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**Datasheet for the decision  
of 10 June 2011**

**Case Number:** T 2175/09 - 3.5.04

**Application Number:** 03000329.7

**Publication Number:** 1309202

**IPC:** H04N 7/36

**Language of the proceedings:** EN

**Title of invention:**  
Video coding system

**Patentee:**  
MITSUBISHI DENKI KABUSHIKI KAISHA

**Former Opponent:**  
ODS Optical Disc Service GmbH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 123(2)  
RPBA Art. 11

**Relevant legal provisions (EPC 1973):**

EPC Art. 76(1), 100(c), 113(1), 138(1)(c)

**Keyword:**

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**Decisions cited:**

G 0004/92, G 0001/93, G 0009/93, G 0001/05, G 0001/06,  
T 0441/92, T 0057/96, T 0475/02, T 0687/05

**Catchword:**

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Case Number: T 2175/09 - 3.5.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.5.04  
of 10 June 2011

**Appellant:** MITSUBISHI DENKI KABUSHIKI KAISHA  
(Patent Proprietor) 7-3, Marunouchi 2-chome  
Chiyoda-ku  
Tokyo 100-8310 (JP)

**Representative:** Verhauwen, Axel  
Krieger Mes & Graf v. der Groeben  
Georg-Glock-Straße 3  
D-40474 Düsseldorf (DE)

**Respondents:** -  
(Opponent)

**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 15 October 2009  
revoking European patent No. 1309202 pursuant  
to Article 101(2) and 101(3)(b) EPC.

**Composition of the Board:**

**Chairman:** F. Edlinger  
**Members:** C. Kunzelmann  
B. Müller

## Summary of Facts and Submissions

- I. The appeal is against the decision of the opposition division to revoke European patent No. 1 309 202.
- II. The patent had been granted on European patent application No. 03 000 329.7, which was a divisional application from application No. 99 124 382.5 (referred to as "the parent application" in this decision), which was itself a divisional application from application No. 97 113 971.2 (referred to as "the grandparent application" in this decision), which was in turn a divisional application from application No. 92 118 018.8 (referred to as "the root application" in this decision).
- III. The opposition proceedings may be summarised as follows:

The patent was opposed on several grounds (Article 100(a) EPC 1973 in conjunction with Articles 54 and 56 EPC 1973; Article 100(b) EPC 1973; and both options under Article 100(c) EPC 1973). With respect to Article 100(c) EPC 1973, the opponent argued that the subject-matter of the patent extended beyond the content of the application as filed and extended beyond the content of each of the three earlier applications as filed. It also argued that each of the earlier divisional applications, when filed, did not meet the requirements of Article 76(1) EPC 1973. It furthermore argued that the parent application and possibly the grandparent application had never met the requirements of Article 76(1) EPC 1973, so that the chain of divisional applications was interrupted. The notice of opposition was transmitted to the patentee

with a communication dated 10 February 2006. The opposition was subsequently withdrawn on 1 March 2007. In a communication pursuant to Article 101(2) and Rule 58(1) to (3) EPC 1973 and dated 27 April 2007 the opposition division indicated that, after a *prima facie* examination, it had been "convinced by the arguments relating to Article 100(a) EPC [1973] ... concerning the lack of novelty of claim 1 with respect to document D3" and that the European Patent Office would continue the opposition proceedings of its own motion. The opposition division also indicated that observations to other objections raised by the former opponent would be welcome. In a summons to oral proceedings dated 4 May 2009 the opposition division reiterated the objection as to lack of novelty with respect to D3 and indicated that other arguments presented by the former opponent against the validity of the patent could be discussed as well. With a letter dated 4 September 2009, the patentee filed auxiliary requests and submitted arguments why in its view the claimed subject-matter according to the main and auxiliary requests was new and involved an inventive step over D3. On 30 September 2009 the opposition division sent the following communication to the patentee by fax: "The Division has examined the further arguments submitted by the former opponent in the opposition notice and is now convinced that the arguments concerning Article 100(c) / 76(1) EPC are relevant. Therefore the Patentees should be prepared to discuss this ground for opposition, which during the oral proceedings will be examined first." On 1 October 2009 the patentee requested postponement of the oral proceedings and argued that there was insufficient time for the preparation of the oral proceedings and thus a violation of Article 113(1)

EPC 1973. With a letter sent by fax on 2 October 2009 the opposition division communicated the reasons for not postponing the oral proceedings. On 5 October 2009, the oral proceedings before the opposition division were held. The opposition division found that the subject-matter of the opposed patent was not directly and unambiguously derivable from what was disclosed in the grandparent application as filed. At the end of the oral proceedings the opposition division revoked the patent because in its view the ground for opposition according to Article 100(c) EPC 1973 prejudiced the maintenance of the patent.

