responsible for the earlier application, informed the applicant that the decision to grant maintained its effect and remained valid, and that the date of publication of the mention of the grant had been deleted, with the deletion to be published in European Patent Bulletin No. 2021/XX of XX.
- V. On 18 June 2021 the applicant filed grounds of appeal. In response to a status enquiry, the Receiving Section issued a brief communication informing the applicant that the status of the divisional application depended

on the outcome of the appeal filed in respect to the earlier application.

- VI. On 7 April 2022, the applicant withdrew its appeal against the decision to grant the earlier application.
- VII. On 18 May 2022, the Receiving Section issued a noting of loss of rights pursuant to Rule 112(1) EPC. The Receiving Section found the present application could not be processed as a divisional application. With reference to the decision of the Legal Board of Appeal in J 28/03, the Receiving Section noted that the appeal against the decision to grant in respect of the parent application had been withdrawn. The decision to grant the parent patent had therefore been upheld. Accordingly, a divisional application could only have been validly filed until the day before the publication of the mention of the grant (16.03.2021).
- VIII. On 2 June 2022, the Examining Division issued a communication advising the applicant of the new publication date of the mention of grant in respect of the earlier application, namely 15 June 2022. This communication noted that the original decision to grant dated 18 February 2021 maintained its effect and remained valid.
- IX. On 15 July 2022, the applicant requested a decision under Rule 112(2) EPC and made submissions in support of the proposition that the present application had been validly filed as a divisional application.
- X. The Receiving Section issued the decision under appeal with the following main argumentation:
The principles of decision J 28/03 were applicable to the present case. In J 28/03, the Legal Board of Appeal drew a distinction between appeals against refusals of a European patent application and appeals against decisions to grant a European patent. As regards the former, there was a "guarantee" that a divisional application can survive even where the appeal was

refused for whatever reason (Reasons 15). The latter was different, as a patent has already been granted, with the consequence that every further action was completely dependent on the outcome of the appeal proceedings (Reasons 16). Moreover, the suspensive effect of an appeal did not allow to ignore the existence of an already taken decision. It only interrupted the normally following further steps until the definite decision of the last instance has been taken (Reasons 18).

- XI. On 14 November 2023, the appellant filed a notice of appeal and paid the appeal fee. In the statement of grounds of appeal filed on 15 January 2024, the appellant argued that the principles established in J 28/03 were not applicable to the present case, they were not convergent with the later decision G 1/09. In the present case, the original date of the mention of grant had been deleted, the parent application remained therefore pending. The situation in J 28/03 was different, there was no deletion of the mention of grant for the parent application. Therefore, the principles of this decision should not be applied to the present case, rather the principles set out in G 1/09 were applicable.
- XII. With letter of 15 July 2022, the appellant argued that other divisional applications were filed under the same circumstances as the present and were allowed by the EPO so that the appellant had legitimate expectations that in the present case the divisional application could be validly filed too.
- XIII. The applicant requested
that the decision under appeal be set aside and
that the application EP XX XXX XXX.X be processed
as a European divisional application.

In the event that this request was rejected oral proceedings were requested.

Reasons for the Decision

1. The decision is issued in writing without holding oral proceedings, because the appellant requested oral proceedings only in the event that the appeal would not be allowed. The Board does not consider oral proceedings to be expedient either.
2. The appeal is admissible. A separate appeal has been allowed in the decision under appeal in accordance with Article 106(2) EPC.
3. Rule 36(1) EPC provides that a divisional application may be filed in relation to any pending earlier European patent application.
4. The question to be decided in the present case is whether the parent application was still pending according to Rule 36 EPC when the divisional application was filed.
5. In the EPC there is no definition of the term "pending application". In G 1/09, the Enlarged Board of Appeal came to the conclusion that a "pending (earlier) European patent application" in this context is a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence (G 1/09, Reasons 3.2.4.).
6. The substantive rights of an applicant include provisional protection under Article 67 EPC. Pursuant

to Article 67(4) EPC, 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". Substantive rights may therefore continue to exist after the refusal of the application until the decision to refuse becomes final (G 1/09, Reasons 4.2.1.).

7. It is a well-established concept, that decisions of the administrative departments of the EPO in patent granting procedures do not become final until the expiry of the period for seeking ordinary means of legal redress. The legal consequence of Article 67(4) EPC is a provision indicating the point in time at which substantive rights conferred by a European patent application and its pending status must end. The retroactive effect of a final decision to refuse on the rights conferred upon the applicant does not influence the pending status of the application before such a decision is final. As an *obiter dictum*, G 1/09 states that in the case of grant, the pending status of the European patent application normally ceases on the day before the mention of its grant is published. From that point in time, substantive rights under the EPC no longer derive from the patent application but from the granted patent (Reasons 4.3.2.).

