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D E C I S I O N
of 10 March 1995

Case Number: T 0441/92 - 3.5.1
Application Number: 85111981.8
Publication Number: 0179283
IPC: H04Q 7/04
Language of the proceedings: EN

Title of invention:

Portable radio for a zoned data communications system
communicating message signals between portable radios and a
host computer

Applicant:

MOTOROLA, INC.

Opponent:

-

Headword:

Divisional application/MOTOROLA, INC.

Relevant legal provisions:

EPC Art. 76, 123(2), 100(c), 138(1)(c)
EPC R. 25(2)

Keyword:

"Interchange of subject-matter between parent and divisional
applications"

"Double patenting (no)"

"Abandonment of subject-matter (no)"

"Claims consistent with original disclosure (yes)"

Decisions cited:

J 0010/88, T 0178/84, T 1055/92, T 0066/85, T 0284/85,
T 0229/86, T 0514/88, T 0133/85, T 0331/87, G 0002/92,
T 0061/85, T 0118/91, J 0015/85

Catchword:

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Case Number: T 0441/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 10 March 1995

Appellant:

MOTOROLA, INC.
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Representative:

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Decision under appeal:

Decision of the Examining Division of the European
Patent Office dated 22 January 1992 refusing
European patent application No. 85 111 981.8
pursuant to Article 97(1) EPC.

Composition of the Board:

Chairman: P. K. J. van den Berg
Members: G. Davies
A. S. Clelland
W. B. Oettinger
C. Holtz

Summary of Facts and Submissions

- I. European patent application No. 85 111 981.8, was filed on 21 September 1985 as a divisional application of Euro-PCT application No. 83 903 706.6 (the parent application), claiming the priority date of 12 November 1982 from US application No. 441 327. By a decision of the Examining Division dated 20 November 1987, which became final after an appeal against it was held inadmissible (c.f. J 10/88 of 13 February 1989), the parent application was refused, following failure on the part of the Applicant to indicate in due time its approval to the text in which the Examining Division intended to grant the application, which had been notified to the Applicant pursuant to Rule 51(4) on 30 June 1987.
- II. The divisional application was refused by a decision of the Examining Division dated 22 January 1992. The decision was based on a main request dated 21 October 1991 with respect to a set of Claims 1 to 13 and an auxiliary request for a different set of Claims 1 to 3. The main request was refused on the following legal grounds:
- (i) Claims 1 to 13 comprised the same subject-matter as Claims 1 to 13 of the parent application, filed with the Applicant's letter of 17 December 1986 during the examination proceedings with respect to the parent application, contrary to the Guidelines for examination in the EPO (hereinafter "Guidelines"), C-VI, 9.6;
 - (ii) Once a divisional application has been filed, it becomes independent from the parent application so that no interchange of subject-matter is thereafter possible. In principle, according to the text of Rule 25(2) in force prior to 1 June 1991, the divisional application should also have its own description, drafted to

correspond to the subject-matter of the divisional. In consequence, it was stated, the fact that in the EPO's practice the Applicant is allowed to maintain in a divisional application the description of the parent application unamended does not automatically enable him to (re)-introduce or take out subject-matter at his volition [**sic**]. Therefore, the subject-matter of these claims (which were amended claims) extended beyond what was disclosed in the divisional application at the time it was filed, contrary to Article 123(2).

- III. As regards the auxiliary request, the reason given for the refusal was that the subject-matter of Claims 1 to 3 did not involve an inventive step.
- IV. The Appellant lodged an appeal against the decision of the Examining Division to refuse the divisional application and paid the appeal fee on 1 April 1992. The statement of grounds was filed the same day. The appeal was limited to the extent that the decision had refused the Applicant's main request.
- V. The arguments of the Appellant in support of the appeal may be summarised as follows:
- (i) the decision was **ultra vires** the European Patent Convention and the Implementing Regulations; it was based on an interpretation of the Guidelines and not on any provision of the EPC;
 - (ii) there could be no objection to the parent and divisional applications claiming the same subject-matter since the parent application had lapsed irrevocably; thus there was no question of double patenting;
 - (iii) an Applicant was entitled to maintain in a divisional application the description of the parent application unamended. When an Applicant files a divisional application, it must be entitled to claim whatever subject-matter is new, inventive and capable of