IV. The patentee appealed and requested that the decision be set aside and that the patent be maintained in unamended form. In the statement of grounds of appeal the appellant gave reasons as to why in its view the subject-matter of the opposed patent did not extend beyond the content of any earlier application as filed. It also submitted arguments as to why in its view the opposition division's conclusion that Article 100(c) EPC 1973 prejudiced the maintenance of the patent was incorrect even if the opposition division's finding was correct that the subject-matter of the patent extended beyond the content of the grandparent application as filed. The patentee also gave arguments as to why its right to be heard had been violated, contrary to the requirements of Article 113(1) EPC 1973.

V. The board issued a communication pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), annexed to a summons to oral proceedings dated 22 February 2011, in which it gave its preliminary opinion.

VI. In a letter dated 10 May 2011 the appellant submitted further arguments in support of its case.

VII. Oral proceedings were held before the board on 10 June 2011. During the oral proceedings, the appellant submitted the following three questions to be referred to the Enlarged Board of Appeal:

1. "Führt eine Änderung der Anmeldungsunterlagen im Prüfungsverfahren einer Teilanmeldung als Glied einer Kette von Teilanmeldungen zu einer Rückwirkung im Sinne einer Fiktion geänderter ursprünglicher Unterlagen bei der Betrachtung der Anforderungen im Sinne der Auslegung von Art. 100(c) EPÜ im Lichte der Entscheidung G 1/06?"

2. "Weichen die Anforderungen der Artikel 100(c) und 138(c) EPÜ für Teilanmeldungen von denen für Ursprungsanmeldungen dahingehend ab, dass gemäß Art. 123(2) EPÜ unzulässige Änderungen gegenüber der ursprünglich - nicht fingiert- eingereichten Fassung der Teilanmeldung keinen Widerrufsgrund für das aus der Teilanmeldung entstandene Patent darstellen?"

3. "Wird die Unzulässigkeit einer Änderung gemäß Art. 123(2) EPÜ einer Teilanmeldung im Prüfungsverfahren durch die Erteilung derselben auf Grund der abweichenden Anforderungen der Art. 100(c) und 138(c) bei der Betrachtung der Anforderungen dieser Artikel im Lichte der Entscheidung G 1/06 geheilt?"

In the board's translation, these questions read as follows:

1. Does an amendment of the application documents in examination proceedings of a divisional application which is one of a sequence of divisional applications have a retroactive effect, in the meaning that the original documents must be deemed amended, in consideration of the requirements in the meaning of the interpretation given to Article 100(c) EPC in the light of decision G 1/06?
  
  2. Do the requirements of Articles 100(c) and 138(c) EPC for divisional applications diverge from those for original applications to the effect that amendments which are inadmissible under Article 123(2) EPC with respect to the originally filed - not deemed amended - version of the divisional application do not form a ground for revocation of the patent originated from the divisional application?
  
  3. Is the prohibition of an amendment under Article 123(2) EPC of a divisional application in examination proceedings remedied by the grant thereof on the ground of the diverging requirements of Articles 100(c) and 138(c) [EPC] in consideration of the requirements of these Articles in the light of decision G 1/06?
- VIII. The appellant requested that the case be remitted to the first instance on the ground that a fundamental deficiency had occurred in the first-instance proceedings. In the alternative, the appellant requested that the decision under appeal be set aside and that the patent be maintained unamended. In the alternative, the appellant requested the board to refer

the three questions submitted in the oral proceedings to the Enlarged Board of Appeal.

