

Decision of Technical Board of Appeal 3.4.2 dated 13 July 2004

T 1158/01 - 3.4.2

(Translation)

Composition of the board:

Chairman: A. G. Klein

Members: M. P. Stock

V. Di Cerbo

Applicant: TridonicAtco GmbH & Co. KG

Headword: Division of a divisional application/TRIDONIC

Article: 76 EPC

Keyword: "Allowability of divisionals from divisionals (yes in principle)" - "Validity of second-generation divisional (no)" - "Legitimate expectations (no)"

Headnote:

When the validity of a second-generation divisional application is examined, the validity of the first-generation divisional from which it was divided out must also be examined. If the subject-matter of the first-generation divisional does not comply with Article 76(1), the second-generation divisional derived therefrom is likewise invalid.

Summary of facts and submissions

I. The application in suit, European patent application No. 99 126 075.3 (publication number 0 989 787), was filed as a divisional application (hereinafter "second-generation divisional") of European patent application No. 95 114 340.3, which in turn had been filed as a divisional application (hereinafter "first-generation divisional") of European patent application No. 91 121 150.6 (hereinafter "parent application").

After the second-generation divisional had been filed, the first-generation divisional was withdrawn. The patent granted in respect of the parent application was revoked in opposition proceedings, and the revocation decision was upheld by the present board in T 1086/00.

II. The second-generation divisional was refused by the examining division on the grounds that its subject-matter did not involve an inventive step as required by Article 56 EPC.

III. The appellant (applicant) filed an appeal against this refusal, explaining in its notice of appeal why the claimed subject-matter was patentable, contrary to the opinion of the examining division.

IV. In a communication sent pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal (RPBA) as an annex to the summons to oral proceedings, the board notified the appellant in particular that it should be prepared to comment on the following points which the board of its own motion intended to introduce into the proceedings.

In the board's provisional opinion, the second-generation divisional could not be accorded the date of filing of the parent application unless the first-generation divisional out of which it had been divided complied with Article 76(1) EPC with respect to the parent application and hence was a valid divisional application.

That however seemed questionable in particular because, unlike the parent application, the first-generation divisional filed on 12 September 1995 claimed a process and circuit for controlling the light intensity and the operating mode of gas discharge lamps which no longer necessarily included **regulating** or a **regulating device**. In particular, the terms "control **and/or** regulating device" and "controlling **and/or** regulating" used in the only independent claims 1 and 2 replaced the terms "control **and** regulating device" and "controlling **and** regulating" in the parent application documents. Mere control with no light intensity regulation seemed irreconcilable with the teaching of the parent application.

As the first-generation divisional filed on 12 September 1995 thus did not comply with Article 76(1) EPC, in the board's provisional view it could not form the basis for a valid second-generation divisional.

V. Oral proceedings were held on 13 July 2004.

The appellant requested that the refusal decision be set aside and that a patent be granted on the basis of claim 1 according to the main request or auxiliary request I or II as filed by letter of 29 June 2004. The exact wording of claim 1 is immaterial to the present decision.

As an auxiliary request the appellant also asked to have the following point of law referred to the Enlarged Board of Appeal:

"1. When examining a second-generation European divisional application, ie a divisional application itself derived from a divisional application, is it legitimate to check that the subject-matter of the first-generation divisional application does not extend beyond the content of the parent application within the meaning of Article 76(1)?

2. If it is, what are the consequences if the subject-matter of the first-generation divisional application *does* extend beyond the content of the parent application as filed?"

VI. The appellant's arguments as to examining the validity of the first-generation divisional in respect of the requirements of Article 76 EPC and as to the consequences of the results of that examination for the status of the second-generation divisional in the present case may be summarised as follows:

Any examination for compliance with Article 76(1) EPC was only allowed to compare the divisional application at issue, here the second-generation divisional, with what was disclosed in the parent application, here application No. 91 121 150.6. Accordingly, the board of appeal too had correctly designated only application No. 91 121 150.6 as the "parent application".

