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**Datasheet for the decision  
of 13 May 2014**

**Case Number:** J 0010/12 - 3.1.01

**Application Number:** XXXXXXXXX.X

**Publication Number:** -

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**Language of the proceedings:** EN

**Title of invention:**  
...

**Applicant:**  
N.N.

**Headword:**  
Pendency of earlier patent application

**Relevant legal provisions:**  
EPC Art. 76(1)  
EPC R. 36(1)  
RPBA Art. 12(4), 13(1)

**Keyword:**  
Pending earlier application - time limit open to re-  
establishment of rights or further processing (no)

**Decisions cited:**  
G 0001/09, J 0002/01, J 0018/04, J 0020/05

**Catchword:**  
-



**Juristische Beschwerdekammer**  
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Case Number: J 0010/12 - 3.1.01

**D E C I S I O N**  
**of Legal Board of Appeal 3.1.01**  
**of 13 May 2014**

**Appellant:** N.N.  
(Applicant)

**Representative:** N.N.

**Decision under appeal:** Decision of the Receiving Section of the European Patent Office posted on 13 December 2011.

**Composition of the Board:**

**Chairman** L. Bühler  
**Members:** F. Blumer  
E. Kossonakou

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the Receiving Section of 13 December 2011 rejecting as inadmissible the request for re-establishment of rights and the auxiliary request for further processing in respect of European patent application No. XXXXXXXX.X, and refusing to treat said application as a divisional application of earlier application No. YYYYYYYY.Y (hereinafter the "earlier application").
- II. On 30 October 2008, following examination of the earlier application, the examining division issued a decision pursuant to Article 97(1) EPC to grant European patent No. 0 000 000. The applicant was informed that the mention of grant would be published in European Patent Bulletin 00/00 of .....
- III. On 23 January 2009, the applicant filed a request pursuant to Article 122(3) EPC to be re-established in its right to file a divisional application, and completed the omitted act by filing European patent application No. XXXXXXXX.X. As an auxiliary request the appellant requested further processing pursuant to Article 121 EPC.
- IV. In a first communication pursuant to Article 113 EPC sent on 1 December 2009, the Receiving Section expressed its preliminary opinion that the request for re-establishment of rights was not admissible, since the right to file a divisional application could not be re-established. The Receiving Section cited case law of the Legal Board of Appeal establishing that there was no time limit for filing a divisional application. As to the request for further processing, the Receiving Section informed the applicant that it intended to

treat the application as not having been filed and that the request for further processing was thus to be considered as having been filed without legal grounds. The appellant was given the opportunity to file comments.

V. In its reply of 11 February 2010, the appellant pointed to decision J 2/08 which had in the meantime referred to the Enlarged Board of Appeal a point of law with respect to the interpretation of Rule 25(1) EPC 1973 and Rule 36(1) EPC. The appellant argued that the board in J 2/08 had favoured the German practice allowing a divisional application to be filed up to the expiry of the period for filing an appeal, and that therefore the expiry of the time limit for filing an appeal was decisive for the possibility of filing a divisional application. Accordingly, this period had to be regarded as a time limit within the meaning of Article 122 EPC. The appellant further pointed to Rule 36(1) EPC as applicable from 1 April 2010 and to the notice dated 20 August 2009 indicating that re-establishment was an available remedy in case of non-observance of the time limits set in amended Rule 36 EPC (OJ EPO 2009, 481, page 485, point III). The appellant suggested that its request of 23 January 2009 should be interpreted as a request for re-establishment in respect of the time limit pursuant to Article 108 EPC (p. 5, section B.3).