IX. At the end of the oral proceedings the chairman announced the board's decision.

X. Claim 1 of the patent as granted reads as follows:

"A method for producing a local decoded signal, wherein said local decoded signal is produced by adding a decoded error signal (207) with a motion compensated predictive signal (210), and said decoded error signal (207) is produced by decoding a coded predictive error signal (206) developed from a difference between said motion compensated predictive signal (210) as a first video image and a second video image of a motion video signal (201) representative of sequential video images including first and second video images, characterized by the steps:  
transform coding the predictive error signal to produce said coded predictive error signal (206) arranged into blocks, the scanning sequence of the transform coefficients being changed on a block by block basis;  
decoding the transform coefficients of the coded predictive error signal (206) to produce said decoded error signal (207);  
storing said local decoded signal as plural odd and even image fields; and  
generating said motion compensated predictive signal (210) from the stored plural fields."

XI. The reasons for the decision under appeal may be summarised as follows.



Concerning the request for postponement of the oral proceedings, it would not have been justified to postpone the oral proceedings because no new facts, evidence or arguments had been introduced in the opposition division's communication dated 30 September 2009.

Concerning the issue of Article 76(1) EPC 1973, one of the objections raised in the notice of opposition was that the feature "the scanning sequence of the transform coefficients being changed on a block by block basis" in claim 1 of the opposed patent was not disclosed in the grandparent application as filed. This defect could not be remedied and therefore revocation of the patent was unavoidable. Subject-matter omitted when filing a divisional application could not be reintroduced; that would infringe Article 123(2) EPC. In this respect the opposition division referred to G 1/06, point 11.2. in conjunction with points 10 and 11.1.

XII. The appellant's arguments may be summarised as follows:

The right to be heard laid down in Article 113(1) EPC 1973 implied that enough time for the preparation of comments had to be allowed. In the case of oral proceedings, Rule 115(1) EPC stipulated that at least two months' notice of the summons shall be given, and Rule 116(1) EPC specified that "[w]hen issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken", with the expression "the points" meaning "all the points". The former opponent had raised many different

issues and referred to so many documents that a thorough preparation of comments on all these issues for oral proceedings was an epic undertaking. But the former opponent had withdrawn the opposition and the European Patent Office had continued the opposition proceedings of its own motion, with the communication dated 27 April 2007 referring to Article 100(a) EPC 1973 only. Also, the summons to oral proceedings did not raise the added subject-matter issue. In this situation it had been reasonable to infer that in fact all grounds against the maintenance of the opposed patent consisted in Article 100(a) EPC 1973. Thus Rule 116 EPC and Article 113(1) EPC 1973 as well as Rule 81(3) EPC had been violated because the opposition division had raised the decisive added subject-matter issue only three working days before the oral proceedings.

Concerning the added subject-matter issue, both the root application and the grandparent application disclosed the feature of controlling the encoding characteristic with the selected prediction signal and the information of the selected blocking. This feature was a generalisation of the feature "the scanning sequence of the transform coefficients being changed on a block by block basis". For a person skilled in the art the encoding characteristic was actually the scanning sequence of the transform coefficients.

The opposed patent had been granted on a divisional application. Thus only the second option mentioned in Article 100(c) EPC 1973 was applicable. Only infringements of Article 76(1) EPC, not of Article 123(2) EPC in the examination phase, were a

ground for opposition. In the present case the relevant amendment was the reintroduction of the feature "the scanning sequence of the transform coefficients being changed on a block by block basis", omitted when filing the grandparent application. This reintroduction was an amendment under Article 123(2) EPC of the grandparent application and was therefore not a ground for opposition for the opposed patent. The "content of the earlier application as filed" in Article 100(c) EPC 1973 was the content of the immediately preceding parent application from which the divisional application was filed. Article 100(c) EPC 1973 also provided a ground for opposition if the subject-matter of a divisional application extended beyond the content of the root application which created the benefit of the date of filing ("time rank"). However, Article 100(c) EPC 1973 did not apply to the omission of subject-matter on filing an intermediate higher-generation divisional application and its reintroduction into the patent before grant. The case of patents granted on one of these applications of a sequence of divisional applications was not considered in Article 100(c) EPC 1973. The decision of the Enlarged Board of Appeal G 1/06 applied only to pre-grant examination proceedings, not to opposition proceedings. The omission of the feature "the scanning sequence of the transform coefficients being changed on a block by block basis" when filing the grandparent application was irrelevant because the feature had been reintroduced into the grandparent application before the parent application had been filed. This reintroduction had retroactive effect because the European Patent Office had granted a patent on the grandfather application, thereby deciding with the