Article 76(1) EPC stipulated that the subject-matter of a divisional application was not allowed to extend beyond the content of the application whose filing date and priority were claimed. In the case at issue, the divisional application claimed the filing date and priority of parent application No. 91 121 150.6, so only that parent application could form the basis for examination for compliance with Article 76(1) EPC.

Significantly, the application at issue did not claim the filing date of the first-generation divisional.

Thus when examining for compliance with Article 76(1) EPC it was not legitimate to examine the relationship of earlier applications with the parent application.

Nor was it legitimate to compare the subject-matter of the second-generation divisional with that of the first-generation divisional. The first-generation divisional was to be considered only in connection with Rule 25 EPC, ie in determining whether the second-generation divisional had been filed in due time, in other words while the first-generation divisional was still pending. If this purely administrative condition was met, there was no reason to deny the applicant the opportunity offered in principle by the divisional application mechanism to have part of the invention as originally disclosed in the parent application further examined in separate proceedings.

The relevant decisions of the EPO's boards of appeal and the relevant commentaries on the EPC rightly held that examination for compliance with Article 76(1) EPC had to be conducted along the same lines as for Article 123(2) EPC. Yet the essential meaning of Article 123(2) EPC was that, in any application, the filing date or priority could be accorded only to what was originally disclosed. Thus here, too, the applicable principle was that the claims and other description documents being examined should be compared with the documents which gave rise to the date of filing. In that connection reference was also made to the commentary in *Benkard*, Europäisches Patentübereinkommen, 2002, point 73, on Article 123 EPC.

Similarly, the essential meaning of Article 76(1) EPC was that the documents being examined (in this case documents containing currently pending claims of the second-generation divisional) should be compared with the documents which gave rise to the date of filing and enjoyed priority (in this case the documents of the parent application).

Moreover, in the case in point, it was not legitimate to compare the documents of the first-generation divisional with the parent application in the light of Article 76(1) EPC, simply because the appellant had in that respect legitimate expectations arising from Article 125 EPC. The EPO examining division had been responsible for examining the first-generation divisional for compliance with Article 76(1) EPC, and it had raised no objections under Article 76(1) EPC, but only on grounds of novelty and inventive step. For that reason the appellant had had a legitimate expectation that the first-generation divisional would be accorded the filing date and priority of the parent application.

A similar decision on according a filing date had already been taken in J 18/96, OJ EPO 1998, 403.

Under procedural law, the examining division and the board of appeal now sitting were confined to the European patent application in suit, and while that application was being legitimately examined it could not be acceptable for the filing date of the first-generation divisional to be reassessed more or less in passing.

In that respect the appellant's procedural status would inadmissibly be made worse by the filing of a divisional application derived from a divisional application.

In the present case the first-generation divisional was also no longer pending. If it were still pending, however, the appellant could remedy any outstanding problems with Article 76(1) EPC by filing appropriate amendments. Yet it could not be acceptable in the present case for the appellant to be placed at a disadvantage purely because the first-generation divisional was no longer pending at the time of the oral proceedings for the application in suit (three years after the appeal was filed).

Moreover, T 555/00 of 11 March 2003 likewise did not call for the first-generation divisional to be compared with the parent, merely requiring (see Catchword 2) the second-generation divisional to be compared with the parent and with the first-generation divisional. Admittedly, on pages 13 and 14 of the Reasons (point 1.5) it was stated that both the

second-generation and the first-generation divisionals had to comply with Article 76(1) EPC; but that view was erroneous, and the cited decision also said nothing about the consequences in the event that the first-generation divisional had been extended relative to the parent application.

The correct position would be that even if a first-generation divisional existed, the consequences could only be that the second-generation divisional had to be treated as a divisional application within the meaning of Article 76(1) EPC if it had not been extended relative to either the parent or the first-generation divisional.