VI. A second communication pursuant to Article 113 EPC was issued on 25 June 2010. The Receiving Section maintained its previous opinion and stated that the outcome in the referral G 1/09 did not affect the case under consideration, since decision J 2/08 dealt with the filing of a divisional application after refusal of the earlier application and did not concern the filing

of a divisional application after the grant of a patent for the earlier application. The Receiving Section moreover refused to construe the request of 23 January 2009 as a request for re-establishment in respect of the time limit pursuant to Article 108 EPC, since this would amount to a request for correction pursuant to Rule 139 EPC. It pointed out that such a request would fail, since neither the mistake nor the correction was self-evident. Moreover, even assuming that such an interpretation was possible, a request for re-establishment into the time limit pursuant to Article 108 EPC would fail, since the omitted acts, i.e. the filing of a notice of appeal, the filing of grounds of appeal and the payment of the appeal fee, had not been completed. As regards amended Rule 36 EPC, the Receiving Section pointed to the President's comments submitted in the then pending referral G 1/09 stating that the time limits introduced in said rule did not touch on the requirement of pendency which was to be considered as an independent procedural condition and not as a period for filing a divisional application.

VII. In its reply of 3 September 2010, the appellant argued that the outcome of the referral G 1/09 was relevant, since the Enlarged Board of Appeal, in its answer, was not restricted to the precise wording of the point of law referred to it. The appellant further disagreed with the Receiving Section's view that it had submitted a request for correction of its initial request for re-establishment. Rather, the appellant had argued that the possible change of law by way of interpretation of Rule 36 EPC suggested by J 2/08 should also be taken into account. If the approach favoured in decision J 2/08 was accepted, the time limit for filing a divisional application would be determined by the time

limit for filing an appeal. The filing of an appeal was however not required. The change in the appellant's assessment of a point of law was permissible. Which time limit was to be applied under Rule 36 EPC had in any case to be decided *ex officio* according to the maxim "*iura novit curia*". Regarding the President's comments pertaining to the referral G 1/09, the appellant argued that this opinion would only become relevant if it was followed by the Enlarged Board of Appeal.

- VIII. A third communication pursuant to Article 113 EPC was issued on 16 May 2011. The Receiving Section referred to the finding in point 4.3.3 of the Reasons for decision G 1/09 that, if a decision to grant had been issued, the deadline for filing a divisional application was the day before the date of publication of the mention of the grant in the European Patent Bulletin. The Receiving Section maintained its arguments in the previous communications and announced its intention to issue a negative decision.
- IX. In its reply of 22 July 2011, the appellant contended that G 1/09 had to be understood as acknowledging that there was a time limit for filing a divisional application and that it expired the day before the date of publication of the mention of the grant for the earlier application. Moreover, from the time when amended Rule 36 EPC had entered into force, such a time limit had been expressly enacted. The appellant therefore concluded that the request for re-establishment was admissible.
- X. On 13 December 2011, the Receiving Section rejected the request for re-establishment and the auxiliary request for further processing as inadmissible.

- XI. The appellant lodged an appeal against this decision and filed counter-arguments.
- XII. In a communication dated 17 February 2014 sent as an annex to the summons to oral proceedings, the board raised objections as to the admissibility of the main and the second auxiliary requests. The board was of the opinion that the appellant's arguments did not support the main request and even contradicted its own previous submissions. With respect to auxiliary request 2, the board considered the appellant's arguments to be an unallowable *venire contra factum proprium*. Regarding the first auxiliary request, the board disagreed with the appellant's interpretation of decision G 1/09 (OJ EPO 2011, 336) that the reference to a "deadline" in point 4.3.3 of its reasons implied that the Enlarged Board of Appeal had acknowledged that the requirement of a pending earlier application pursuant to Rule 25 EPC 1973 (Rule 36(1) EPC) was to be regarded as a time limit within the meaning of Article 122 EPC. Furthermore, the board regarded the appellant's objections as to the distinction between a condition and a time limit as not persuasive in the light of the analysis of the concept of a time limit in the jurisprudence of the Legal Board of Appeal. The board therefore informed the appellant of its preliminary opinion that neither further processing (Article 121 EPC) nor re-establishment of rights (Article 122 EPC) was available if the filing of a divisional application did not comply with the substantive requirement of a "pending earlier European patent application" pursuant to Rule 36(1) EPC.
- XIII. Oral proceedings were held before the board on 13 May 2014. During the oral proceedings, the appellant

requested that the following question be referred to the Enlarged Board of Appeal:

"In the Decision G 0001/09 the Board holds that further to a decision to grant there is a "deadline" for filing a divisional application one day before the mention of the grant.