force of law and as *res iudicata* that the reintroduction was allowable and that the grandparent application was deemed retroactively as not going beyond the content of the root application as filed. The retroactive ("ex tunc") effect of a change of a divisional application was evident from the order and point 2.2 of the reasons of G 1/05. The interests of third parties were not affected because the reintroduction of the omitted feature into the grandparent application and the subsequent grant of a patent were known to the public. The feature "the scanning sequence of the transform coefficients being changed on a block by block basis" had not been deliberately omitted ("fallen gelassen") when filing the grandparent application. Instead an error had occurred when filing the grandparent application and the applicant had put things right. Hence point 11.2 of G 1/06, to which the opposition division had referred in the decision under appeal, was not applicable. The points of law raised by the appellant were of fundamental importance and should be referred to the Enlarged Board of Appeal.

## Reasons for the Decision

1. The appeal is admissible.
2. *Procedural issues*
  - 2.1 The appellant requested that the case be remitted to the first instance on the ground that a fundamental deficiency had occurred in the first instance proceedings. According to Article 11 RPBA, "[a] Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise." The appellant alleged (see point XII above) that its right to be heard under Article 113(1) EPC had been infringed due to non-compliance with Rules 116(1) and 81(3) EPC by the opposition division's communication of 27 April 2007 and the summons to oral proceedings of 4 May 2009.
  - 2.2 The question is whether the opposition division's decision to revoke the patent, taken in the oral proceedings, was "based on grounds or evidence on which the parties concerned have had an opportunity to present their comments" (see Article 113(1) EPC 1973).
  - 2.3 It is established case law that an opposition division may examine new facts, evidence and arguments presented in oral proceedings (see, for instance, the opinion of the Enlarged Board of Appeal G 4/92, OJ EPO 1994, 149, points 8 to 10 for the particular case of an absent party). This applies *a fortiori* also to facts, evidence and arguments already presented in advance of the oral proceedings, for instance in the notice of opposition.

The opposition division must however give the parties the opportunity to comment before issuing a decision based on such facts or evidence, so as to comply with the requirements of Article 113(1) EPC 1973.

2.3.1 The particular ground for opposition ultimately relevant for the decision under appeal is based exclusively on the disclosure of the applications forming the chain of divisional applications leading to the opposed patent. These applications originate from the patent proprietor/appellant and have essentially identical descriptions and drawings (disregarding a discussion of prior art which was present only in the root application) so that a detailed study of one of the descriptions (with corresponding drawings) was sufficient to understand the disclosure of all the descriptions. Hence the assessment of any differences of disclosure between the divisional applications was essentially a question of analysing the respective claims as formulated by the patent proprietor/appellant or the representatives. Under these circumstances the board considers that the opposition division had no obligation to set longer time limits than those set in the EPC to safeguard the patentee's right to be heard (Article 113(1) EPC 1973). The appellant's reference to Rule 115 EPC (former Rule 71(1) EPC 1973) concerns the minimum period of two months' notice of the summons. In the present case this minimum period was also respected.

2.3.2 In the present case the notice of opposition with all the potentially relevant grounds for opposition was transmitted to the patentee with a communication dated 10 February 2006 and the patentee was given a total of twelve months to reply to the opposition division's

communication dated 27 April 2007. Hence the time limit was in the board's view sufficient for the patent proprietor and the representatives to draw up a response to each of the grounds for opposition. As far as the time for the preparation of oral proceedings is concerned (see Rule 116 EPC), five months' notice of the summons to oral proceedings was given and there was a period of four months between the issuing of the summons to oral proceedings and the "final date for making written submissions" referred to in Rule 116 EPC. This period too, in the board's view, was sufficient to prepare a written response.

