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**Datasheet for the decision
of 29 November 2019**

Case Number: J 0008/19 - 3.1.01

Application Number: XXXXXXXXX.X

Publication Number:

IPC:

Language of the proceedings: EN

Title of invention:

N.N.

Applicant:

N.N.

Headword:

Relevant legal provisions:

EPC Art. 64(1), 67(1), 67(4), 76(1) sentence 1, 97(3), 108
sentence 1, 108 sentence 2

EPC R. 36(1), 139 sentence 1

RFees Art. 5(2), 7(2)

Arrangements for deposit accounts 5.4.1

Keyword:

Correction of error - form for payment of appeal fee (yes)
Divisional application - pending earlier European patent
application (no)

Decisions cited:

G 0001/09, G 0001/12, G 0001/18, J 0010/87, J 0027/96,
J 0003/01, J 0025/01, J 0006/02, J 0025/03, J 0007/04,
J 0016/08, J 0024/10, J 0020/12, J 0006/13, J 0009/14,
T 0445/08

Catchword:



Juristische Beschwerdekammer
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Case Number: J 0008/19 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 29 November 2019

Appellant: N.N.
(Applicant)

Representative: N.N.

Decision under appeal: Decision of the Receiving Section of the European Patent Office posted on 5 April 2019 stating that European patent application No. XXXXXXXXX.X was not to be treated as a European divisional application.

Composition of the Board:

Chairman W. Sekretaruk
Members: G. Decker
R. Romandini

Summary of Facts and Submissions

- I. The appeal lies against the decision of the Receiving Section posted on 5 April 2019 stating that European patent application No. XX XXX XXX.X was not to be treated as a European divisional application since the requirements for filing a divisional application had not been fulfilled, and that all fees paid for this application were to be refunded.
- II. The appellant filed European patent application No. XX XXX XXX.X as a divisional application from the earlier European patent application No. YY YYY YYY.Y at 13.37 hrs on 25 April 2018.
- III. The mention of the grant of the patent stemming from the earlier application was published in European Patent Bulletin XX/XX at 14.00 hrs on the same day.
- IV. The reasons for the decision under appeal may be summarised as follows:
 - (a) Following G 1/09, Reasons 3.2.4, a European patent application is "pending" under Rule 36 EPC if it is in a status in which substantive rights deriving from it under the EPC are in existence.
 - (b) Following the *obiter dictum* in G 1/09, Reasons 4.3.2, the pending status of a European patent application normally ceases on the day before the mention of its grant is published, because from that point in time substantive rights under the EPC are no longer derived from the application, but rather from the granted patent.

(c) There is no contradiction between the consequences of the retroactive effect of a decision to reject becoming final, as held by the Enlarged Board of Appeal in G 1/09, and of publishing the mention of the grant. Rather, these cases are treated differently due to differing circumstances. When an application is rejected, its status is unclear until the rejection becomes final. In the vast majority of grant cases, there is no doubt about the underlying status of the application.

(d) In the present case, the application was filed on the same day on which the mention of the grant of the earlier patent application took place, the latter therefore no longer being pending on that day. Consequently, the requirements for filing a divisional application under Article 76 EPC were not met.

V. On 17 June 2019, the appellant filed a notice of appeal which was accompanied by a completed Form 1038E for payment of the appeal fee. In the form the appellant had indicated the correct appeal fee ("*011 Appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC*") in the "Fees" box. The box for the "Amount to be paid", however, showed only EUR 1 860, rather than the correct amount of EUR 2 255. Consequently, only the former amount was debited within the time limit under Article 108, first sentence, EPC. The balance on the appellant's deposit account on this date was well above the amount of the appeal fee.

VI. In a communication dated 23 July 2019, the board notified the appellant pursuant to Rule 112(1) EPC that the appeal fee had not been paid in full within the

applicable time limit and that the appeal would therefore be considered not to have been filed.

