

Interlocutory decision of Technical Board of Appeal 3.4.03 dated 30 March 2006

T 1409/05 - 3.4.03

(Language of the proceedings)

Composition of the board:

Chair: R. G. O'Connell

Members: G. Eliasson

T. Bokor

Applicant: SEIKO EPSON CORPORATION

Headword: Sequence of divisionals/SEIKO

Article: 76(1) EPC

Article: 1, 54(2), 54(3), 63(1), 64(1), 80, 90(1)(a), 90(2), 96(2), 97(1), 100(c), 111(1), 112(1)(a), 123(2) EPC

Rule: 25(1), 39, 86(3) EPC

Keyword: "Compliance with Article 76(1) EPC for a sequence of divisional applications" - "Accordinging of a filing date" - "Content of the application" - "Referral to the Enlarged Board of Appeal"

Headnote

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

*(1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a **necessary and sufficient** condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?*

*(2) If the above condition is **not** sufficient,
does said sentence impose the additional requirement*

(a) that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its divisional predecessors?

or

(b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?

Summary of facts and submissions

I. This is an appeal against the refusal of European patent application 01 128 824.8 for non-compliance with Article 76(1) EPC.

II. The present application (A3) is the third in a sequence A1, A2, A3 of divisional applications, each divided from its predecessor, and stemming from a root (originating) application A0 (89 304 929.6). The root and the first divisional A1 (94 106 661.5) have been granted. The second divisional A2 (97 200 954.2) was refused for non-compliance with Article 76(1) EPC as were its sibs B2 (97 200 955.9) and C2 (97 200 957.5).

III. Claim 1 of A3 as filed has the same wording as claim 1 of A2 as filed and reads as follows:

"1. A liquid crystal device for an electro-optical device, the liquid crystal device including a plurality of liquid crystal cells wherein data signals are supplied to the liquid crystal cells through a plurality of field effect transistors, arranged in a plurality of picture elements (292) the liquid crystal device comprising:

a substrate (71, 86) having a pixel region and at least one driver region;

a plurality of first lines and a plurality of second lines arranged in a matrix in the pixel region and connected to the field effect transistors;

driving circuits (21, 12) formed in the at least one driver region and connected to one of the first lines and second lines,

output terminals of driver circuits connected to one of said plurality of first lines and said plurality of second lines; and

at least one driver test circuit (283, 288) comprising transistors, said transistors of said at least one driver test circuit (283; 288) being coupled to a test signal input terminal (284; 289) a test signal output terminal (285; 290) and one of said first and second lines,

wherein test signals applied to the test signal input terminal (284; 289) are output to said test signal output terminal (285; 290) through said transistors in accordance with the operation of said driver circuit."

IV. Claim 1 of A1 as filed reads as follows:

"1. An active matrix panel comprising a picture element matrix (22), which is mounted on a transparent substrate (71, 86) and which includes a plurality of gate lines (24, 25), a plurality of source lines (26, 27, 28) and a plurality of picture elements (32, 33), each of the picture elements including a thin film transistor (29, 101), the active matrix panel further comprising a gate line drive circuit (21) and a source line drive circuit (12) and being characterised in that at least one of the gate line drive circuit and the source line drive circuit comprises a plurality of complementary thin film transistors (47 to 56; 58, 59; 99, 100) provided on the transparent substrate, and having a gate length shorter than that of the thin film transistors of the picture element matrix."

V. In the refusal decision under appeal the examining division noted that A2, itself a divisional, was refused for non-compliance with Article 76(1) EPC. Applying what it saw as the *ratio decidendi* of T 555/00, viz. that non-compliance with Article 76(1) EPC of a divisional as filed necessarily entailed non-compliance of a divisional of

that divisional, the examining division concluded that the present application A3 did not comply with Article 76(1) EPC. Furthermore, since the claimed subject-matter was identical to that of A2 as filed, the reasons for refusing A2 (cf. VI below) applied *mutatis mutandis* with respect to the disclosure of A1.

VI. The reasons for refusing A2, the predecessor of the present application A3, were essentially as follows:

A1, from which A2, B2 and C2 were divided out, defined in claim 1 as well as in the "statement of invention" an active matrix panel comprising thin film transistors (TFTs) in which the TFTs of the gate or source drive line circuits are complementary and have a gate length shorter than that of the TFTs of the picture element matrix (cf. A1 as published, page 3, lines 46 to 52). The skilled person would thus deduce from the description of A1 as filed that these features were essential to the (disclosure of the) invention. Since claim 1 of A2 did not include all of these features, it contained subject-matter which was not directly and unambiguously derivable from A1 as filed.