The appellant's argument that, when the opposition division issued the summons to oral proceedings, it had been reasonable to assume that all grounds still relevant for not maintaining the opposed patent were confined to Article 100(a) EPC 1973 does not convince the board. The opposition division had not abandoned the ground for opposition which in the end was relevant for the decision: on the contrary, it indicated in the communication dated 27 April 2007 that "[o]bservations relating to the objections to patentability raised by the former opponents at points III to V of the notice of opposition are not strictly necessary, **but they would be welcome** to provide the Division with a more complete overview of the situation at the next stage of the procedure" (emphasis by the board). In respect of the summons to oral proceedings the board notes that Rule 116 EPC obliges the European Patent Office to draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. But neither Rule 116 EPC nor Article 113(1) EPC 1973 obliges the opposition division to identify in advance

of the oral proceedings that (or those) particular ground(s) for opposition (of the totality of grounds for opposition raised in the opposition proceedings) which will be decisive in the written reasons for the decision. The opposition division also indicated in the summons to oral proceedings that "[o]ther arguments presented by the former opponents against the validity of the granted patent could be discussed too, depending on the outcome of the discussion".

2.3.3 The appellant's argument that the opposition division raised the decisive added subject-matter issue only three working days before the oral proceedings and so did not give the patentee sufficient time to prepare the oral proceedings does not convince the board either. The decisive added subject-matter issue had been raised by the opponent in the notice of opposition and the patentee was given sufficient time to comment on it in writing. Furthermore, the patentee was in fact prepared for the oral proceedings and submitted arguments in the oral proceedings before the opposition division (see points 2.2 and 2.3 of the minutes of the oral proceedings) which in substance were essentially the same as those submitted in the respective section of the statement of grounds of appeal. Finally, the fact that the former opponent had raised a large number of grounds for opposition does not entitle the patentee under Article 113(1) EPC 1973 to know in advance which of these grounds for opposition is or are, in the opposition division's view, the most relevant.

2.4 Hence in the present case there was no obligation to postpone the oral proceedings before the opposition division to safeguard the patentee's right to be heard



(Article 113(1) EPC 1973). Thus no fundamental deficiencies within the meaning of Article 11 RPBA are apparent in the first-instance proceedings.

2.5 In view of the above the appellant's request for remittal to the first instance under Article 11 RPBA is refused.

3. *The added subject-matter issue*

3.1 The meaning of Article 100(c) EPC 1973 for a patent granted on divisional applications

3.1.1 Article 100(c) EPC 1973 specifies that opposition may be filed on the ground that "the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application ... beyond the content of the earlier application as filed." Hence, in the board's view, a patent granted on a divisional application may be opposed under Article 100(c) EPC 1973 both on the ground that its subject-matter extends beyond the content of the divisional application as filed (to deal with the case where an infringement of Article 123(2) EPC was overlooked in examination proceedings) and on the ground that its subject-matter extends beyond the content of the earlier application as filed (to deal with the case where an infringement of Article 76(1) EPC 1973 was overlooked in examination proceedings). This is also the view taken, for instance, in T 441/92 (see point 4.2), T 57/96 (see point 1.1) and T 475/02 (see point 2.1). Similarly, Article 138(c) EPC 1973 specifies that a European patent may be revoked with effect for a contracting state on the ground that "the

subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application ... beyond the content of the earlier application as filed."

- 3.1.2 The board is not aware of a decision supporting the appellant's view that a purported infringement of Article 123(2) EPC in examination proceedings is not a ground for opposition to a patent granted on a divisional application (and not a ground for revocation of such a patent). On the contrary, it is established case law that for non-divisional applications Article 100(c) EPC 1973 is related to Article 123(2) EPC in the sense that it is applicable only if the application has been amended during the proceedings before grant in a manner contrary to what is allowed under Article 123(2) EPC (see the decision of the Enlarged Board of Appeal G 1/93, OJ EPO, 541, point 2 of the reasons). In addition, for divisional applications, the identical wording of relevant parts of Articles 76(1) EPC 1973, 100(c) EPC 1973 and 123(2) EPC ("beyond the content of the earlier application as filed"; which is also mentioned among the grounds for revocation in Article 138(1)(c) EPC 1973) implies in the board's view that Article 100(c) EPC 1973 is also related to Article 76(1) EPC 1973 in the sense that it is at least applicable if the divisional application infringed Article 76(1) EPC 1973 and this defect was not removed before the grant of the patent. The connection between Articles 76(1), 100(c) and 138(1)(c) EPC 1973 is also considered in G 1/06, OJ EPO 2008, 307, point 3.6. In this context the board notes that the legislative history too shows that the decision to additionally include added subject-matter with respect

to the earlier application in the list of possible grounds for opposition and grounds for revocation was a consequence of the decision not to allow added subject-matter in divisional applications, as set out in Article 76(1) EPC 1973. This can be taken, for instance, from the *travaux préparatoires* (see point 157 of Doc. BR/135 e/71, p. 91 discussed in the decision of the Enlarged Board of Appeal G 1/06, section 4 of the Reasons).