- VII. On 7 August 2019, the appellant paid the outstanding part of the appeal fee. At the same time, it requested that the submitted Form 1038E containing the incorrect debit amount be corrected under Rule 139, first sentence, EPC.
- VIII. The statement setting out the grounds of appeal was filed on 8 August 2019.
- IX. Oral proceedings were held before the board on 29 November 2019. The appellant's final requests were:
- that the debit order in Form 1038E of the amount of "EUR 1 860" in the "Fees" box be corrected under Rule 139 EPC to the amount of "EUR 2 255";
 - that the impugned decision be set aside such that European patent application No. XX XXX XXX.X be treated as a European divisional application; and, should the board be minded to dismiss the appeal,
 - that the following question be referred to the Enlarged Board of Appeal: *"Where the precise time of publication of the mention of the grant of the patent resulting from a European patent application can be established, must the European patent application still be considered to be pending in the sense of Rule 36(1) EPC on the date of said publication until the moment that said publication has actually taken place?"*.

- X. The appellant's arguments where relevant to the present decision may be summarised as follows:

Request for correction under Rule 139 EPC

- (a) Rule 139, first sentence, EPC applied to mistakes in any document filed with the EPO and hence also to mistakes in Form 1038E.
- (b) The appellant's intention to pay the requisite fee was abundantly clear from that form, in which it had explicitly ordered the debiting of the fee "*for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC*". This was the correct and unique designation of the appeal fee in the amount of EUR 2 255 as introduced on 1 April 2018. The amount originally indicated was clearly inconsistent with the selected fee item and could thus only be the result of a mistake.
- (c) The mistake originated in the use by the professional representative's paralegal of an earlier notice of appeal as a template for the generation of the draft online filing submission. While the graphical user interface (GUI) of the EPO online filing software explicitly indicated that the fee schedule valid on 1 April 2018 was in use and while the GUI presented the correct fee item, the software did not update the corresponding amount, which was normally done automatically. This occurred because the option "Edit fee amounts" had been selected in the template, and this had disabled the automatic updating.
- (d) The case law stating that a possible retroactive effect of a correction under Rule 139, first

sentence, EPC could not re-open a procedural phase already terminated or a time limit already expired related to fact patterns which differed from those in the present case. In this context, point 5.4.1 of the current Arrangement for deposit accounts (ADA) also had to be considered. According to this provision, the payment date for a payment made by debit order was the date of receipt of the debit order. Moreover, the above case law pre-dated the Enlarged Board's decision in G 1/12, which explicitly established the general applicability of corrections under Rule 139, first sentence, EPC.

- (e) As the requested correction, if granted, had retroactive effect following the Enlarged Board's decision in G 1/12, the corrected payment led to the appeal being deemed to have been filed.

Period of pendency of an earlier patent application under Rule 36 EPC

- (a) There was no support for the Receiving Section's narrow interpretation of the notion of "substantive rights" as only consisting of rights under Article 67 EPC. There were further substantive rights deriving from an application, such as the right to have it published under Article 93 EPC, the right to have the mention of its grant published under Article 97(3) EPC and the right to have the specification of the European patent published under Article 98 EPC. Hence, at least some substantive rights continued to exist until the very moment at which the mention of the grant and the specification of the European patent were published.

- (b) The drafters of the EPC did not envisage the possibility of being able to determine the chronology of the relevant events with the required certainty and precision, as is the case now with the online publication of the mention of the grant of patents. There was nothing in EPC law that would prevent the EPO from attaching legal consequences to the chronology of events taking place on the same date.
- (c) Even if it were the case that the substantive rights deriving from an application ceased the day before the publication of the mention of the grant, they would do so due to a retroactive effect of said publication, since it did not happen precisely at midnight but rather at some point later in the day. The Receiving Section had failed to correctly take into account this retroactive effect by refusing to recognise the analogy with the retroactive effect of the final refusal of an application. There was no legal or logical reason to treat these retroactive effects differently, as far as their effects on the pendency of the patent application were concerned. The distinction between these cases as alleged by the Receiving Section - namely, that there was no doubt about the underlying status of the application - was based on an incorrect assumption. There was always some uncertainty about the factual occurrence of the publication on the announced date, which could be delayed, for example, due to unforeseen technical problems. There was also some degree of legal uncertainty, as it remained possible that a decision to grant that had already been issued would be subsequently set aside, rendering it - and any publication resulting from it - null and void.