industrial application (subject to all the provisions of the EPC and its rules). The Examining Division had objected that the description and drawings related to matter for which protection had not been sought in the claims of the divisional application as filed, citing the version of Rule 25(2) EPC then in force. According to that Rule: "Where possible, the description and drawings of [...] any divisional application shall relate only to the matter for which protection is sought by that application." In the present case, the description and drawings did relate only to the matter for which protection was sought. Rule 25(2) (old version) required a correlation between the description and drawings and the claims **as granted**. The Applicant would be entitled to submit claims to all sorts of subject-matter for which protection had not been sought at the time of filing (provided the claims were supported by the description and drawings) and if necessary the Applicant would be entitled to file divisional applications for such subject-matter. The rule did not bear the interpretation placed upon it by the Examiner. In any case, the Rule needed only to be applied "where possible". Furthermore, Rule 25(2) EPC, as amended by the Administrative Council with effect from 1 June 1991 by the deletion of the provision in question, supported the Appellant's case.

(iv) There was no violation of Article 123(2) in the present case, because the subject-matter claimed was clearly supported by the description and Figure 6 thereof.

Reasons for the Decision

1. The appeal is admissible.
2. The first reason given by the Examining Division for the refusal of the main request was that the claims thereof comprised the same subject-matter as Claims 1 to 13 of the parent application as filed on 17 December 1986 during the examination proceedings of the parent application. In support of its decision, the Examining Division referred to the Guidelines C-VI, 9.6, where it is stated that: "The parent and divisional applications may not claim the same subject-matter. This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words." Reference was also made to the Guidelines IV, 6.4, where it is stated that "it is an accepted principle in most patent systems that two patents shall not be granted to the same Applicant for one invention".
 - 2.1 Article 76 EPC establishes the rules governing European divisional applications. Paragraph (1) thereof provides as follows: "A European divisional application ... may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority". The procedure to be followed in relation to divisional applications is provided for in Rule 25 of the Implementing Regulations. There is no mention of the issue of double patenting in any of these provisions.

2.2 However, the Board finds that in the present case the question of double patenting does not arise. By the time that, in March 1990, the Appellant submitted the amendments to the divisional application which brought it into the identical form which had been proposed by the EPO for grant for the parent application in its communication under Rule 51(4) EPC dated 30 June 1987, the parent application had already ceased to exist. No rights had been conferred on the Applicant in relation to the parent application since it had been refused (Article 67(4) EPC). Thus, in this case, there is no question of two rights resulting from two patents being granted to the same Applicant for the same invention.

3. The second argument of the Examining Division that no interchange of subject-matter between a parent and a divisional application is possible once the divisional has been filed, is based on its interpretation of the version of Rule 25(2) EPC in force up to 1 June 1991, and the Guidelines, C-VI, 9.5. It was argued also that this proposition was supported by the case law of the Boards of Appeal in relation to Rule 46, with particular reference to decision T 178/84 (OJ EPO 1989, 157).

3.1 The version of Rule 25(2) EPC in force until 1 June 1991, reads as follows:

"Where possible, the description and drawings of the earlier European patent application or any European divisional application shall relate only to the matter for which protection is sought by that application. However, when it is necessary for an application to describe the matter for which protection is sought by another application, it shall include a cross-reference to that other application."

This provision was deleted with effect from 1 June 1991 so as to conform with EPO practice, according to which an unamended description, identical to that contained in the parent application, was normally accepted. According to the reason given for the proposed change at the time (c.f. document CA/52/90 of 7 August 1990), in the interest of more flexibility both for the EPO and the Applicant, it was thought preferable to leave it to the Examining Division to deal with amendments to the description and drawings taking into account the relevant circumstances of the case and to deal with the matter in the Guidelines rather than by regulation in the Implementing Regulations.