- 3.1.3 Furthermore, the view that a purported infringement of Article 123(2) EPC in examination proceedings is not a ground for opposition to a patent granted on a divisional application would not be consistent with the fact that a divisional application is an independent application. Divisional applications are to be treated in the same manner as ordinary applications and are subject to the same requirements, unless specific provisions of the EPC require something different (see G 1/06, points 3.1 and 8.1). In particular, divisional applications have to comply with both Articles 76(1) EPC 1973 and 123(2) EPC (see, for instance, T 441/92, point 4.1 and G 1/06, points 3.3 and 9.2).

3.2 The relevance of G 1/06 in opposition proceedings

- 3.2.1 Both Articles 76(1) and 100(c) EPC 1973 (see section 3.1.1 above) refer to the "earlier application". It is not contested that both articles prohibit adding subject-matter beyond the content of the immediately preceding application from which a divisional application was derived. The appellant also accepted that it is the purpose of these articles to prohibit extending the subject-matter beyond the root

application as filed. However, the appellant's main argument was that an infringement of Article 76(1) EPC 1973 in the case of an intermediate higher-generation divisional application did not constitute a ground for opposition under Article 100(c) EPC 1973. This argument is not convincing, because Article 100(c) EPC 1973 gives the public the possibility of *inter alia* opposing a patent on the ground that its subject-matter extends beyond the content of the earlier application as filed if an infringement of Article 76(1) EPC 1973 was overlooked in examination proceedings. In view of the connections of these articles and the relevant findings of the Enlarged Board in G 1/06 for a sequence of divisional applications, the present board considers that an infringement of Article 76(1) EPC 1973 constitutes a possible ground for opposition under Article 100(c) EPC 1973. This applies also in the particular case of an infringement of Article 76(1) EPC 1973 in an intermediate higher-generation divisional application.

- 3.2.2 The argument that the interests of third parties were not affected because the public was aware, by means of the pending root application, that anything disclosed in the root application might be claimed in a divisional application does not convince the board that intermediate higher-generation divisional applications are irrelevant in opposition proceedings (as opposed to the finding in G 1/06 for examination proceedings). This argument is not relevant to the present opposition appeal proceedings because the root application was no longer pending when the application resulting in the opposed patent was filed.

3.2.3 Also the argument that the omitted feature was disclosed in the root application and had been reintroduced into the grandparent application does not convince the board that intermediate higher-generation divisional applications are irrelevant in opposition proceedings (as opposed to the finding in G 1/06 for examination proceedings). This amendment made to the grandparent application did not change the content of the grandparent application as filed. In particular this amendment cannot be deemed to have retroactively become part of the content of the grandparent application as filed. Instead, after filing, the grandparent application remained independent and separate from the root application, each of these applications as filed having their own content. There is no basis in the EPC for a retroactive effect of amendments on the content of an application as filed, and the board is not aware of any decision supporting the view that this effect may exist. Such a retroactive effect of amendments would be contrary, for instance, to the purpose of Article 123(2) EPC (see G 1/93, OJ EPO 1994, 541, point 9). The retroactive effect of amendments made in opposition proceedings (see Article 68 EPC) concerns the effects specified in Articles 64 and 67 EPC, but not the content of the application as filed.

3.2.4 In particular, nothing in G 1/05 (OJ EPO 2008, 271) and G 1/06 (OJ EPO 2008, 307) can be seen as supporting the idea of a retroactive effect of amendments on the content of an application as filed. Point 2.2 of G 1/05 (and of the identical reasons in G 1/06) explains that if the concept of "invalidity of a divisional application" were accepted then an "invalid divisional

application" could not be made valid by way of amendment. Point 2.9 then gives the conclusion of section 2 that a divisional application which does not meet the requirements of Article 76(1) EPC 1973 is not invalid. Sections 3 to 6 give the reasons why an applicant of a divisional application which does not meet the requirements of Article 76(1) EPC 1973 has a procedural right to amend the divisional application so that it does so. This procedural right to amend is however not unrestricted. As set out in point 7 of G 1/05, an amendment of a divisional application to comply with Article 76(1) EPC 1973 must meet the other requirements of the EPC.