The above-mentioned features were considered essential (to the disclosure) since they were included in the statement of invention of A1. Since this statement differed from the corresponding statement in A2 as filed, the total information content of these applications was different.

The reasons for refusing B2 and C2 were essentially the same as for A2.

VII. Refusal of A2 was not appealed. The refusals of B2 and C2 were appealed and in decisions T 797/02 and T 720/02 respectively Technical Board of Appeal 3.4.02 dismissed both appeals for the same reasons, which were essentially as follows:

(a) B2 and C2 were divisionals of a divisional (A1). The essential content of A1 was determined by the invention or group of inventions defined in the claims thereof. To comply with Article 76(1) EPC any further divisionals, in the present case B2 and C2, must be directed to objects encompassed by such invention or group of inventions; reasons 2.2.

(b) To allow subject-matter from the root application A0 which was reproduced in the description of the first divisional application A1 but not encompassed by the invention actually divided out of the root application, to be further divided out of the first divisional at a later date would be to allow applicants, by the filing of a sequence of divisionals, each divided from its predecessor, to leave the public completely uncertain during most of the life of a patent as to how much of the subject-matter of the root application might still be claimed. This would pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications; reasons 2.2.

VIII. The appellant applicant requests that the decision under appeal be set aside and that a patent be granted on the basis of the application as filed.

IX. The arguments presented by the appellant in support of his requests can be summarised as follows:

The examining division had misinterpreted "the content of the earlier application" as used in Article 76(1) EPC. Following the jurisprudence of the boards of appeal, exemplified by decisions T 260/85 OJ EPO 1989, 105; T 514/88 OJ EPO 1992, 570; T 441/92 and T 1008/99, it meant the whole of the technical information disclosed to the person skilled in the art.

Reasons for the decision

1. The appeal is admissible.

2. The decision under appeal was based solely on Article 76(1) EPC and it appears from the file that the examining division did not examine any other substantive requirements for patentability. Hence if the appeal is allowed, it would be appropriate pursuant to Article 111(1) EPC to remit the case to the examining division for further prosecution.

3. *Application of Article 76(1) EPC to a sequence of divisional applications each divided from its predecessor*

In decision T 39/03 Technical Board of Appeal 3.4.02 referred the following questions to the Enlarged Board of Appeal (referral G 1/05):

(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?

Since the present application A3 remains as filed, this appeal is not directly affected by the above questions.

Whereas referral G 1/05 is concerned with the question from what point in the procedure compliance with Article 76(1) EPC, second sentence, is required, the present appeal is concerned with the question of what such compliance means.

3.1 *How is the term "content of the earlier application as filed" in Article 76(1) EPC to be interpreted?*

3.1.1 The subject-matters of claim 1 of both the present application A3 and its predecessor A2 (as filed) indisputably extend beyond the scope of claim 1 of A1. In the light of decisions T 720/02, T 797/02 and more recently T 90/03, the question arises whether this fact by itself warrants a refusal of the present application. These decisions have held that the **content** of a divisional application for the purposes of Article 76(1) EPC - or even for the purposes of Article 123(2) EPC - was defined by the **claims** of the divisional application **as filed** (emphasis added). On this view the claimed subject-matter of a divisional of a divisional may not go beyond the claimed subject-matter of its predecessor divisional as filed. For brevity this requirement will be termed the *nested claims* requirement.

3.1.2 The term used in Article 76(1) EPC "content of the earlier application as filed" is a term which appears in several other articles of the EPC, notably in Articles 100(c) and 123(2) EPC. The legislative intent behind this term is clear from the discussion regarding the "prior claim approach" vs the "whole contents approach" for the purposes of Article 54(3) EPC during the drafting phase of the EPC. In the jurisprudence of the boards of appeal of the EPO relating to divisional applications a consensus has developed that the term "content of the application" is to be interpreted as "the total technical information content of the disclosure", be it in the description or the claims (T 514/88, OJ EPO 1992, 570, reasons 2.2; "Case Law of the Boards of Appeal of the EPO, 4th Edition 2001", Chapter III.A.2; *Singer-Stauder*, "The European Patent Convention, A Commentary 3rd Edition", Article 76, Note 20). It is also established jurisprudence of the boards of appeal that Article 123(2) EPC and Article 76(1) EPC, second sentence are to be interpreted in the same manner in this respect (*supra* and T 276/97, reasons 2.4 and 4.2).

In T 873/04, reasons 1, the above principles were applied to a sequence of divisional applications where the predecessor application was itself a divisional.