The passage of the Guidelines relied on by the Examining Division (C-VI, 9.5) is the following:

"The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application."

- 3.2 In the present case, it is a matter of fact that the divisional application was filed on 21 September 1985 with a description which was, with the exception of the statements of field and objects of the invention, substantially identical to that of the parent application. No objection was raised to this by the Examining Division during the nearly five-year examination procedure prior to the correspondence following the filing of the amendments comprising the

present main request on 23 March 1990, which led to the decision under appeal. Moreover, that decision was dated 22 January 1992, when the version of Rule 25(2) EPC relied on by the Examining Division had ceased to apply for more than six months. It should be noted that Articles 3 (transitional provisions) and 5 (entry into force) of the Decision of the Administrative Council of 7 December 1990 amending the Implementing Regulations to the European Patent Convention and the Rules relating to Fees (OJ EPO 1991, 4) make it clear that the amendments to the Rules were to enter into force with respect to pending applications on 1 June 1991, with specific exceptions relating only to Rules 30 and 104b, paragraph 1, of the Implementing Regulations. In this regard, the Board has noted that the Examining Division relied in its decision on an opinion from a legally qualified examiner, written before the amendment to the Rules entered into force, stating incorrectly that the said amendment did not change the legal situation.

- 3.3 The Board takes the view, therefore, that there is nothing in the EPC to prevent an Applicant from repeating the parent description in a divisional application and that there is no contravention of Article 76(1) in this respect in the present case.
4. Based on the argument that no interchange of subject-matter between the parent and divisional applications is possible after the filing of the divisional application, the Examining Division further argued that introducing in the divisional application claims from the parent application corresponded to adding subject-matter extending beyond what was disclosed in the divisional application at the time it was filed, contrary to Article 123(2) EPC.

4.1 This raises the question of the nature of divisional applications. It is a generally accepted principle of patent law that, once a divisional application has been validly filed, it becomes separate and independent from the parent application. Thus, once the conditions of Article 76(1) have been met, the divisional application is to be examined as an application quite separate from the parent application and must itself comply independently with all the various requirements of the EPC. On this point, the Board agrees with the practice, supported by the case law of the Boards of Appeal (c.f. T 1055/92 (to be published), point 7 of the Reasons for the Decision and T 284/85 of 24 November 1989 (unpublished), points 2 and 3 of the Reasons for the Decision), according to which each divisional application must comply not only with the requirements of Article 76(1) EPC but also with those of Article 123(2) EPC.

4.2 The conclusion that the requirement of Article 76(1) EPC is separate from that of Article 123(2) EPC, i.e. that the divisional application must neither extend beyond the content of the earlier (parent) application as filed nor be amended after filing in such a way that it contains subject-matter which extends beyond the content of the divisional application as filed, is also consistent with Articles 100(c) and 138(1)(c) EPC, which the Board interprets as meaning that there is a separate provision for opposition, beside that relating to Article 123(2) EPC, to deal with the case where an extension of the divisional application beyond the content of the parent application may have been overlooked during examination. The purposes of the requirements of Articles 76(1) and 123(2) are different and it would be anomalous if divisional applications did not have to meet the requirements of both.

