

Decision of Technical Board of Appeal 3.4.2 dated 26 August 2005**T 39/03 - 3.4.02**

(Language of the proceedings)

Composition of the board:

Chairman: A. G. Klein

Members: M. P. Stock

J. H. P. Willems

Applicant: ASTROPOWER INC.

Headword: Divisional application/ASTROPOWER

Article: 76(1) EPC

Keyword: "Validity of divisional applications" - "Referral to Enlarged Board of Appeal"

Headnote

The following questions are referred to the Enlarged Board of Appeal:

(1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?

(2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?

(3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

Summary of facts and submissions

I. European patent application No. 99 100 131.4 (publication No. EP 0 911 885) was filed as a divisional application to the earlier European application No. 93 116 174.9 (publication No. EP 0 591 949) of which mention of the grant was published on 28 July 1999. The applicant and appellant has appealed against the decision of the examining division refusing the divisional application on the ground that none of the requests before it met the requirements of the EPC. The examining division inter alia reasoned that the divisional application did not comply with Article 76(1) EPC because the feature of "the grains having an average width in the range of 0.002 to 1 cm" as set out in several independent claims was not disclosed in the earlier application.

II. With its statement setting out the grounds for appeal dated 12 December 2002 the appellant filed replacement claims 1 to 9 and presented arguments in support of novelty and an inventive step of the claimed subject-matter. The appellant requested that the appealed decision be set aside and, auxiliarily, that oral proceedings be appointed.

III. In a communication dated 22 December 2004 the Board notified the appellant that the application neither in the original nor in the present version met the requirements of Article 76(1) EPC and it was considered as an important point of law whether a divisional application as originally filed not meeting the requirements of Article 76(1) EPC can still be amended in the course of the examination procedure in order to meet these requirements. The Board indicated that it envisaged referring this question to the Enlarged Board.

IV. In a response to this communication dated 22 April 2005 the appellant withdrew its request for oral proceedings in the event the Board decided to refer a question of law to the Enlarged Board but reserved the right to reinstate the request later in the proceedings when the Board considers the substantive issues to the appeal.

Reasons for the decision

1. The appeal is admissible.

2. *The contents of the divisional application as originally filed*

2.1 Each of claims 1, 13 and 15 of the present divisional application as originally filed contains the feature "elongated columnar grains having an average width in the range of 0.002 to 1 cm in size". This range is nowhere indicated in the corresponding earlier application as originally filed, as was correctly stated by the examining division in its decision (see point 1.3.2 of the Reasons).

2.2 A similar problem arises with the feature defining "an average grain size of at least 80 microns" in claims 2 and 14 of the divisional application as originally filed. The lower limit of 80 microns is not indicated in the earlier application, which only discloses a "minority carrier diffusion length greater than 40 microns" and a "minimum grain size dimension at least two times the minority carrier diffusion length" (see claim 7). It is clear that this definition is more restrictive than the one claimed in the divisional application as filed.

2.3 Claim 9 of the divisional application as originally filed defines a lower limit of 10 microns for the minority carrier diffusion length, which is nowhere disclosed in the earlier application.

2.4 Claim 12 of the divisional application as originally filed makes reference to "said grains" having features of a silicon net, which would refer to the columnar grains of claim 1. However, it is only disclosed in the earlier application, column 7, lines 5 to 8, and column 9, lines 31 to 36, that partially melted silicone below the melted material functions as a net on which columnar grains grow. The grains as originally disclosed in the earlier application accordingly do not by themselves constitute a net.

Thus the divisional application as originally filed in a number of aspects appears to be directed to subject-matter which extends beyond the content of the earlier application as filed, in contravention of the requirement set out in Article 76(1) EPC.

3. *Further prosecution*

3.1 The Board is well aware of the fact that in cases where, like in the present situation, a divisional application as filed offends against the provisions of Article 76(1) EPC relative to its subject-matter, it is the established practice of the EPO to allow the applicant at any later stage of the examining procedure to amend the divisional application so that it meets the requirements of Article 76(1) EPC, and to consider the corrected application, provided it also meets the requirement of Article 123(2) EPC in relation to its version as filed, as a valid divisional application, deemed to have been filed on the date of filing of the earlier application and having the benefit of any right of priority, as provided for also in Article 76(1) EPC.