3.1.3 The above principles, although well-established, have been challenged in decisions T 720/02 and T 797/02 (both decisions having essentially the same reasons) in the case of a sequence of (two) divisional applications, the second divided from the first, and stemming from a root application. For such applications it was held that in order to comply with Article 76(1) EPC, second sentence, any successor divisional applications must be directed to objects encompassed by the invention or group of inventions divided out of the root application in the first divisional; that is the subject-matter of the divisional application must fall within the scope of the claims of the earlier divisional application (see reasons 2.2). In the more recent decision T 90/03 these principles were apparently applied to the first divisional as well (reasons 2).

3.1.4 The board regards this recently developed line of jurisprudence of T 720/02, T 797/02, and T 90/03 as problematic, since there are no indications in the EPC, either explicitly or implicitly, that a different interpretation should be used for the purposes of Article 76(1) EPC in the case in which the term "earlier application" refers to a divisional application. There is in particular no indication that in such a case the term "content" should be equated with "the matter for which protection is sought" (as claimed on filing) - an interpretation which would be contrary to the established meaning of this term.

3.1.5 Neither can the board find any discernible legislative intent to that effect. It is noted that in the course of the latest modification of Rule 25(1) EPC, the introduction of the term "**any** pending application" was meant to make it clear that a parent application to a divisional application could be a divisional application itself; cf. "Information from the EPO" OJ EPO 2002, 112. Thus it is evident that the competent legislator, here the Administrative Council, was aware of the possibility of sequential divisional applications, each divided from its predecessor, and was also aware of the need to regulate this issue, but nevertheless refrained from differentiating between "normal" and divisional applications, and did not establish further special rules for divisional applications beyond the specific material requirements of Article 76(1) EPC. It must therefore be assumed, absent any indication to the contrary, that the legislator did not intend to create differing legal standards for the examination of a normal and a divisional application, be it a first divisional or a divisional of a divisional.

3.1.6 The reason given in T 720/02 and T 797/02 for using a narrower construction of "content of the earlier application" was that otherwise the public would be left completely uncertain during most of the life of a patent as to how much of the subject-matter of the initial (root) patent application might still be claimed, and that this would pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications; reasons 2.2.

3.1.7 The present board has doubts whether it would be proper to arrive at an interpretation *contra legem* by referring to a perceived unfairness of a legal provision or the potential for misuse, in particular when an actual misuse was neither alleged nor established. Firstly, interpreting and applying the law is not an exercise of a discretionary power, except where this is explicitly permitted by the law itself, as in Article 96(2) EPC or Article 114(2) EPC. Secondly, some degree of uncertainty for the public is inherent in the patent system. It is hard to see why sequential divisional applications, each divided from its predecessor, would leave the public in substantially greater uncertainty than "normal" ones. At the time of writing, there are of the order of one hundred thousand patent applications pending at the EPO - unpublished. Arguably, an unpublished patent application is a source of much larger uncertainty than a published one, at least concerning the subject-matter that "might still be claimed". By the same token, there is an identifiable public interest in seeing published applications proceed to grant speedily. However, if delay in the grant procedure and the protraction of the "state of uncertainty" of the public is also partly attributable to the EPO itself, it is hardly legitimate to restrict applicants' rights on such a basis.

3.1.8 It is universally acknowledged that the primary legislative purpose of divisional applications is to provide a possibility of obtaining protection for inventions which are non-unitary. The same should hold for sequential divisional applications. Accordingly, the provisions of the EPC should not be interpreted so as effectively to bar applicants from benefiting from this possibility. The board notes that even though the *nested claims* principle was proposed in relation to sequential divisional applications, each divided from its predecessor, it may have

repercussions for first divisional applications as well, as evidenced by T 90/03. Specifically, the assumption that the restrictive interpretation of the term "content of the application" holds for **any** divisional application - and not only for an "earlier application" and only for the purposes of Article 76(1) EPC - would make it extremely risky, if not downright impossible for applicants to draft claims with an acceptable scope of protection. This approach would dictate that the same restrictive interpretation is to be applied when interpreting the "content" for the purposes of Article 123(2) EPC. For example, in a clear case of non-unity, where a previously non-searched second invention is pursued in the divisional application, an applicant may find himself barred from taking a feature from the description into the claims, normally a routine exercise, as it may be seen to contravene Article 123(2) EPC. In other words, this assumption would harm not only "abusive", but also fully "legitimate" divisional applications, where the subject-matter of the divisional application was claimed right from the start in the root application, so that the public had been put on notice.

3.1.9 The board acknowledges that a systematic filing of sequential divisional applications, each divided from its predecessor, with minimal or absolutely no difference in their subject-matter could indeed constitute an abuse of the patent procedure. It could thwart a final refusal of a patent application, and thus effectively circumvent Rule 86(3) EPC, last sentence, which legally empowers the examining division to keep the duration of the grant procedure under control. However, even this potential for abuse cannot justify a construction of another provision of the EPC contrary to the undisputed primary purpose of that provision, as this would transgress even the limits of purposive construction. In effect, it would be tantamount to a legislative activity which is reserved for the legislator, being the Administrative Council or a diplomatic conference of the contracting states.

