
Filing of divisional patent applications after publication of the mention of the grant under the European Patent Convention

Decision J 01/24 of the Legal Board of Appeal of the European Patent Office dated April 16, 2024

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Like J 28/03, J 01/24 deals with the question whether a European patent application is still "*pending*" after filing an appeal against the decision to grant the respective patent even though the mention of the grant has already been published. With its decision J 01/24 dated April 16, 2024, the Legal Board of Appeal of the European Patent Office (EPO) departed from the principle stated in J 28/03 that the answer to the question whether the patent application was still "*pending*" depended on the outcome of the appeal. Instead, the decision J 01/24 assessed whether substantive rights (e.g., provisional protection) still derive from the patent application. This was the case as, according to the current common practice of the EPO, the appeal of the applicant against the grant of the patent was treated as validly filed, with the consequence that the mention of the grant was deleted. Decision J 01/24 thus provides applicants which have overlooked to file a European divisional application before the publication of the mention of the grant of the parent application with a workaround to cure said deficiency by filing an appeal against the decision to grant and subsequently filing the divisional application.

1. Summary of Facts and Submissions

Decision J 01/24 concerns the admissibility of filing a divisional European patent application after the publication of the mention of the grant of the earlier application.

The appeal is directed against the interlocutory decision of the Receiving Section dated 14 September 2023 that the later application will not be treated as a divisional application of the earlier application. The Receiving Section allowed a separate appeal against the decision under Article 106(2) EPC.

A decision to grant was issued for the earlier application on 18 February 2021, setting an original date of publication of the mention of the grant as 17 March 2021.

On April 16, 2021, the applicant filed a notice of appeal against the decision to grant the earlier application and paid the appeal fee.

By a brief communication dated May 6, 2021, the Examining Division that was responsible for the earlier application informed the applicant that the decision to grant maintained its effect and remained valid, but that the date of publication of the mention of the grant had been deleted.

On May 24, 2021, the request for grant of a divisional application based on the earlier application was filed.



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On June 18, 2021, the applicant filed the grounds of appeal.

In response to a status enquiry, the Receiving Section issued a brief communication informing the applicant that the status of the later application depended on the outcome of the appeal filed in respect to the earlier application.

On April 7, 2022, the applicant withdrew its appeal against the decision to grant the earlier application.

On May 18, 2022, the Receiving Section issued a noting of loss of rights pursuant to Rule 112(1) EPC. The Receiving Section found the later application could not be processed as a divisional application. With reference to the decision of the Legal Board of Appeal in J 28/03, the Receiving Section noted that the appeal against the decision to grant in respect of the earlier application had been withdrawn. The decision to grant the parent patent had therefore been upheld. Accordingly, a divisional application could only have been validly filed until the day before the publication of the mention of the grant (March 16, 2021).

On June 2, 2022, the Examining Division issued a communication advising the applicant of the new publication date of the mention of the grant in respect of the earlier application, namely 15 June 2022. This communication noted that the original decision to grant dated 18 February 2021 maintained its effect and remained valid.

On July 15, 2022, the applicant requested a decision under Rule 112(2) EPC and made submissions in support of the

proposition that the later application had been validly filed as a divisional application.

In its interlocutory decision dated September 14, 2023, the Receiving Section ruled that the later application will not be treated as a divisional application of the earlier application and allowed a separate appeal against said decision.

On November 14, 2023, the appellant filed a notice of appeal and paid the appeal fee.

a. The arguments of the appealed decision of the Receiving Section

The Receiving Section argued that the principles of decision J 28/03 were applicable to the present case. In J 28/03, the Legal Board of Appeal drew a distinction between appeals against refusals of a European patent application and appeals against decisions to grant a European patent. As regards the former, there was a “*guarantee*” that a divisional application can survive even where the appeal was refused for whatever reason (Reasons 15). The latter was different, as a patent had already been granted, with the consequence that every further action was completely dependent on the outcome of the appeal proceedings (Reasons 16).

Moreover, the suspensive effect of an appeal did not allow to ignore the existence of an already taken decision. It only interrupted the normally following further steps until the definite decision of the last instance has been taken (Reasons 18).

b. The appeal against the decision of the Receiving Section

In the statement of grounds of appeal filed on January 15, 2024, the appellant argued that the principles established in J 28/03 were not applicable to the present case, and they were not convergent with the later decision G 01/09. In the present case, the original date of the mention of the grant had been deleted, and the parent application remained therefore pending. The situation in J 28/03 was different, as there was no deletion of the mention of the grant for the parent application. Therefore, the principles of this decision should not be applied to the present case, rather the principles set out in G 01/09 were applicable.

By letter dated July 15, 2022, the appellant argued that other divisional applications were filed under the same circumstances as the present and were allowed by the EPO so that the appellant had legitimate expectations that in the present case the divisional application could also be validly filed.

The applicant requested that the decision under appeal be set aside and that the later application be processed as a European divisional application. In the event that this request was rejected, oral proceedings were requested.