(d) The Receiving Section had incorrectly relied on a part of decision G 1/09 which, being a mere *obiter dictum*, was not legally binding and which was in any case too vague to constitute a legal rule. The statement in point 4.3.2 of that decision was not sufficiently reasoned to serve as a precedential rule that could be applied to other cases. Moreover, by admitting that an application's pending status "normally" ceased on the day before the publication of the mention of the grant, the Enlarged Board implicitly acknowledged that in certain circumstances, which it did not specify, said pending status did not cease on the day before the publication of the mention of the grant.

Reasons for the Decision

1. The appellant filed a notice of appeal on 17 June 2019, within the two-month time limit prescribed in Article 108, first sentence, EPC, which ended on that same day (Rules 126(2), 131(2) and (4), 134(1), first sentence, EPC). However, due to the insufficient amount in the "Amount to be paid" box on Form 1038E, the prescribed appeal fee was not fully paid before expiry of that time limit. Following the Opinion G 1/18 of the Enlarged Board of Appeal, Conclusion 1(a) (not yet published in the OJ EPO), this results in the appeal being deemed not to have been filed.
2. *Request for correction (Rule 139, first sentence, EPC)*
 - 2.1 To change the above result, the appellant filed a request for correction under Rule 139, first sentence, EPC and claimed that the retroactive effect of an

allowable correction led to the appeal being deemed to have been filed.

2.2 Under Rule 139, first sentence, EPC linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request.

2.3 General applicability of Rule 139, first sentence, EPC

2.3.1 In the context of requests for correction of the designation of states, the boards of appeal denied in several decisions that Rule 139 EPC (Rule 88 EPC 1973) could be applied generally, as this would circumvent the requirements for re-establishment of rights under Article 122 EPC 1973. It was stated that the correction of a mistake was an isolated procedural measure and not a case of re-establishment into a defined procedural phase as a whole (see J 27/96, Reasons 3.2). A procedural loss of rights only indirectly caused by an incorrect document would not be remedied by a later correction of the document pursuant to Rule 139, first sentence, EPC. This principle also characterised the functional and essential difference between a correction under Rule 88, first sentence, EPC 1973 on the one hand and *restitutio in integrum* pursuant to Article 122 EPC 1973 on the other (see J 3/01, Reasons 10; J 25/01, Reasons 4). To cancel procedural effects after failure to meet a time limit would be to apply Rule 88, first sentence, EPC 1973 beyond its clear and unambiguous wording and would violate the scope of application of Article 122 EPC 1973 which stipulated specific requirements for the grant of re-establishment of rights (see J 6/02, Reasons 15).

2.3.2 It is true that, as claimed by the appellant, the above decisions relate to fact patterns which differ from

those in the present case. However, it can be left open whether these different circumstances are sufficient to disregard the above case law for the following reason.

2.3.3 In its decision G 1/12 (OJ EPO 2014, A114), the Enlarged Board has already affirmed that corrections of errors under Rule 139, first sentence, EPC in documents filed with the EPO are generally applicable.

(a) According to the Enlarged Board, this follows clearly from the EPC structure as intended by the legislator, Rule 139 EPC having been left in the part relating to "Common provisions", where it had already been in the EPC 1973. Since it applied to any document filed with the EPO, the Enlarged Board saw no reason why it should not also apply to appeals (see G 1/12, Reasons 33 to 36).

(b) The Enlarged Board also rejected the argument that, applying the general principle of *lex specialis derogat legi generali*, Rule 139 EPC was to be considered "*lex generalis*", which was applicable unless derogated from by specific provisions (such as Rule 101 EPC in the case there). It could not find any indication in the wording of Rule 139 EPC that this generally applicable provision referred to specific provisions. When formulating Rule 139 EPC, the EPC drafters did not make use of any introductory or final wording which, by definition, would have referred to a specific provision excluding the general provision, as was the case in several other EPC provisions (see G 1/12, Reasons 39).

(c) The present board is aware that the Enlarged Board made the above findings exclusively in the context

of the correction of an error in the appellant's name and of Rule 101 EPC as a possible *lex specialis*. However, it fails to see why the lines of argument set out above should not equally apply to the correction of a mistake in a payment form and to the relation between Rule 139 EPC on the one hand and the provisions concerning the re-establishment of rights on the other. The board also notes that the Enlarged Board in G 1/12 was apparently aware of the case law cited in point 2.3.1 above, as can be seen from the reference made to decisions J 27/96 and J 6/02 in point 37 of the Reasons.