- 4.3 The second sentence of Article 76(1) EPC provides that a divisional application "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed". This provision generally corresponds to Article 123(2) EPC, and constitutes a substantive condition for allowability of the application-in-suit as a divisional application. Thus the criterion for admissibility of the claims of the application-in-suit as claims of a divisional application, i.e. of an application having the deemed filing date of the parent application, is the same as that set out in Article 123(2) EPC in relation to amendment of a normal application. The content of the application means, in respect of both Articles 76(1) and 123 (2) EPC, the total information content of the disclosure, (c.f. T 229/86 of 28 September 1988 (unpublished) and T 514/88 (OJ EPO 1992, 570), points 2.1 and 2.2 of the Reasons for the Decision).
- 4.4 The relevant issue to be decided here therefore is whether or not the amended claims in question are consistent with the original disclosure in the divisional application as filed. This is in contrast to the position during opposition proceedings, i.e. after grant of the patent, when Article 123(3) EPC prohibits amendment of the **patent** "in such a way as to extend the protection conferred". There is thus a clear distinction made between the restriction **before grant** to subject-matter that does not go beyond the content of the application as filed, and the additional restriction **after grant** to the scope of protection as conferred by the granted patent.
- 4.5 According to the case law of the Boards of Appeal, Article 123(2) EPC has to be interpreted as meaning that where a feature is entirely omitted from a claim, thus broadening its scope, such excision is not permissible,

whether this feature appears relevant or not to the features which represent the inventive concept of the subject-matter claimed, **unless there is a basis for the broadened claim in the original application**. Such a basis need not be presented in express terms but it must be sufficiently clear to a person skilled in the art to be unambiguously recognisable as such (c.f. T 66/85 (OJ EPO 1989, 167)). Thus, there may be cases where a divisional application contains the identical description to that of the parent application but where new claims are introduced directed to an entirely different invention or which remove an essential feature of the claimed invention with the result that the new claims are no longer supported by the description. However, this issue does not arise in this case, since the claims objected to by the Examining Division appear to the Board to be directly and unambiguously derivable by the skilled man from the description as filed with the present divisional application and as it remained at the time the amended claims in question were filed; there is also no contradiction to the totality of the original disclosure (c.f. T 514/88, **supra**, points 2.3, 2.4 and 2.7 of the Reasons for the Decision, T 66/85, **supra**, T 133/85 (OJ EPO 1988, 441), T 331/87 (OJ EPO 1991, 22) and T 229/86, **supra**).

- 4.6 In the present case, as stated above, the material in the current claims is directly and unambiguously derivable from the description of the divisional application as filed. For example, the subject-matter of independent Claims 1 and 10 is clearly disclosed at page 6, line 19 to page 7, line 11, page 8, line 29 to page 9, line 8 and page 9, line 23 to page 10, line 30, and in Figures 6. It may be mentioned also that, although these claims include substantial amendments vis-à-vis the original claims of the parent application, no objections under Article 123(2) were raised by the

Examining Division of the EPO when they were submitted in that case. The divisional application as originally filed did claim a different invention to that specified in the current claims. However, it is to be noted that the application documents as a whole, in particular the description, did indicate that the features currently claimed also constituted an invention in the view of the Applicant (see, for example, page 9, lines 5 and 6, 9 and 10 and 35).

4.7 Interested members of the public are put on notice by the EPC that, after a European patent application has been filed, the content of that application cannot thereafter be extended, but that, nevertheless, while the application is pending, the protection sought by the claims may be extended beyond that sought in the claims as originally filed. The public are informed as to the content of the application as filed when the application is published (see Article 93(2) EPC). In this respect, there is no distinction between a normal application and a divisional application. To this may be added that the public has access to the files of an earlier parent application by virtue of Article 128(3) EPC.

4.8 It follows that, in the present case, in the Board's view, the fact that the proposed divisional application contains claims which are different from those which were originally filed for that application does not introduce subject-matter beyond the content of the parent application and thus does not contravene Article Article 76(1) EPC. It does not contravene Article 123(2) EPC either, since all the claims are directly and unambiguously derivable from the description of the divisional application as filed.