This practice is set out in the Guidelines for Examination in the EPO. The formal requirements for the filing of a divisional application are given in Chapter A-IV, 1. Under 1.2.1, see second paragraph, it is mentioned that the question whether a divisional application is confined to subject-matter contained in the parent application is not decided until the examination procedure. The examination procedure for a divisional application is dealt with in Chapter C-VI, 9.1.4 to 9.1.6. Under 9.1.4 the procedure for a divisional application containing subject-matter additional to that contained in the parent application is described. It is indicated that the divisional application must be refused under Article 97(1) EPC due to non-compliance with Article 76(1) EPC, if the applicant is unwilling to remedy this defect by removal of the additional subject-matter. The Guidelines thus imply that a divisional application not meeting the requirements of Article 76(1) EPC in its version as filed may indeed be corrected in this respect at any later stage of the examination procedure, and in particular independently of whether the earlier application is still pending or not.

This practice would not appear to have been questioned so far by the Boards of Appeal, which in many instances accepted that divisional applications which in the version as originally filed offended against the provisions of Article 76(1) EPC, be later amended (see e.g. decisions T 1074/97 or 1092/04, not published in the OJ EPO).

3.2 The Board however has strong reservations as to the correctness of this practice for the following reasons. These reservations are based primarily on a number of apparent inconsistencies in the current practice both with recent developments in the case law of the Boards of Appeal regarding the treatment of divisional applications filed as divisional applications of earlier divisional applications, and with the provisions of Rule 25(1) EPC, setting a time limit for the filing of divisional applications. These reservations seem to find support also in the express wording of Article 76 EPC, as confirmed by case law and legal developments in a contracting state (Great Britain), and in the Historical Documentation relating to the EPC (Travaux Préparatoires).

3.3 A difficulty with the present practice became apparent as a consequence of recent case law of the boards of appeal allowing the filing of divisional applications as divisionals of earlier divisional applications; see in particular decision T 1158/01 (published in OJ EPO 2005, 110).

In this decision the present Board in a different composition ruled that when the validity of the second-generation divisional application is examined the validity of the first-generation divisional application must also be examined. If the first-generation divisional application is invalid because its subject-matter does not comply with Article 76(1) EPC, the second-generation divisional derived from it is likewise invalid, see point 3.2 of the Reasons.

It is to be noted that in the case underlying decision T 1158/01, the first-generation divisional application as originally filed extended beyond the content of the earlier application. It was however not examined in this respect, and the impermissible subject-matter remained in the application until the latter was eventually abandoned. This first-generation divisional application thus never met the requirements of Article 76(1) EPC.

However, if in the course of its examination, an invalid first-generation divisional application comprising added subject-matter in its version as originally filed was amended so as to delete any such added subject-matter, and was thus made retroactively valid, the second-generation divisional application - and any further member of a subsequent cascade of divisional applications - would as a consequence also become valid. Conversely, once the initially invalid divisional application has become valid as a result of the deletion of originally impermissible added subject-matter, any still later partial or total re-introduction of such originally added subject-matter in the course of an amendment would result in the divisional application and, together with it, the whole sequence of further-generation applications, becoming invalid again under Article 76(1) EPC.

The inconvenience of such practice in terms of legal certainty for the public is evident, and it could in the Board's view only be avoided if the validity of the first-generation divisional application under Article 76(1) EPC was only to be judged for once, on the sole basis of its version as originally filed.

3.4 Moreover, the present practice of the EPO of authorising at a late stage of the examination procedure, irrespective of whether the earlier patent application is still pending or not, and without any further limitation other than the one imposed by Article 123(2) EPC, amendments aimed at deleting added subject-matter from divisional applications as filed so as to overcome objections under Article 76(1) EPC, in the Board's view results in applicants

being effectively allowed to formulate valid divisional applications in contravention of the provisions of Rule 25(1) EPC.

The provisions of Rule 25(1) EPC indeed establish a point in time after which the applicant can no longer seek protection for any subject-matter disclosed but not claimed in its patent application, and these provisions therefore are of paramount importance in providing legal certainty for the public.

Therefore, allowing the applicant that has filed an invalid divisional application directed to subject-matter extending beyond the content of the earlier application as filed, to formulate long after expiry of the period of time defined in Rule 25(1) EPC an amended divisional application directed to subject-matter actually disclosed both in the earlier application and in the divisional application as filed and thus in conformity with the requirements of both Articles 76(1) and 123(2) EPC but nevertheless different from - and possibly not even encompassed by - the aspects of the earlier application for which the original divisional application had been filed, may in the Board's view deceive the legitimate expectation of the public that exclusive rights would be confined to the subject-matter of the claims granted at the outcome of the examination of the earlier application and to the subject-matter specifically divided out of the earlier application by way of the original divisional application.