3.2 In a sequence of divisional applications, each divided from its predecessor, is non-compliance with Article 76(1) EPC hereditary?

3.2.1 Application A2 was refused for non-compliance with Article 76(1) EPC. In the light of decisions T 904/97 and T 555/00 - on the interpretation of the latter by the examining division in the decision under appeal and subsequently by T 1158/01, OJ EPO 2005, 110 - this raises the question whether the present application A3 may enjoy a "valid" filing date at all. These decisions have held that a divisional of a divisional cannot be accorded the filing date of its root application, if the first divisional is not deemed to have been accorded this filing date. This construction of Article 76(1) EPC was also tacitly accepted in the referring decision T 39/03; reasons 3.3 and question (1) of the decision formula. This objection also featured in the decision under appeal. For brevity this requirement will be referred to as the *impeccable pedigree* requirement. For the reasons indicated below this board finds it difficult to subscribe to the reasoning of the above decisions.

3.2.2 At the outset the board notes that there is no basis in the EPC for the concept of an "invalid" application and it does not seem appropriate to draw legal consequences from the perceived properties of non-existent legal categories. In fact the terms "valid" or "invalid" do not occur in the EPC. However, solely for the purposes of discussion, especially when referring to this concept as introduced by some earlier decisions, the board will use the term "invalid" divisional application for a divisional application which does not comply with the requirements of Article 76(1) EPC, in the sense that the claimed subject-matter - at least as filed - extends beyond the content of the earlier application (root or parent).

3.2.3 At first sight, the wording of Article 76(1) EPC may indeed suggest an interpretation according to which an "invalid" divisional application does not have a filing date *ab initio*; cf. T 904/97, reasons 4.1.2. This interpretation may find support in the wording "shall be deemed to have been **filed** on the date of filing of the earlier application" (board's emphasis), ie the divisional application is deemed to have been accorded a filing date. *A contrario*, noncompliance with Article 76(1) EPC would then have the consequence that a filing date could not be accorded as the EPC does not foresee the accordance of a filing date other than that of the earlier (root or parent) application; J 11/91 OJ EPO 1994,28, reasons 4.2.

3.2.4 However, the clause "shall be deemed to have been filed on the date of filing..." can also be interpreted as putting the emphasis on the "date", ie where it is not the filing as a legal act, but the date as an event marker which is pivotal.

3.2.5 Clearly, the legislative purpose of Article 76(1) EPC is the obtaining of a legal effect which is related to the legal effects of a filing date. Therefore, it is worth taking a closer look at the concept and legal effects of a filing date as regulated by the EPC.

3.2.6 A legally effective - in the terminology of the EPC, an accorded - filing date has several different legal effects. Amongst others:

(a) it marks the beginning of the pendency of a European patent application; Article 80 EPC in conjunction with Article 90(1)(a), 90(2) EPC;

(b) it marks the notional date on which the applicant formally **claims** to have deposited his invention with the EPO; and

(c) the filing date will define the state of the art and hence the extent of search and examination, for the purposes of Article 54(2) and (3) EPC.

The legal effects (a) to (c) will ensue immediately when the filing date has been accorded. Further legal effects of the filing date will unfold upon publication of the patent application:

(d) It will mark the date which will count as the filing date so as to affect **other** applications for the purposes of Article 54(3) EPC.

The filing date will unfold still further legal effects on grant:

(e) it will mark the starting date for the **granted** protection envisaged by Article 64(1) EPC, cf. Article 63(1) EPC; and

(f) the filing date will mark the **legally confirmed** date by which the applicant had deposited the invention for which protection was granted, and as such, recognises the claim of (b).

The difference between the legally relevant dates (a) to (f) is clearly shown by the fact that logically they need not coincide, although this is the core assumption in the patent granting system established by the EPC.

3.2.7 A filing date for a "normal" application is accorded as soon as the requirements of Article 80 EPC are met - apart from other formal issues, such as language, etc.

3.2.8 If an application is deemed to have been accorded a filing date, an application comes into existence. In other words, there will be a pending application, and the legal effects (a) to (c) as explained at point 3.2.6 above are obtained.

3.2.9 Conversely, a pending application must always be deemed to have been accorded a filing date. It is of course true that the EPC uses the notion of an application that is not deemed to have been accorded a filing date; cf. Article 90(2) EPC. However, such a purported application will legally never be pending, as there would be no application; cf. Article 90(2) EPC, last sentence. Such a purported application is neither searched nor examined, and neither filing, search, examination nor annual fees need be paid thereafter. A purported application which does not have a filing date simply does not exist as an application *sensu stricto* for the purposes of the EPC. This shows

that a pending application without a filing date would be in a legal limbo. In other words, the notion of according a filing date is synonymous with the legal recognition of the existence of a pending European patent application.