2. The Appeal Proceedings (J 01/24) and the Reasons for the Decision

The Legal Board of Appeal considered that the appeal (against the decision of the Receiving section) is admissible, in particular as a separate appeal has been allowed in the decision under appeal pursuant to Article 106(2) EPC.

When is an application pending?

The Legal Board of Appeal assessed the question when an earlier application is “*pending*”, as required as prerequisite in Rule 36(1) EPC for filing a divisional application.

The EPC does not contain a definition thereof, so that the Legal Board of Appeal referred to the principle laid down in the decision G 01/09 of the Enlarged Board of Appeal: A “*pending (earlier) European patent application*” is a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence (G 01/09, Reasons 3.2.4.). The substantive rights include provisional protection under Article 67 EPC.

The Legal Board of Appeal moreover emphasized that the retroactive effect of a final decision to refuse an application on the rights conferred upon the applicant does not influence the pending status of the application *before* such a decision is final.

Based on the fact that in the present case (unlike in the case underlying J 28/03) the deletion of the date of the mention of the grant prevented the grant of the patent from becoming effective, the Legal Board of Appeal thus concluded that substantive rights (e.g. provisional protection) still derive from the earlier patent application which was therefore still pending.

The Legal Board of Appeal insofar did not follow the position of the board in J 28/03 that “*an appeal against a decision granting a patent and resulting in the publication of the grant of the patent would be expected to be inadmissible with respect to Article 107(1) EPC and should therefore not*

benefit of the possibility to file a divisional application even during the appeal procedure. This can also be understood as to avoid abusive appeals to construe artificially pending 'parent applications'.

According to J 01/24, it is the current practice of the EPO that appeals against the grant of a patent are treated as appeals validly filed, with the consequence that the date of the mention of the grant is deleted. If the appeal is later withdrawn or turns out to fail, there will be a new date of publication of the mention of the grant.

J 01/24 considers that this is a requirement for the effectiveness of the grant of a patent (Article 64(1) EPC).

Decision J 01/24 moreover emphasizes that the EPC has no provision restricting appeals of the applicant against the grant of a patent and that *“such an appeal cannot therefore be seen as clearly inadmissible”*.

Such an appeal is in contrast to a *“clearly inadmissible”* appeal that should have no suspensive effect, such as an appeal without basis in the EPC, e.g. an appeal filed by a third party (cf. Reasons 10.5).

A *“pending application”* in particular does not require *“pending grant proceedings”*, cf. also G 01/09, Reasons 4.2.5. This is also in line with the principle that in case of a stay of the proceedings pursuant to Rule 14(1) EPC there are no pending grant proceedings even though the application is still pending.

Order

Consequently, the Legal Board of Appeal ordered that the decision under appeal be set aside and that the case be remitted to the Receiving Section for further prosecution with the order to treat the later application as a divisional application of the earlier application.

3. Remarks

The landmark decision G 01/09 already provided clarity for applicants in that a divisional application may be filed as long as the decision to refuse the application has not become final, i.e. within the time limit for filing an appeal.

The present decision J 01/24 now provides clarity for the different case where the mention of the grant of an application has been published and the applicant thereafter files an appeal against the decision to grant within the time limit for filing an appeal. In such a case, a divisional application can still be filed as, according to the common practice

of the EPO, the mention of the grant is deleted, and the application is consequently still pending.

The decision does not change the fact that the vast majority of such appeals will fail, as the decision to grant is (usually) fully in line with the intention to grant to which the applicant agreed. In contrast to the proceedings for example before the German Patent and Trademark Office, this applies even if the grant is based on an auxiliary request, as the applicant necessarily withdraws the higher ranked requests when agreeing to the intention to grant based on an auxiliary request.

However, the decision J 01/24 distinguishes between “*not clearly inadmissible*” appeals (filed by the applicant) and “*clearly inadmissible*” appeals (for instance, an appeal filed by a third party). From a practical point of view, this seems to be reasonable, as an appeal of the applicant against the decision to grant might in principle also be admissible according to the standard applied in J 28/03 – even though this should only apply in rare cases.

As a justification of the current practice of the EPO to treat appeals against the grant of a patent as validly filed, J 01/24 points out that it is inconsistent to consider an appeal in two different ways: first for the mention of the grant to be deleted, the appeal only needs to be admissible; and second whether the suspensive effect applies is dependent on the outcome of the appeal. If this inconsistent approach were to be adopted, the situation would be uncertain and unclear especially for third parties, that could not know whether a patent application is

still pending, as this would depend on the outcome of the appeal proceedings. J 01/24 insofar also refers to the requirement for the effectiveness of the grant of a patent (Article 64(1) EPC) (Reasons 10.5).

It certainly remains best practice to file divisional applications before the publication of the mention of the grant to avoid all the above issues. Opening the door to filing a divisional by filing an appeal against the decision to grant should only be used as a backup, which may prove extremely valuable in case the timely filing of the divisional was overlooked. Oblivious applicants should however keep their fingers crossed that the EPO does not change the current practice of treating appeals of the applicant against the grant of a patent as validly filed, with the consequence that the mention of the grant is deleted.