The fundamental importance of the legal issues raised here justified referring them to the Enlarged Board of Appeal.

Reasons for the decision

1. The appeal is admissible.

2. *Examination by the board of its own motion*

The examining division refused the application in suit because it did not involve an inventive step, without ever pronouncing upon its formal allowability as a second-generation divisional.

Given the importance of this issue, especially in terms of the proper filing date to be accorded to the divisional application in suit, the board will examine it of its own motion. The power of a board of appeal in ex parte proceedings to examine whether an application also meets EPC requirements that were not considered by the examining division is established by Enlarged Board decision G 10/93, OJ EPO 1995, 172, and has not been contested by the appellant.

3. *Divisionals from divisionals*

3.1 Formal allowability

In T 904/97 of 21 October 1999 the present board (in a different composition) had expressed doubts, particularly in the light of the historical documentation relating to the EPC (travaux préparatoires), about the allowability of sequences of divisional applications, but had left the matter open (see Reasons 2).

In the revised version of the EPC (EPC 2000) which was adopted on 29 November 2000 by a diplomatic conference but has not yet entered into force, an amendment was made to the French text of Article 76 EPC, whereby the term "demande initiale" (initial application) was replaced by "demande antérieure" (earlier application) to bring the wording into line with the English and German versions. In the Explanatory remarks on the Basic proposal for the revision of the EPC, this amendment was expressly stated to be designed to clarify that the Convention allowed a divisional application to be derived from an earlier divisional application as well, which evidently was not clear from the reference merely to the initial application (see MR/2/00 e, p. 65). It may be concluded from this amendment that the contracting states have now accepted the possibility of divisionals from divisionals.

Furthermore, Technical Board of Appeal 3.2.5 in T 555/00 of 11 March 2003, considering the fact that Article 76 EPC did not rule out the earlier application itself being a European divisional application, concluded that a divisional filed in respect of an earlier divisional did not as such contravene the requirements of Article 76 EPC (see Reasons 1.2).

Thus since the formal allowability of divisionals from divisionals has already been approved by a board of appeal and was expressly advocated by the contracting states during preparatory work on the EPC 2000, the present board

likewise no longer sees any reason for further reservations, which in any case would go against the established practice of the examining divisions (see Guidelines for examination in the EPO, December 2003, Part C, Chapter VI, 9.1.1, last sentence).

3.2 Examining divisionals from divisionals

3.2.1 The substantive conditions to be met by a divisional application are primarily established by Article 76 EPC: "It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority." If the divisional application itself is a second-generation divisional, there is in principle no difficulty in applying Article 76 EPC *mutatis mutandis*, since the earlier application out of which the second-generation divisional was divided is then the first-generation divisional. If the first-generation divisional itself is a valid divisional of the parent application, it inherits the latter's date of filing, which then under Article 76(1) EPC also applies to the second-generation divisional.

If, however, the first-generation divisional is not a valid divisional of the parent application within the meaning of Article 76 EPC, it cannot itself be deemed to have been filed on the date of filing of the parent. Nor does the EPC provide for it to be accorded any other date of filing, such as the date on which it was actually filed (see T 555/00, Reasons 1.6), and as a result it also cannot transfer a date of filing to the second-generation divisional. Hence in that case the second-generation divisional is not a valid divisional application either.

For these reasons, in the board's view, when the validity of a second-generation divisional is examined, the validity of the first-generation divisional must also be examined. This moreover has already been established in the only two earlier decisions known to the board which have dealt with divisionals from divisionals (see T 904/97, Reasons 4.1.2: "The parent application thus **never** met the requirement of Article 76(1) EPC with respect to the grandparent application, and it therefore **never** validly benefited from the latter's filing and priority dates. Neither [...] could it have transferred any such inexistent benefits to any subsequent divisional application."; and T 555/00, Reasons 1.5: "... not only the patent in suit, but also the parent application must comply with Article 76(1) EPC.").