3.2.10 Hence a pending divisional application must also have a filing date. The declaration of the applicant on the (physical) lodging of the documents that the application is a divisional application is in fact a declaration of his intention to preserve the already established legal effects of the earlier (root or parent) application, viz. the existence of a pending application before the EPO and the event-marking dates (a), (b) and (c), which define the extent of search and examination. Legal effect (a) arises with the accordance of the filing date to the divisional application by the Receiving Section. As to the legal effect (b), this remains as a **claim** to the event-marking date, which will transform into the legal effect (e), as soon as compliance with Article 76(1) EPC has been established. Naturally, at the time of the physical lodging of the divisional application the applicant cannot - yet - benefit from any legal effects of the filing date such as (e) and (f) which have not yet been established in the earlier (root or parent) application.

3.2.11 This corresponds to the very notion of a division, as only something existing can be divided. This is also mirrored by the requirement of Rule 25(1) EPC, as interpreted by established jurisprudence: a divisional application can be accorded a filing date only if its parent is pending - ie exists, in the sense that it still exists at the time of the (physical) lodging of the divisional application. Similarly, the continuation of the legal effects (b) and (c) of the filing date of the parent is also reasonable. Firstly, the continuation of the legal effect (b) is not dependent on any external condition since it is inherent in the notion of a **claim**. Secondly, the examination of the application is based upon this claimed filing date, which defines the state of the art, otherwise its examination simply would not make any sense. This is the established practice of the European Patent Office.

3.2.12 There can be no further substantive requirements for the **accordance** of a filing date to the divisional application. The condition of Article 76(1) EPC can certainly not be such a requirement, because compliance with this requirement is established only during substantive examination of the application (J 13/85, reasons 7) and a substantive examination cannot be performed absent a pending application as explained above.

3.2.13 This leads to the conclusion that compliance with Article 76(1) EPC is not a requirement for according a filing date to a divisional application, but a requirement which has to be fulfilled in order to obtain some other legal effect. Interpreted in this light and bearing in mind the reasoning at 3.2.6 above, the clause "shall be deemed to have been filed on the filing date" is an expression of the wish of the legislator that the divisional application should be entitled to the filing date of the earlier (root or parent) application as the **significant calendar date** for all those legal effects of the filing date which arise **after** the filing of the application, the most important ones arising after grant. At the same time, it is left open what should be the legal fate of those applications which do not comply with Article 76(1) EPC.

3.2.14 However, before a filing date may be legally confirmed through grant, it must be claimed. Expressed differently the formulation of Article 76(1) EPC not only assigns the legal effects of the filing date of the root to the divisional application, but effectively opens for applicants the **procedural possibility** of filing divisional applications and formally **claiming** the filing date of the root. Absent this provision it would not be clear on what material basis divisional applications should be examined.

3.2.15 However, legal effects arising from a granted patent are indivisible, ie it is not foreseen in the EPC to grant a "defective" patent with only some of its legal effects, as a response to partially fulfilled substantive conditions. Accordingly, in order to unfold the legal effects envisaged by the legislator, the application must proceed to grant. This presupposes that all substantive conditions for grant are fulfilled. In this manner, Article 76(1) EPC is in fact just another condition for grant. To borrow the terminology of English contract law, it is a condition subsequent rather than a condition precedent. This leads to the interpretation that an application which does not comply with the requirements of Article 76(1) EPC shall not be allowed to proceed to grant. This is consistent with the reasoning in T 555/00 at 1.6 and is fully in line with the substantive nature of this requirement, eg its well-established analogy to Article 123(2) EPC. Such an interpretation also fits in neatly with the existing practice of the European Patent Office in implementing Article 97(1) EPC, ie a pending application which does not comply with a substantive requirement is not deemed to have lost its filing date but is **refused** pursuant to Article 97(1) EPC.

3.2.16 This leads to the conclusion that the legally effective filing date of a divisional application - for the purposes of establishing a pending application - is based on the **pendency** of the parent, and not on its compliance with substantive requirements, such as Article 76(1) EPC or any other substantive requirement for grant. The same must apply to a divisional of a divisional. This means that besides Article 80 EPC, the only requirement for the legally effective filing of a divisional of a divisional is the pendency - ie the existence - of its predecessor (parent) divisional **at the time of filing** of the successor divisional application, as provided by Rule 25(1) EPC. This approach also makes it possible for the EPO Receiving Section to decide immediately on the accordance of a filing date to a divisional application (Rule 39 EPC).