The present practice which does not provide for any limitations as to the time at which a divisional application offending against the provisions of Article 76(1) EPC is corrected nor as to the subject-matter to which the corrected application can be directed, beyond those imposed by Articles 76(1) and 123(2) EPC, can thus be seen to pave the way for potential misuse of the possibility afforded by the EPC to file divisional applications. The mere filing of a divisional application relating to a pending earlier application but being invalid by virtue of Article 76(1) EPC at present in effect grants an applicant the opportunity to postpone the moment when he can - in the course of amendments made to overcome an objection under Article 76(1) EPC - freely select which aspect of the earlier application is to be divided out. According to the present practice, provided the description of the invalid divisional application is the same as that of the earlier application as filed, the applicant at the time of the correction benefits from the very same freedom for formulating the amended divisional application as if he had not yet filed the divisional and as if the earlier application was still pending.

Similar concerns relating to the potential effect on the legal certainty for the public of the late formulation of divisional applications have been expressed by this Board in a different composition in its decisions T 720/02 and T 797/02 (not published in the OJ EPO; see point 2.2 of the Reasons), in relation to the proper handling of sequences of divisional applications.

3.5 Support for the Board's reservations against the present practice of the EPO concerning the handling of divisional applications which offend against the provisions of Article 76(1) EPC may also be found in the actual wording of this article.

Article 76(1) EPC is explicitly directed to the **filing** of divisional applications. It sets out the requirements to be met by a divisional application as filed and the consequences resulting from compliance of a divisional application with these requirements:

"A European divisional application **must be filed** directly with the European Patent Office at Munich or its branch at The Hague. 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" (emphasis added).

Thus, Article 76(1) EPC may be seen to express that a divisional application can only benefit from the filing and priority dates of the earlier application if it has actually been **filed** in respect of subject-matter which does not extend beyond the content of the earlier application.

The question of the correct interpretation of very similar legal provisions concerning divisional applications comprising additional subject-matter in their version as originally filed was considered in detail by the UK Patents

Court in its decision "Hydroacoustics...", see Fleet Street Reports [1981], pages 538 to 550, in which it had to apply Section 76(1) of the 1977 UK Patents Act which provides:

"76(1). An application for a patent (the later application) shall not be allowed to be filed ... in respect of any matter disclosed in an earlier application ... if the later application discloses matter which extends beyond that disclosed in the earlier application, as filed ..."

From this wording, which obviously was intended to match the corresponding provisions of Article 76(1) EPC, the Court drew the conclusion, see page 548, second paragraph, that it was mandatory to refuse to allow any divisional application to be filed which contains additional matter not disclosed in the parent application. The Court did not accept the argument of the applicant, see page 548, third paragraph, that the words "shall not be allowed to be filed ..." were not to be read as meaning that a divisional application with additional matter cannot be filed but were to be read as meaning "shall not be allowed to proceed", so that the applicant should be allowed to delete the additional matter and then to proceed with matter disclosed in the parent application. The Court argued that the words "shall not be allowed to be filed" were perfectly plain and it saw no reason why they should not have been given their plain meaning.

Incidentally the Board notes that Section 76 of the UK Patents Act has been amended with effect from January 7, 1991 so as to explicitly allow later deletion of added subject-matter. It now provides that "An application for a patent ... which is made in respect of matter disclosed in an earlier application ... and discloses additional matter, that is matter extending beyond that disclosed in the earlier application ... may be filed ... but shall not be allowed to proceed **unless it is amended to exclude the additional matter**" (emphasis added); see "Terrell on the Law of Patents", ed. S. Thorley et al., 15th edition, London, Sweet & Maxwell, 2000.

Article 76(1) of the Convention has, however, remained unchanged.

3.6 Against the current practice of the EPO of allowing deletion from divisional applications of additional subject-matter extending beyond the content of the earlier application so that it meets the requirements of Article 76 EPC, the Board also found in the Historical Documentation relating to the EPC (Travaux Préparatoires) indications that the Convention was not meant to allow such deletion. The minutes of the Munich Diplomatic Conference in 1973, see pages 36 to 37, show that Article 74(now Article 76, divisional applications) was the object of a thorough discussion in relation more particularly to the question of whether or not additional subject-matter in divisional applications belongs to the state of the art under Article 52(now Article 54) paragraph 3 EPC. This discussion is summarised under point 210. There it is stated that "Where a divisional application comprised new examples extending beyond the original version of the earlier application, these examples were not allowable. **They should not, however, be deleted ...**" (emphasis added).

4. The questions of whether divisional applications which offend against the requirements of Article 76(1) EPC can be rendered valid by later amendments and which are the conditions under which such correction may be admissible thus are important points of law.

The Board has strong reservations against the possibility of correcting such divisional applications, but since its views are clearly not in line with established practice of the EPO in this respect, it considers it appropriate in the circumstances to refer the question to the Enlarged Board of Appeal as provided for under Article 112(1)(a) EPC.

Order

For these reasons it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

(1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?

(2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?

(3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?