- 3.2.5 The board agrees with the appellant that G 1/06 mainly concerns questions relating to sequences of divisional **applications** (emphasis by the board). But in point 3.6 it nevertheless points to the connection between Articles 76(1) EPC 1973 and 100(c) EPC 1973. In view of the connections between Articles 76(1) EPC 1973, 100(c) EPC 1973 and 123(2) EPC and in view of the fact that a divisional application is an independent application which is to be treated in the same manner as an ordinary application and is subject to the same requirements, unless specific provisions of the EPC require something different (see section 3.1 above), the board is convinced that also a patent granted on a divisional application which is part of a sequence of divisional applications may be opposed on the ground that its subject-matter extends beyond the content of the earlier application as filed, to deal with the case where an infringement of Article 76(1) EPC 1973 was overlooked in examination proceedings. This is consistent with the purpose of the opposition procedure

(to give the public the opportunity to challenge the validity of the patent; see decision of the Enlarged Board of Appeal G 9/93 OJ EPO 1994, 891, point 3 of the Reasons).

3.2.6 Therefore in the board's view the findings of the Enlarged Board of Appeal concerning the interpretation of Article 76(1) EPC 1973 in the context of sequences of divisional applications are also to be applied when examining whether a ground for opposition under Article 100(c) EPC 1973 prejudices the maintenance of a patent granted on a divisional application which is part of a sequence of divisional applications. This is also the view taken in decision T 687/05 (see point 3.1). Consequently the board agrees with the statement in T 687/05 (see the headnote) that "in order to meet the requirements of Article 100(c) EPC, it is a necessary and sufficient condition that anything disclosed in the granted patent must be directly and unambiguously derivable from not only the application on which the patent has been granted but also from what is disclosed in each of the preceding applications as filed". The board is not aware of any decision taking a diverging view.

3.2.7 The argument that point 11.2 of G 1/06 was not applicable in the present case because the applicant had not deliberately omitted the feature "the scanning sequence of the transform coefficients being changed on a block by block basis" does not convince the board. Point 11.2 of G 1/06 summarises, for the case of sequences of divisional applications, the conditions under which it is justified to accord the filing date of the first disclosure, in the root application, of

the subject-matter concerned. One of these conditions is that said subject-matter was disclosed in each of the preceding (earlier) applications as filed. Subject-matter not disclosed in each of the preceding (earlier) applications as filed is "[c]ontent which has been omitted on filing a member higher up the sequence" in point 11.2, second paragraph, of G 1/06 and thus cannot be reintroduced into that member or in divisional applications lower down the sequence from it. This objective condition is not dependent on the applicant's subjective intentions at the time of filing the preceding application(s). In view of the connection between Articles 76(1) and 100(c) EPC 1973 (see section 3.1 above), the board does not see any reason why these subjective intentions should play a role in opposition proceedings when examining whether a ground for opposition under Article 100(c) EPC prejudices the maintenance of a patent.

In the present case this objective condition relating to the **filing of the earlier application** is not met (see point 3.4 below). Thus it does not matter if the further condition given in point 11.2 of G 1/06 is met, namely that the subject-matter concerned may not have been unequivocally and definitely abandoned at the time of **filing the divisional application** under consideration.

3.3 The effect of the grant of a patent on the grandparent application

3.3.1 Since a divisional application is independent and separate from the parent application unless the EPC provides otherwise, allowing an amendment in a parent



application does not mean that there is a legal obligation to allow the same amendment in a divisional application divided from the parent application. It is clear that contradictory decisions on an identical issue may cause confusion, but an examining division may have good reasons for not following an earlier decision of another examining division in another set of examination proceedings, even if the same issue is concerned. Similarly, opposition divisions may take views which do not follow an earlier view adopted by an examining division, even if the same issue is concerned.

3.3.2 In particular, the examining division's decision to grant a patent on the grandparent application only concerned the grandparent application under examination. There is no basis in the EPC for a binding effect of a decision to grant a patent on a grandparent application on an examining division entrusted with the examination of a divisional application divided from the grandparent application. Such a binding effect would also not be consistent with the fact that a divisional application is an independent application.