Is this "deadline" to be understood in the same way as a time limit as the "time limit" of 24 months under Rule 36 EPC for filing a divisional application?

Otherwise, a request for restoration would be readily admissible for the 24 month period under Rule 36 EPC, but not admissible within a shortened period if the date of mention of grant is earlier than the end of the 24 month period."

XIV. The appellant's arguments, insofar as they are relevant to the present decision, may be summarised as follows:

- a) The Enlarged Board of Appeal, in its decision G 1/09, point 4.3.3 of the Reasons, used the term "deadline". According to the ordinary meaning of this word, a "deadline" is either a time limit or the end of this time limit. This understanding was also consistent with the case law of the boards of appeal in which this term was used. The finding of the contested decision, that the requirement of a "pending earlier European patent application" in Rule 36(1) EPC did not stipulate a time limit for filing a divisional application was not correct. The board's preliminary opinion that the term "deadline" was broader than the terms "time limit" and "period" did not negate the appellant's



understanding of point 4.3.3 of the Reasons of decision G 1/09.

- b) The distinction made in earlier case law between the "end of a time limit for performing a procedural act" and a "period of time, the end of which is determined by a condition" was artificial and had the consequence that comparable situations were treated differently without good reason. This was exemplified by amended Rule 36(1)(a) EPC as in force since April 2010 (see decisions of the Administrative Council of 25 March 2009, OJ EPO 2009, 296, and of 26 October 2010, OJ EPO 2010, 568) which expressly provided for a time limit. Re-establishment of rights had to be available irrespective of which of the alternative "deadlines" (end of pendency of the earlier application or end of the 24-month time limit) was missed, since the same precautions had to be taken in order not to miss any of these "deadlines".
  
- c) Re-establishment was intended as an all-encompassing safety net for applicants who failed to complete an act in a timely fashion and lost an application as a result. The distinction between the "end of a time limit for performing a procedural act" and a "period of time, the end of which is determined by a condition" was therefore artificial.

XV. The appellant requested that the decision under appeal be set aside and that patent application No. XXXXXXXX.X be accorded the filing date of earlier application No. YYYYYYYY.Y (main request).

In the alternative, as a first auxiliary request, the appellant requested that the decision under appeal be set aside, the request for re-establishment of rights in regard to the filing of a divisional application allowed, and patent application No. XXXXXXXX.X accorded the filing date of earlier application No. YYYYYYYY.Y.

As a second auxiliary request, the appellant requested that the decision under appeal be set aside, that the request for re-establishment of rights in regard to the filing of an appeal against the decision to grant the earlier application be admitted, and that the case be remitted to the department of first instance for further prosecution.

The appellant further requested that a point of law be referred to the Enlarged Board of Appeal.

## **Reasons for the Decision**

*Main request: admission into the appeal proceedings*

1. The appellant's main request, which was filed for the first time on appeal, amounts to asserting that the earlier application was still pending on the date of filing of patent application No. XXXXXXXX.X. In support of this request, the appellant essentially argued that the earlier application had to be regarded as pending within the meaning of Rule 36(1) EPC after the mention of the grant of a patent for that application until the (later) date of expiry of the time limit for filing an appeal, even if no appeal was actually filed.
2. In its communication sent as an annex to the summons, the board however indicated that it was not minded to admit the main request into the appeal proceedings. The

board objected that the appellant's arguments did not support the main request and even contradicted its own previous submissions. Even if the board were to accept the appellant's assertions, the pending status of the earlier application would have ended in the present case on 9 January 2009 (Article 108 EPC together with Rules 126(2) and 131(4) EPC; the time limit being computed by reference to the dispatch of the decision to grant on 30 October 2008, see point II above), i.e. before the filing on 23 January 2009 of European patent application No. XXXXXXXX.X as a purported divisional application. This result was also conceded by the appellant in its letter of 11 February 2010 (p.5, section B.1).