3.2.17 It has to be admitted that even though compliance with Article 76(1) EPC cannot be a requirement for the accordance of the filing date, it may still be interpreted as causing the subsequent **loss** of the accorded filing date in the event of non-compliance. Since it is not possible to separate the legal effects of a filing date from each other, this would dictate the loss of the application as a whole. In this case the real question could be whether this assumed loss of the filing date will occur with an *ex tunc* or *ex nunc* effect as regards the validity of the procedural steps made during the pendency of the application.

3.2.18 If Article 76(1) EPC were to be construed as causing the loss of the filing date with an *ex nunc* effect this would not affect the accorded filing date of a divisional application, because after the filing of the divisional the two applications become fully independent; cf. T 1176/00, reasons 2.1, first sentence. At the time of filing the divisional application the predecessor application **does** have an effective - accorded and existing - filing date, which the divisional application can validly claim, and thus can be accorded a filing date. In fact, the legal consequences of an *ex nunc* loss of the filing date of the application cannot be distinguished from the legal consequences of a refusal.

3.2.19 This corresponds to the present practice. As stated at point 3.2.15, patent applications are not deemed to have lost their filing date, but are refused. A refusal does not entail a retrospective loss of a filing date. It is well established that refusal of a patent application has an *ex nunc* effect as regards the validity of procedural steps made during the pendency of the application, including the filing of a divisional application; cf. *Krasser*, Patentrecht (5. Auflage) § 29 V. 4. True, Article 97(1) EPC, last sentence also envisages the possibility of sanctions other than a refusal, such as deemed withdrawal. However, Article 76(1) EPC stops short of expressly providing any other sanction.

3.2.20 An analysis of the legislative history of Article 76(1) EPC also supports the interpretation that the issue is not the accordance of a filing date, but the determination of the significant calendar date. The problematic formulation "shall be deemed to have been filed" appeared in the Travaux Préparatoires as early as 1961, and has remained substantially unchanged since. However, at that time in at least two national patent systems, namely in the Federal Republic of Germany and in the United Kingdom, divisional applications were **not** necessarily refused if they contained unallowable extensions, but could proceed to grant with another filing date (see BPatG 20.12.1965, E 8, 23 and subrule 13(2) of the Patent Rules 1968 made pursuant to the (UK) Patents Act 1949). Under such circumstances, the use of the disputed wording was fully justified. In this light it becomes clearer that the "deemed filing date" is indeed a requirement for grant. The legal content of this provision is not the **according** of the filing date, but rather a **confirmation** of the - already claimed and accorded - filing date. Expressed differently, this provision is rather a recognition that the application may indeed be granted with the claimed filing date, as opposed to a grant with **some other** - but nevertheless existent and recognised - filing date. But there is no trace in the travaux that the intended legal effect in case of non-compliance was to be the **loss** of the filing date, much less the *ex tunc* loss of the application as a whole.

3.2.21 This board finds the other possible interpretation, namely the assumption of the retrospective - *ex tunc* - loss of a filing date untenable. It is indisputable that it would cause problems for the smooth functioning of the EPO. While the board recognises that the desire for a convenient internal administrative system for the EPO is not a source of law, the sheer practicability of the "system of law ... for the grant of patents", as the primary purpose of the EPC (Article 1 EPC), is also a point which should be given weight. That interdependence of parents and divisionals is undesirable from a purely practical point of view has been made clear in G 4/98, OJ EPO 2001, 131, last sentences of point 5 of the reasons, : " Although there are some connections between the two procedures (eg concerning time

limits), actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application **should not influence the procedure concerning the latter**. And finally, tricky questions arising in a case where a patent has been granted after accelerated processing of the divisional application before the due time for paying the designation fees for the parent application are avoided" (emphasis added).

3.2.22 The assumption of the retrospective loss of a filing date of a divisional application would raise questions no less tricky than the retrospective withdrawal of designations. Such an assumption would give rise to a number of antinomies; in more colloquial language it would be a recipe for a legal mess. In fact, had the Enlarged Board of Appeal come to the conclusion in case G 4/98 (cf. reasons 5) that a designation is withdrawn with an *ex tunc* effect, it would also have caused the retrospective loss of the filing date; cf. Article 80(b) EPC.

3.2.23 One such antinomy would be the fact that a retrospective loss of the filing date would immediately raise the question of the legal basis of the renewal fees paid for the divisional application.