3.3.3 The argument that the issue was *res iudicata* does not convince the board. The examining division's decision to grant a patent (Article 97(2) EPC 1973) on the grandparent application concerned subject-matter which was substantially different from that of the present opposition proceedings.

3.3.4 Hence the board finds that the grant of a patent on the grandparent application is not relevant for the present opposition appeal proceedings.

3.4 Application to the present case

3.4.1 The decision under appeal is based on the finding that the feature "the scanning sequence of the transform coefficients being changed on a block by block basis" in claim 1 of the opposed patent was not disclosed in the grandparent application as filed. The appellant submitted that a generalised version of this feature was disclosed in the grandparent application as filed. According to the appellant, this generalised feature of controlling the encoding characteristic with the selected prediction signal and the information of the selected blocking implied the specific feature.

3.4.2 However, the appellant has also indicated in the statement of grounds of appeal (see page 13, fourth paragraph) that a person skilled in the art will know that the scanning sequence of the transform coefficients is one of a number of possible encoding characteristics, other encoding characteristics being, for example, the kind of variable length coding used for the coefficients or the consideration of saturation effects. Furthermore the appellant has also indicated in the statement of grounds of appeal (see page 11, last paragraph) that the grandparent application as filed refers to the "quantization characteristic of the transform coefficient" as also being in accordance with the selected blocking. The quantization characteristics are a further example of encoding characteristics, but cannot be equated with the encoding characteristics.

3.4.3 Since the scanning sequence of the transform coefficients is undisputedly only one of a number of encoding characteristics, the mere disclosure of the

general "encoding characteristic" being in accordance with the selected blocking in the grandparent application as filed leaves open which of the more specific characteristics are changed in accordance with the selected blocking and which may be independent of the selected blocking. In particular, it is not directly and unambiguously derivable from this general disclosure that in particular the scanning sequence of the transform coefficients is changed on a block-by-block basis as specified in claim 1 of the opposed patent.

3.4.4 Hence the board agrees with the decision under appeal that the subject-matter of claim 1 of the opposed patent extends beyond the content of the earlier application as filed in that it contains subject-matter which was not disclosed in one of the preceding (earlier) applications as filed, namely the grandparent application. For the reasons given in section 3.2 above, the grandparent application too is "the earlier application" within the meaning of Article 100(c) EPC. Hence a ground for opposition under Article 100(c) EPC prejudices the maintenance of the patent. Therefore the opposition division's decision to revoke the patent was correct (see Article 101(2) EPC). Thus the appeal is to be dismissed.

4. *The request for referral to the Enlarged Board of Appeal*

4.1 Pursuant to Article 112(1)(a) EPC 1973, "In order to ensure uniform application of the law, or if an important point of law arises ... the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the

appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes."

- 4.2 The present appeal is against the decision of an opposition division of the EPO in which questions concerning national revocation proceedings are not relevant for the outcome of the case. Thus a referral to the Enlarged Board of Appeal of the second and third points of law submitted by the appellant, in so far as they are concerned with the interpretation of Article 138(1)(c) EPC 1973, is not necessary.
- 4.3 In the present case it follows from points 3.2.3 and 3.2.4 above that, in the board's view, the first point of law (in so far as the interpretation of Article 100(c) EPC is concerned) submitted by the appellant may be answered without any doubt. The answer is "no", and the board is not aware of any decision supporting the opposite answer. Hence there is no need to refer the first point of law to the Enlarged Board of Appeal.
- 4.4 Furthermore, it follows from points 3.1.1 to 3.1.3 above that, in the board's view, the second point of law (in so far as the interpretation of Article 100(c) EPC is concerned) submitted by the appellant may likewise be answered without any doubt. Again, the answer is "no", and the board is not aware of any decision supporting the opposite answer. Hence there is no need to refer the second point of law to the Enlarged Board of Appeal, either.

4.5 Lastly, it follows from section 3.3 above that, in the board's view, the third point of law (in so far as the interpretation of Article 100(c) EPC is concerned) submitted by the appellant may also be answered without any doubt. Here too, the answer is "no", and the board is not aware of any decision supporting the opposite answer. Hence there is also no need to refer the third point of law to the Enlarged Board of Appeal.

## **Order**

### **For these reasons it is decided that:**

1. The appeal is dismissed.
2. The request for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:

K. Boelicke

F. Edlinger