3. The appellant did not contest the board's preliminary assessment nor did it submit any reasons for not having filed said request with the Receiving Section.
4. For these reasons, the board decided to exercise its discretion pursuant to Article 12(4) of the Rules of Procedure of the Boards of Appeal (RPBA) to hold inadmissible the main request.

*Auxiliary request 1: availability of re-establishment of rights*

5. The appellant argued that re-establishment of rights was a remedy available in case of loss of the right to file a divisional application in respect of the earlier application. The appellant contested the finding in the decision under appeal that the principle of Rule 36(1) EPC (as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006, Special edition No. 1, OJ EPO 2007, 89), according to which a divisional application may be

filed "relating to any pending earlier European patent application", did not impose a time limit in the meaning of Article 122(1) EPC, but was a substantive condition.

6. It is established jurisprudence with regard to Article 76 and Rule 25 EPC 1973 that it is the entitlement acquired by virtue of the earlier application that gives an applicant the right to file a divisional application. This means that the rights derivable for the divisional application from the earlier application correspond to, but are also limited to, the rights existing in respect of the earlier application at the filing date of the divisional application. The entitlement to file a divisional application according to Article 76 and Rule 25 EPC 1973 is thus a procedural right that derives from the applicant's status as applicant under the earlier application (J 2/01, OJ EPO 2005, 88, points 5.1 and 6 of the Reasons; J 20/05 of 6 September 2007, point 2 of the Reasons with further references to the jurisprudence).
  
7. In line with this jurisprudence, the Legal Board of Appeal held that the requirement of a "pending earlier European patent application" in Rule 25(1) EPC 1973 did not establish a time limit within the meaning of Article 122 EPC 1973, but imposed a substantive requirement for the filing of a divisional application (J 18/04, OJ EPO 2006, 560 with further references to the jurisprudence). This jurisprudence has been confirmed by the Enlarged Board of Appeal in its decision G 1/09 (OJ EPO 2011, 336, point 3.2.4 of the Reasons, concurring with J 18/04, OJ EPO 2006, 560).

8. Rule 36(1) EPC as adopted by decision of the Administrative Council of the European Patent Organisation of 7 December 2006 (Special edition No. 1, OJ EPO 2007, 89) is still based on the principle that a divisional application may be filed "relating to any pending earlier European patent application". Therefore, the finding in decision G 1/09 that the requirement of a "pending earlier European patent application" imposes a substantive requirement for the filing of a divisional application applies to Rule 36(1) EPC.
9. The board sees no reason to deviate from the established jurisprudence as set out above and is not persuaded by the appellant's arguments.
10. The appellant argues that the Enlarged Board of Appeal, in point 4.3.3 of the Reasons for decision G 1/09 (OJ EPO 2011, 336), used the term "deadline" which refers to a time limit. According to the appellant, this terminology implies that the Enlarged Board acknowledged that the requirement of a pending earlier application pursuant to Rule 25 EPC 1973 (Rule 36(1) EPC) was to be regarded as a time limit within the meaning of Article 122 EPC.
  - 10.1 The board does not agree. First of all, the term "deadline" is broader than the terms "time limit" and "period" (for which the term "Frist" is used in the German text of the EPC). It encompasses any last date for validly performing an action and says nothing about the nature of the underlying time restriction. By contrast, the term "time limit", as a legal concept of the EPC procedural system, has a precise meaning (Rule 131 EPC). It is a period of time of defined duration which is computed by reference to a relevant event

(*dies a quo*). Thus, the last date up until which a procedural act can be validly performed ("deadline") is the result of this computation of the period of time specified in the legal provision establishing the time limit by reference to the *dies a quo* (see in detail J 18/04, OJ EPO 2006, 560, points 18 to 26 of the Reasons). For these reasons, "deadline" cannot be equated to "time limit".