3.2.24 Another problem with the notion of retrospective loss of the filing date becomes clear when a divisional predecessor application terminates without a decision on compliance with Article 76(1) EPC. If there is such a final decision in the proceedings of the predecessor, the question is settled. If there is no final decision on this issue, eg in the case of refusal on some other basis, a withdrawal or deemed withdrawal, there can be no legal consequence either, which means that the predecessor application does not lose its filing date, even if it never did comply with Article 76(1) EPC. This leads to the surprising result that the legal basis of the filing date and hence the "existence" of the later-generation application hinges **not only** on substantive criteria but **also** on procedural steps made in the procedure of its predecessor **after** the applications became independent.

3.2.25 At first sight, it would appear that the retrospective-loss-of-filing-date theory leads to the same result as the invalid-application theory deduced from the *impeccable pedigree* principle. As will be shown below, this is not the case.

3.2.26 The principle of party disposition does not allow a department of the EPO to decide on a non-pending application. This means that the department examining the divisional application cannot "reopen" the proceedings of the earlier application to decide on the existence of the filing date. Therefore, the problem outlined in 3.2.24 cannot be cured. This does not seem to hold for the invalid-application theory, at least as interpreted in T 1158/01.

3.2.27 Under the invalid-application theory, a division or board examining a divisional application must examine the "validity" of all antecedent divisional applications (parents, grandparents, etc. as the case may be) as envisaged in T 1158/01, and based on the result of this examination, may come to the conclusion that the application in fact does not have a filing date. Now the fact that the non-pending application could be examined for its filing date can only mean that the filing date is some objectively existing "property" of the application, and **not** a legal consequence of a decision in the proceedings of the predecessor. It is not clear how this notion of the filing date may be reconciled with the principle that the filing date is accorded by the Receiving Section.

3.2.28 Apart from these conceptual problems, this board has difficulty in finding any plausible explanation why any department should examine an application for which no examination (or even search) fees have been paid at all, as the case may be. But the fact that this examination should be performed by the department charged with the subsequent divisional application appears even stranger. It must be kept in mind that the examination of the predecessor application for compliance with Article 76(1) EPC requires an examination of the subject-matter of the claims of the predecessor application relative to its predecessors. Therefore, a department wishing to establish whether the predecessor application was "valid" or not for the purposes of the *impeccable pedigree* principle must resort to the examination of some subject-matter which may be totally different from the subject-matter claimed in the application before it. Theoretically, the department may have to examine subject-matter falling into a completely different IPC class from that with which it is normally charged, bearing in mind that the primary legislative target of divisional applications is non-unitary inventions.

3.2.29 A similar antinomy arises in relation to appeals: under the circumstances described above, an appeal against the finding of invalidity of the parent must be filed in the procedure of the divisional application, even though the underlying questions and facts pertain to some other procedure, namely the procedure of the parent.

3.2.30 The concept of the retrospective loss of a filing date - just as the concept of "invalidity" - is not only impractical but also unnecessary. The undisputed legal purpose of Article 76(1) EPC, namely the prevention of granting protection for some added subject-matter that was "smuggled in" by means of the sequential applications may be also achieved in a simple and straightforward manner. The disclosure in the later-generation divisional - must be examined, and it must be determined whether this was disclosed in **all** earlier applications **as filed**: parents, grandparents, etc. as the case may be. Essentially this principle has been formulated in T 655/03, reasons 3.3.1; in T 643/02, reasons 2.1 and indeed in T 555/00, reasons 1.5. It is to be noted that this exercise only requires the examination of subject-matter which is in fact before the competent department, and further it does not require any *post mortem* analysis of the legal status of the earlier applications. In this manner, interdependence of the applications is also avoided.

3.2.31 Having regard to the above considerations this board is unable to subscribe to the theory advocated by T 1158/01. On the contrary, the procedural system of the EPC does not allow room for the concept of retrospectively "invalid" patent applications or patents. In the absence of such a concept, the presumed "validity" of a later-generation divisional application is unaffected by the "validity" of its parent, grandparent, etc. Since the "*impeccable pedigree*" theory is based on a certain construction of the provisions of Article 76(1), it is incumbent on the boards to interpret Article 76(1) in a manner which is consistent with the procedural system of the EPC.

3.2.32 As explained above, this board considers that the condition "may be filed for subject-matter not extending beyond the content of the earlier application as filed" is to be understood as a precondition for grant. If this condition is fulfilled, the divisional application may proceed to grant and its deemed filing date (ie the filing date of the parent) is confirmed. If the condition is not fulfilled, the divisional application must be refused under Article 97(1) EPC in conjunction with Article 76(1) EPC. The legal effect of the refusal will be the same as that for refusal for non-compliance with any other substantive condition, with no retrospective loss of the filing date.