- 2.4 Requirements for a correction under Rule 139, first sentence, EPC
- 2.4.1 In G 1/12, Reasons 37, the Enlarged Board summarised the following principles developed by the boards of appeal with regard to corrections under Rule 88, first sentence, EPC 1973 (Rule 139, first sentence, EPC):
- (a) The correction must introduce what was originally intended. The possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans. It is the party's actual rather than ostensible intention which must be considered.
 - (b) Where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one.
 - (c) The error to be remedied may be an incorrect statement or an omission.

(d) The request for correction must be filed without delay.

2.4.2 In the present case, the appellant has met these requirements.

(a) The appellant originally intended to pay the full appeal fee via Form 1038E on 17 June 2019. Its intention to pay the correct amount (and not simply a reduced or previously valid amount) via Form 1038E was immediately apparent, as can be seen from the document to be corrected, in which the appellant had indicated in the "Fees" box the appeal fee relevant in the present case ("*011 Appeal fee for an appeal filed by an entity other than those referred to in Rule 6(4) and (5) EPC*").

Consequently, the strict requirements as to the appellant's burden of proof do not apply here.

(b) Furthermore, the error to be remedied in the present case is an incorrect statement in a document filed with the EPO, namely, the wrong amount in the "Amount to be paid" box on Form 1038E.

(c) Finally, the appellant filed its request under Rule 139 EPC only five days after the deemed delivery of the board's communication under Rule 112(1) EPC. The board is therefore satisfied that the appellant filed its request for correction without delay.

2.4.3 Apart from the requirements set out in G 1/12, Reasons 37, the Enlarged Board neither listed any further requirements for an allowable correction under

Rule 139, first sentence, EPC, nor explicitly stated that that list was to be regarded as exhaustive and that no further requirements should be considered. Consequently, there is case law which considered further requirements to safeguard legal certainty and the interests of third parties and the public.

- (a) Subsequent to the Enlarged Board's decision in G 1/12, the referring board in that case additionally took into account the necessity for procedural legal certainty and the respondent's interests when deciding on the appellant's request for correction (see T 445/08, interlocutory decision of 26 March 2015, Reasons 10, 11 and 13.6).
- (b) Furthermore, the boards of appeal have also considered the public's legitimate interest in being able to rely on the information published by the EPO (see J 9/14, Reasons 3 and 4, regarding a request for correction under Rule 139 EPC of the withdrawal of the designation of a contracting state). Accordingly, some decisions have excluded a correction under Rule 139 EPC (or Rule 88 EPC 1973) where even after a file inspection there would not have been any reason for a third party to suspect, at the time of the official notification to the public, that the withdrawal could be erroneous and later retracted (see J 25/03, Reasons 10; J 6/13, Reasons 4).
- (c) Also in the aforementioned context of the correction of designations, the boards of appeal imposed in some cases the requirement that an erroneous withdrawal of the designation of a contracting state had to be due to an excusable

oversight. This proviso followed from the need to weigh up the interests of a third party against those of the applicant and to take into account the requirement for fair proceedings before the EPO (see J 10/87, Reasons 13; J 16/08, Reasons 5, 10, 11).

- (d) Finally, in J 20/12 the board dealt with the question of whether an application was still pending after its (erroneous) withdrawal under Article 67(4) EPC. It touched upon the problem that an application could potentially remain pending *ad infinitum* after it was withdrawn if a request for correction under Rule 139 EPC led to such pendency, because there was no time limit placed on the right to make this request (see J 20/12, Reasons 5.2 and 5.3). From this it could be inferred that a correction under Rule 139 EPC should no longer be available as a legal remedy if a statutory time limit has expired or a statutory event has occurred.

2.4.4 In the present case, there is no need to decide whether the Enlarged Board's list of requirements for a request under Rule 139, first sentence, EPC is exhaustive. The potential further requirements set out above are in any case met.

- (a) The need for legal certainty, according to which parties are, as a rule, bound by their procedural acts (see T 445/08, interlocutory decision of 26 March 2015, Reasons 10 and 13.6), does not play a role in the present *ex parte* case since there is no respondent who may have relied on the appellant's original underpayment of the appeal fee

and whose interests could potentially be sacrificed if correction were to be allowed.