10.2 It is moreover clear from the context that the Enlarged Board of Appeal did not use the term "deadline" in point 4.3.3 of the Reasons for decision G 1/09 in order to refer to a time limit. First, the Enlarged Board dealt with the question of until when a European patent application was pending within the meaning of Rule 25(1) EPC 1973, i.e. until when were substantive rights in existence which derived from the application if the application was refused. Points 4.3.1 and 4.3.2 dealt with the same question in the case of grant. The Enlarged Board then went on to address the issue raised by the President of the EPO of whether the filing of a divisional application would be allowed irrespective of an inadmissible appeal being filed with regard to the parent application. In its reply, the Enlarged Board referred to its previous answers. It used the term "deadline" in the sense of a last date for validly performing an action, that is the filing of a divisional application. This date was determined by the last date on which substantive rights deriving from the earlier patent application were still in existence.

10.3 Furthermore, the appellant's interpretation of G 1/09 would be difficult to reconcile with the decision's *ratio decidendi*. The Enlarged Board of Appeal held that a "pending earlier European patent application" in the specific context of Rule 25 EPC 1973 was a patent

application in a status in which substantive rights deriving therefrom under the EPC were (still) in existence. Article 67(4) EPC 1973 and Article 64(1) EPC 1973 determine the point in time at which substantive rights conferred by an earlier European patent application cease to exist and its pending status within the meaning of Rule 25 EPC 1973 ends (G 1/09, OJ EPO 2011, 336, points 4.2.3 and 4.3.3 of the Reasons). The Enlarged Board of Appeal thus considered the filing of an application under Rule 25 EPC 1973 to be conditional upon the existence of substantive rights under the earlier application and not dependent on the lapse of a period of time of defined duration which was computed by reference to a relevant event (*dies a quo*).

- 10.4 The board is therefore of the opinion that point 4.3.3 of the Reasons for decision G 1/09 (OJ EPO 2011, 336) cannot be understood to mean that the Enlarged Board of Appeal considered the requirement "pending earlier European patent application" in the specific context of Rule 25 EPC 1973 to be a time limit and not a condition, but rather is consistent with point 3.2.4 of the Reasons.
  
11. The appellant referred to Rule 36(1) (a) and (b) EPC which entered into force on 1 April 2010 (see decisions of the Administrative Council of 25 March 2009, OJ EPO 2009, 296, and of 26 October 2010, OJ EPO 2010, 568; letters (a) and (b) of Rule 36(1) EPC were abrogated by decision of the Administrative Council of 16 October 2013, OJ EPO 2013, 501). The appellant argued that these provisions expressly provided for a time limit for filing a divisional application. It further contended that re-establishment of rights was available with respect to said time limits pursuant to Rule 136(3) EPC, since further processing was expressly

excluded in Rule 135(2) EPC as in force with effect from 1 April 2010. Applicants had to take the same precautionary measures in order to ensure compliance with either the requirement of pendency of the earlier application or any of the time limits of Rule 36(1) (a) and (b) EPC. Therefore, re-establishment of rights had to be available irrespective of which of the alternative "deadlines" (end of pendency of the earlier application or end of the 24-month time limit) had been missed.