3.2.33 Further, with this interpretation the provision of Article 76(1) EPC may also play a role in determining the significant date for the purposes of Article 54(3) EPC in relation to later applications (legal effect (d)). This interpretation allows the department examining the later application to take into consideration or to exclude some subject-matter in the earlier application as prior art, without having to decide on the "validity" of the earlier application containing the disputed subject-matter. It is sufficient to examine the deemed filing date of that subject-matter of the earlier application which anticipates the subject-matter of the later application.

4. It will be demonstrated in the following paragraphs that the answer to the question whether, when examining for compliance with Article 76(1) EPC, this board's interpretation of the article as expounded above should be applied in preference to the constructions posited in decisions T 904/97 and T 1158/01 on the one hand (*impeccable pedigree*), and in decisions T 720/02, T 797/02 and T 90/03 on the other hand (*nested claims*), would decide the present appeal.

It should, incidentally, be borne in mind that the present application remains as filed. It is for the Enlarged Board of Appeal to decide in case G 1/05 (referring decision T 39/03) whether or not a divisional application has to meet the requirements of Article 76(1) EPC at its actual filing date.

5. On this board's interpretation it would suffice for compliance with Article 76(1) EPC that what is disclosed in the application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed.

5.1 The subject-matter of the present application A3 was indisputably disclosed in A2 as filed since A3 and A2 as filed are identical.

5.2 As to the question whether the subject-matter of the present application A3 is directly and unambiguously derivable from A1 and A0, it is noted that claim 1 of the present application is based on the embodiment of Figure 14. This embodiment describes a circuit for testing each output from the source line and gate line drive circuits (application as published, paragraphs [0044] to [0046]). This passage of the description is identical to the corresponding parts of A1 and A0 (cf. A1 as published, page 10, lines 32 to 50; A0 as published, page 9, line 56 to page 10, line 15).

5.3 The examining division objected in this connection that since A1 as filed claimed an active matrix panel comprising thin film transistors (TFTs) in which the TFTs of the gate or source drive line circuits are complementary and have a gate length shorter than that of the TFTs of the picture element matrix (cf. A1 as published, page 3, lines 46 to 52), a skilled person reading A1 would deduce that the embodiment of Figure 14 of A1 related to such an active matrix panel. Since claim 1 of the present application A3 does not define the gate lengths of the transistors, the examining division was of the opinion that the subject-matter of the present application A3 extended beyond that of A1 as filed.

5.4 The board is not persuaded by this analysis, since it is clear to a skilled person reading A1 that the circuit described in the embodiment of Figure 14 checks only whether correct output signals are present on the source and gate lines, and that it is accordingly irrelevant from the point of view of testing the source and gate lines what type of transistors are employed in the drive circuits and in the picture element matrix; cf. T 545/92, reasons 3.1; T 211/95, reasons 4.4.

5.5 Hence the board finds that the subject-matter of present application A3 is directly and unambiguously derivable from each of A0, A1, and A2 as filed. On this board's interpretation developed at point 3 above, Article 76(1) EPC would be complied with and the case would fall to be remitted to the department of first instance pursuant to Article 111(1) EPC.

6. On the other hand, applying the *impeccable pedigree* construction developed in T 904/97 and T 555/00 (on the - in this board's view, mistaken - interpretation of the latter by the examining division in the decision under appeal and subsequently by T 1158/01) would have the consequence that the appeal would have to be dismissed.

Since the predecessor (parent) application A2 was refused for non-compliance with Article 76(1) EPC and this decision was not appealed, the present application would likewise have to be considered "invalid"; cf. T 904/97, reasons 4.1.2 and T 1158/01, reasons 3.2.1.

7. The appeal would likewise have to be dismissed if the *nested claims* requirement developed in T 720/02 and T 797/02 were to be regarded as imposed by a proper construction of Article 76(1) EPC.

As mentioned at point 5.3 above, claim 1 of the present application A3 does not specify the relative gate lengths of different transistors, as is the case in claim 1 of A1 as filed. Therefore, the subject-matter of the present application A3 is not encompassed by (nested in) the subject-matter of the claims of A1; cf. T 797/02, reasons 2.2.

8. Article 112(1)(a) EPC provides that: in order to ensure uniform application of the law, or if an important point of law arises, a board of appeal shall, during proceedings on a case ... of its own motion ... refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.

It has been shown at points 5 to 7 above that the proper interpretation of Article 76(1) EPC for later-generation divisional applications is an important point of law decisive for the present appeal. Since the board's views are not in line with the *ratio decidendi* of several recent decisions of other boards of appeal, it considers it appropriate to refer the question to the Enlarged Board of Appeal in order to ensure uniform application of the law.

Order

For these reasons it is decided that:

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

(1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a **necessary and sufficient** condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?

(2) If the above condition is **not** sufficient,
does said sentence impose the additional requirement

(a) that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its divisional predecessors?

or

(b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?