8. The earlier decision J 28/03 differentiated between the decision to refuse the parent application and the decision to grant the parent application. In the first case a divisional application should be allowed as long as the appeal procedure has not been terminated. Whereas in the second case of a decision to grant the patent fully in accordance with the request of the

applicant, Rule 25(1) EPC (1973), allowing the filing of a divisional application, did not apply.

9. The Notice of the Office dated 9 January 2002 concerning amendment of Rule 25(1), 29(2) and 51 EPC (1973), published in OJ EPO 2002, 112 reads:

"An application is pending up to (but not including) the date that the European Patent Bulletin mentions the grant of the European patent, or until the date that the application is refused, withdrawn or deemed withdrawn; if notice of appeal is filed against the decision to refuse, a divisional application may still be filed while appeal proceedings are under way (see Guidelines for Examination in the European Patent Office, Chapter A-IV, 1.1.4)."

So the appeal against the decision to grant the patent as requested could not benefit from the suspensive effect of an appeal against the refusal of a patent application (J 28/03, Reasons 9).

In the case J 28/03, the date of publication of the mention of the grant was not deleted, so that the grant of the patent became effective. The earlier patent application was therefore no longer "pending".

10. On the contrary in the present case, the date of publication of the mention of the grant had been deleted as a consequence of the appeal filed. Therefore, the patent application was still pending.

- 10.1 Moreover, the principle stated in J 28/03 that the answer to the question, whether the parent patent was still "pending", depended on the outcome of the appeal

against the grant of the parent application, is not convincing.

According to Article 106(1), second sentence, EPC, an appeal has suspensive effect.

This provision does not distinguish between an appeal against the refusal or against the grant of a patent.

- 10.2 In the later decision G 1/09 (Reasons 4.2.4.), it is stated that a patent application, which has been refused by the Examining Division, is thereafter still pending within the meaning of Rule 25 EPC 1973 until the expiry of the period for filing an appeal. Thus on the day after this period, it is no longer pending if no appeal was filed. The same conclusion applies to Rule 36(1) EPC in its former and its current version.
- 10.3 There are no "pending grant proceedings" required, because pending proceedings cannot simply be equated with a pending application (G 1/09, Reasons 4.2.5.). Support for such a conclusion can also be drawn from the fact that proceedings are no longer pending if they had been stayed according to Rule 14(1) EPC, nevertheless, the patent application remains pending. The conclusion in G 1/09 was that for Rule 25 EPC (1973) it is not relevant whether or not *proceedings* are pending before the EPO, but whether or not the patent application is still pending.
- 10.4 The issue is whether substantive rights still derive from the application or not.
In the present case, the deletion of the date of the mention of grant prevented the grant of the patent becoming effective. Thus, the substantive rights (e.g. provisional protection) still derive from the patent application which is therefore still pending.

10.5 The Board does not agree with the position of the board in J 28/03 (Reasons 11), that "an appeal against a decision granting a patent and resulting in the publication of the grant of the patent would be expected to be inadmissible with respect to Article 107(1) EPC and should therefore not benefit of the possibility to file a divisional application even during the appeal procedure. This can also be understood as to avoid abusive appeals to construe artificially pending 'parent applications'."

The current practice of the EPO treats appeals against the grant of a patent as appeals validly filed, with the consequence that the date of the mention of the grant is deleted in such a case. If later the appeal is withdrawn or turns out to fail, there will be a new date of publication of the grant. This is a requirement for the effectiveness of the grant of a patent (Article 64(1) EPC).

The present Board considers that it is inconsistent to consider an appeal in two different ways: first for the mention of the grant to be deleted, the appeal only needs to be admissible; and second for the suspensive effect to apply is dependent on the outcome of the appeal.

If this inconsistent approach were to be adopted, the situation would be uncertain and unclear especially for third parties, that could not know whether a patent application is still pending, as this would depend on the outcome of the appeal proceedings.

There is no basis in Article 106(1) EPC for such an approach. In the established case law of the Boards of

Appeal (see Case Law of the Boards of Appeal, 10th edition, 2022, V.A.1.3.1.), an example of a clearly inadmissible appeal that should have no suspensive effect, is an appeal without basis in the EPC, e.g. filed by a third party. The EPC has no provision restricting appeals of the applicant against the grant of a patent. Such an appeal cannot therefore be seen as clearly inadmissible.

- 10.6 As a consequence such an appeal has suspensive effect according to Article 106(1), second sentence, EPC.

11. That means for the present case that the parent patent application was still pending when the divisional application was filed. Therefore, it is not necessary to deal with the further arguments (especially in respect to legitimate expectations) of the appellant.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Receiving Section for further prosecution with the order to treat the application as a divisional application of European patent application EP XX XXX XXX.X.

The Registrar:

The Chairman:



C. Eickhoff

I. Beckedorf

Decision electronically authenticated