- 11.1 The board notes that the appellant did not dispute that Rule 36(1) (a) and (b) EPC which entered into force on 1 April 2010 does not apply to the present case. Indeed, Rule 36(1) EPC as amended by decisions of the Administrative Council of 25 March 2009 (OJ EPO 2009, 296) and of 26 October 2010 (OJ EPO 2010, 568) applies to divisional applications filed on or after 1 April 2010 or 26 October 2010 (see Article 2 of the said decisions). Consequently, the appellant cannot rely on the new law as being applicable to the present case.
- 11.2 But even taking the reference to Rule 36(1) (a) and (b) EPC as supporting the appellant's objection that there is no meaningful distinction between a condition and a time limit, the board is not persuaded. Considering that Rule 36(1) (a) and (b) EPC sets certain procedural time limits for filing divisional applications during the examination procedure, such situation does not vitiate the findings in the jurisprudence that the entitlement to file a divisional application according to Article 76 and Rule 36 EPC is a procedural right that derives from the applicant's status as applicant in respect of the earlier application, and that the requirement of a "pending earlier European patent



application" in Rule 36 EPC imposes a substantive requirement for the filing of a divisional application. Contrary to the appellant's allegation, the coexistence of a (substantive) condition and (procedural) time limits which impose different time restrictions is neither inconsistent nor unacceptable. The Enlarged Board of Appeal was conscious of such a situation and stated that "... the pending status of an earlier European patent application does not mean that a divisional application relating to it can always be filed. This may be excluded by procedural provisions, ..." (G 1/09, OJ EPO 2011, 336, point 3.2.5 of the Reasons). As the appellant itself concedes, procedural time limits are superseded by an earlier termination of the pendency status of the earlier application. Conversely, the filing of a divisional application relating to a pending earlier application may be excluded due to the expiry of one of the time limits in Rule 36(1) (a) and (b) EPC. The board therefore does not see any discrepancy in the coexistence of a (substantive) condition and (procedural) time limits.

- 11.3 In the light of the analysis of the concept of a time limit in decision J 18/04, the appellant's further objections asserting that there is no viable distinction between a condition and a time limit likewise fail to persuade the board. The fact that the substantive requirement of a "pending earlier European patent application" can only be fulfilled within a certain time frame - and for this reason an applicant needs to proceed as if it were dealing with a proper procedural time limit - does not create a time limit under Rule 36(1) EPC which has to be met by the applicant (see J 18/04, point 7 of the Reasons).

12. Lastly, the appellant contends that re-establishment of rights was intended as an all-encompassing safety net for applicants who failed to complete an act in a timely fashion and lost their application as a result, and that the term "time limit" was not to be viewed in a restrictive manner, but covered all acts for which a time restriction applied.

12.1 The appellant's allegation is on both counts clearly unfounded and not supported by specific references to the *travaux préparatoires* to the EPC 1973 or EPC 2000. The board notes that the legislator had expressed its view that Article 121 EPC 1973 should be given a narrow interpretation (see the minutes of the Munich diplomatic conference for setting up a European system for the grant of patents, MR/PR/I, p. 57, no. 583). In 2000, the legislator extended the scope of application of further processing whilst at the same time restricting that of re-establishment of rights (see the basic proposal for the revision of the European Patent Convention of 13 October 2000, MR/2/00, p. 157, no. 1, p. 163, no. 6).

Also, the legislator maintained non-compliance with a time limit as an explicit requirement for both re-establishment of rights and further processing. There is no support in the *travaux préparatoires* for applying re-establishment of rights or further processing to any time restriction, irrespective of whether it is a time limit in accordance with the legal concept of the EPC procedural system.

12.2 The requirement of a "pending earlier European patent application" in Rule 36(1) EPC reflects considerations which take into account legal effects on material rights of the applicant, and the material interests of

third parties. If the legislator had intended to find a different balance between legal certainty and substantive justice when it considered the possibility of further processing or re-establishment of rights with respect to the filing of divisional applications, it could and indeed would have substituted a time restriction complying with the legal concept of "time limit" for the substantive condition of Rule 36(1) EPC.

13. Since both further processing (Article 121 EPC) and re-establishment of rights (Article 122 EPC) require that a time limit has been missed, these remedies are not available where the filing of a divisional application does not comply with the substantive requirement of a "pending earlier European patent application" pursuant to Rule 36(1) EPC. There is thus no need for the board to consider the further requirements of these remedies and to determine the appropriate one. The appellant's request for re-establishment of rights in regard to the filing of a divisional application is not admissible. As a consequence, the appellant's first auxiliary request is not allowable.