5. The Examining Division relied also on decision T 178/84, *supra*, in support of its argument that interchange of subject-matter between parent and divisional application is not allowable. That case was concerned with issues related to unity of invention and decided that it was within the intention of Rule 46(1) EPC to regard subject-matter as abandoned in a particular application if, in response to an invitation to pay a further search fee, the additional search fee is not paid. However, the Board also held in that case that the Applicant may still file a divisional application in respect of the material for which a search fee is not paid (see Reasons for the decision, point 4.2, last paragraph). Thus, according to the decision, the subject-matter is not considered as having been definitively abandoned in these circumstances. Moreover, the Board noted that it was the general intention of the EPC to leave it to the Applicant to decide with which subject-matter (i.e. which one of a plurality of disclosed inventions) a patent application is to proceed and that normally the Applicant should be free to decide this question as he sees fit. The Board points out that decision T 178/84 was subsequently considered by the Enlarged Board of Appeal in its Opinion in G 2/92 (OJ EPO 1993, 591). The Enlarged Board similarly found that an Applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division under Rule 46(1) EPC cannot pursue that application for the subject-matter in respect of which no search fees have been paid, but that such an Applicant must file a divisional application in respect of such subject-matter if protection is sought therefor.
- 5.1 The Board, therefore, finds no support for the arguments of the Examining Division in either of these decisions.

6. The question still arises, however, whether at the time the parent application in the present case lapsed the subject-matter of its claims could be considered to have been abandoned. There have been few decisions of the Boards of Appeal concerned with the question of abandonment. In J 15/85 (OJ EPO 1986, 395), the Legal Board of Appeal took the view that, if an Applicant cancels claims included in a European patent application but fails to state at the same time that deletion is without prejudice to the filing of a divisional application, the Examining Division will be obliged to refuse its consent to the subsequent filing of a divisional application.
- 6.1 In a later decision, T 61/85 of 30 September 1987 ([1988] 1 EPOR, 20), the Board ruled that, if on the true interpretation of a statement made by an Applicant or Patentee, it may be considered that a particular subject-matter has been expressly abandoned together with the complete deletion of the appropriate claim and, in addition, all support therefor in the specification, the same cannot be reinstated.
- 6.2 These decisions were based on the reason that, once an Applicant or a Patentee, without making any reservation, has taken an action resulting in a limitation of the matter for which protection was previously sought, the public should be entitled to draw reliable conclusions from that action, e.g. as to the possibility of freely exploiting the abandoned subject-matter. It is arguable that these decisions are not relevant to this case, since the question to be decided is whether, by lapse of the parent application, the claims therein are irrevocably lost. Abandonment, therefore, is not the issue here.

- 6.3 It is questionable also whether these decisions are relevant to the issue of the relation between parent and divisional applications. In any case, neither of these decisions supports the view that in the present case there was abandonment of the subject-matter of the claims of the parent application at the time that application lapsed. There was no express abandonment of the claims and, at that time, the divisional application had already been filed with the same description as the parent application so that the public was already on notice as to the possible scope of protection sought in the divisional application.
- 6.4 In decision T 118/91 of 28 July 1992 (unpublished), the Board considered the argument that the filing of a divisional application led to the abandonment of the subject-matter thereof in the parent application, which accordingly could no longer be considered as belonging to the original disclosure of that application. The Board found that there was nothing in Article 76 EPC or any other provision of the EPC to support that contention, stating clearly that the content of the application as filed cannot as a matter of logic be reduced by the subsequent filing of a divisional application (c.f. Reasons for the Decision, point 2.4.1). By analogy, for the reverse situation, this Board finds that the lapse of a parent application cannot have the effect of reducing the content of a previously filed divisional application.
7. The Board, therefore, sees no objection in principle to the grant of a patent on the basis of the main request, comprising the Claims 1 to 13 and description pages filed on 23 March 1990, together with the remaining description pages and drawings as published. The Board notes that these claims correspond to Claims 1

to 13 of the parent application as proposed by the EPO in the communication under Rule 51(4) EPC dated 30 June 1987 for the grant of the parent application.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to grant the patent on the basis of Claims 1 to 13 and description pages 3 to 5, 7, 8, 17, 29 and 30, filed on 23 March 1990, and description pages 1, 2, 6, 9 to 16, 18 to 23 and 23a to 27 (renumbered 24 to 28) and drawings, sheets 1 to 8, as published.

The Registrar:

The Chairman:

M. Kiehl

P. K. J. van den Berg