3.2.2 The board is not persuaded by the appellant's arguments against the allowability of its examining the validity of the first-generation divisional.

For the reasons set out above, the appellant's view that in examining for compliance with Article 76(1) EPC all that is allowed is a comparison between the second-generation divisional and the parent conflicts in particular with the wording of Article 76 EPC and the case law of the boards of appeal. The comment the appellant cites from *Benkard*, *Europäisches Patentübereinkommen*, 2002, point 73, on Article 123 EPC relates primarily to the application of Article 123 EPC to further amendments to a divisional application and seems here merely to reflect its author's personal opinion.

Nor does the appellant's reference to the principle of legitimate expectations make any difference in the present case, not least because the appellant withdrew the first-generation divisional, which means that the examining division, which had always had its doubts about the patentability of the claimed subject-matter, had not given a final decision on the validity of that divisional application or even been obliged to comment upon it. Contrary to the appellant's line of argument, since the first-generation divisional has been withdrawn, the board in examining the second-generation divisional in suit cannot concern itself even in passing with the status of the first-generation divisional, which is not at issue here.

Yet even if the first-generation divisional had been validly granted, the board would in no way feel debarred from assessing substantive issues arising from examination of the second-generation divisional, since the filing of a divisional application gives rise to a separate examination procedure entirely independent of the one for the earlier application.

In J 18/96, cited by the appellant, the applicant had filed a description and claims in two different official languages, but a date of filing was nonetheless accorded on the grounds of the principle of legitimate expectations, as the Receiving Section had left him for a considerable time in the justified belief that the application had been validly filed. In that case, however, a date of filing was refused as a consequence of a formal error which the Receiving Section could or should have noticed and which the applicant could have remedied if notified accordingly. In the present case, though, the reason for not accorded a date of filing was the contravention of a substantive condition, in that the first-generation divisional did not comply with the conditions set out in Article 76(1) EPC; and responsibility for complying with substantive conditions rests primarily with the applicant himself. Quite apart from that, the examining division when examining the first-generation divisional had no occasion to note the contravention of Article 76(1) EPC, as it had concluded on other grounds that no patent could be granted in respect of the subject-matter of the first-generation divisional. As the conditions of Article 76(1) EPC expressly have to be met when the divisional application is filed, and as, likewise expressly, the content of the earlier application as filed has to be taken into consideration, contrary to the appellant's view it is at least questionable whether the noted deficiency could still have been remedied if it had been noted in good time and if the first-generation divisional had been amended accordingly.

3.2.3 Since, for the above reasons, both the wording of Article 76 EPC and the case law of the boards of appeal warrant the conclusion that a second-generation divisional has to be based on a first-generation divisional whose subject-matter does not extend beyond the content of the parent application as filed, there is no need to refer the point of law formulated by the appellant to the Enlarged Board of Appeal.

4. Main request and auxiliary requests

The appellant does not contest that the first-generation divisional is in contravention of Article 76(1) EPC because it claims a process and circuit for controlling the light intensity and the operating mode of gas discharge lamps which, unlike the parent, no longer necessarily include regulating or a regulating device (see point IV above).

Consequently, the first-generation divisional cannot be accorded a date of filing, and the second-generation divisional derived from it also does not constitute a valid divisional application.

Hence the appellant's main request and two auxiliary requests, all seeking the granting of a patent on the basis of the second-generation divisional as filed, cannot be allowed.

5. Other matters

In its communication sent pursuant to Article 11(1) RPBA as an annex to the summons to oral proceedings, the board had also expressed doubts that the second-generation divisional in suit complied with Article 76(1) EPC in relation to the first-generation divisional because although the descriptions of the parent and the first and second-generation divisionals were largely identical, the subject-matter of the second-generation divisional was not included in that part of the parent application which was the subject-matter of the first-generation divisional.

As the appellant's requests are not allowable on other grounds, there is no need for further examination of this issue.

Order

For these reasons it is decided that:

The appeal is dismissed.