*Auxiliary request 2*

14. With respect to auxiliary request 2, the appellant's arguments lack consistency and even contradict the facts of the case: by letter of 11 February 2010, the appellant suggested that its request of 23 January 2009 should be interpreted as a request for re-establishment in respect of the time limit pursuant to Article 108 EPC (p. 5, section B.3; see point V above). In a communication posted on 25 June 2010, the Receiving Section held that the request for re-establishment of rights of 23 January 2009 was clear and unambiguous. It could not be reinterpreted the way the appellant had

requested (see point VI above). By letter of 3 September 2010 (p. 4 et seq., section B), the appellant disputed that it had requested that its initial request for re-establishment in regard to the filing of a divisional application be considered as a request for re-establishment in respect of the time limit for filing an appeal against the decision to grant the earlier application (see point VII above). Contrary to the appellant's allegation in its statement setting out the grounds of the appeal (p. 10, section IV.1), with its letter of 22 July 2011 the appellant did not revert to requesting re-establishment of rights in respect of the time limit for filing an appeal. As a consequence, the Receiving Section did not take a decision on this issue. On appeal, however, the appellant requests remittal on the basis of such a request and argues that the first instance has not dealt with this request (see statement setting out the grounds of the appeal of 20 April 2012, p. 10, section IV.1).

15. It is not the purpose of appeal proceedings to allow the appellant to conduct its case anew. Their main function is to give a judicial decision upon the correctness of a decision taken by a first-instance department. The issues to be dealt with on appeal are thus primarily determined by the dispute underlying the first-instance proceedings, the relevant issues of which have to be reflected in the reasoned decision rendered by that instance.
  
16. It follows from point 14 above that the appellant made a conscious choice not to present a request corresponding to auxiliary request 2 to the department of first instance. The appellant thereby deliberately limited the issues in dispute before the Receiving

Section. The appellant's submission of auxiliary request 2 for the first time in appeal was therefore clearly inconsistent with its previous conduct and in breach of the generally recognised prohibition against *venire contra factum proprium* and thus of the principle of good faith. For this reason, auxiliary request 2 was held inadmissible (Article 12(4) RPBA).

*Referral to the Enlarged Board of Appeal: admission into the appeal proceedings*

17. During the oral proceedings, the appellant formulated a question for referral to the Enlarged Board of Appeal (set out in point XIII above). It argued that this request should be admitted into the appeal proceedings, since it had realised only at that late stage of the proceedings that the board did not concur with the appellant's understanding of the term "deadline" used in point 4.3.3 of the Reasons of decision G 1/09 (OJ EPO 2011, 336). The appellant had not been aware of any decision on this question. Moreover, the distinction between condition and time limit led to a manifestly unreasonable result when applied to Rule 36(1) EPC.
  
18. The board cannot accept that its disagreement on the point of law became apparent only at the oral proceedings. In the communication accompanying the summons, the board had dealt with this issue in points 4 to 12, especially points 9 and 10, and had given a negative opinion. Moreover, this issue had already been under consideration in the proceedings before the Receiving Section (see the appellant's letter of 22 July 2011, section 2.2). The appellant had thus had ample time and opportunity to request a referral earlier in the appeal proceedings. Instead, it

presented this request only at the oral proceedings after the board had given a negative opinion with respect to the first auxiliary request.

19. For these reasons, the board did not admit the appellant's request for a point of law to be referred to the Enlarged Board of Appeal into the appeal proceedings.
20. Since none of the appellant's requests is allowable, the appeal must be dismissed.

## Order

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

The appeal is dismissed.

The Registrar:

The Chairman



C. Eickhoff

L. Bühler

Decision electronically authenticated