(b) Moreover, although the public should, in general, be able to rely on the information published by the EPO - for example, the fact that the appellant had originally paid an insufficient appeal fee -, it cannot necessarily infer that the published facts will inevitably lead to certain legal consequences. The present appellant subsequently filed certain procedural requests to eliminate the legal consequences of its mistake, and until the appeal is decided, third parties cannot presume that the board will dismiss those requests, such that the mistake would lead to the appeal being deemed not to have been filed.

(c) As far as the "excusable oversight" requirement is concerned, the board notes that it is related in nature to the "due care" requirement for re-establishment of rights under Article 122 EPC. However, a correction under Rule 139, first sentence, EPC is a generally applicable legal remedy and is thus available independently of whether the conditions for re-establishment of rights are met (see point 2.3.2 above). This general applicability would appear to be circumvented if the above requirement were to be applied to corrections under Rule 139, first sentence, EPC. The exact criteria according to which an oversight should be excusable or not are also not clear to the board.

In the present case, however, the board holds that the degree of negligence on the part of the appellant was very low. The appellant had selected

the relevant appeal fee in the EPO online filing software. This would normally have automatically indicated the correct fee amount. The appellant could not have been expected to know that the selected "Edit fee amounts" option on the template would disable the automatic indication of the correct amount. Hence, even if the criterion of an excusable oversight were to be strictly applied in this case, this criterion would be met.

- (d) In the present case, the board also does not see any risk of the application in suit having an unclear legal status for an indefinitely long period of time because of requests for correction under Rule 139 EPC not being subject to a statutory time limit. Since the appellant had filed notice of appeal and had actually intended to pay the full appeal fee within the two-month time limit under Article 108, first sentence, EPC, the appeal proceedings were initiated within the prescribed time frame. The request for correction relates to a mistake committed within that time frame. As a consequence, there is no need to decide whether the requirements listed by the Enlarged Board in G 1/12 are sufficient *per se* to avoid the above risk.

2.5 Retroactive effect of a correction under Rule 139, first sentence, EPC

2.5.1 The Enlarged Board further stated in G 1/12, Reasons 37, that an allowable correction under Rule 139 EPC has "retrospective effect". This effect results in the indication of the correct amount of the appeal fee in the respective box on Form 1038E *ab initio*.

- 2.5.2 It could, however, be argued that the correct indication of the requisite fee would only be an intermediate step before the appeal fee could be debited, while the time limit for payment had already expired.
- 2.5.3 In this context, Articles 5(2) and 7(2) RFees in conjunction with point 5.4.1 of the current ADA come into play. The latter provision states the following: "*Provided there are sufficient funds in the deposit account on the date the EPO receives the debit order, that date will be considered as the date on which the payment is made.*" Accordingly, as the EPO received the (retroactively corrected) debit order on 17 June 2019 and as the balance of the professional representative's deposit account was sufficient on that date, the above date - which was before the expiry of the time limit under Article 108, first sentence, EPC - is to be considered as the payment date.
3. The board concludes that the requirements for the requested correction are met and that the correction should thus be allowed. As a consequence, the appeal is retroactively deemed to have been filed, the correction under Rule 139 EPC having effect *ex tunc*.
4. The appeal complies with the further requirements of Articles 106 to 108 and Rule 99 EPC and is therefore admissible.
5. *Valid filing of a European divisional application under Article 76(1) and Rule 36(1) EPC*
- 5.1 A European divisional application may be filed if it relates to a pending earlier European patent application (Article 76(1), Rule 36(1) EPC).

- 5.2 Pendency of the earlier European patent application
- 5.2.1 Following G 1/09 (OJ EPO 2011, 336, Reasons 3.2.4), a "pending earlier European patent application" within the specific context of Rule 25 EPC 1973 (Rule 36(1) EPC) is a patent application which is in a status in which the substantive rights deriving from it under the EPC are (still) in existence.
- 5.2.2 At the same time, it appears safe to say that, as soon as a European patent comes into existence, the European patent application from which it is derived ceases to exist and that there is no overlap between the phases of a pending patent application and a granted European patent. If a European patent exists, the corresponding patent application is no longer pending. Conversely, if a patent application is still pending, the patent has not yet come into existence.
- 5.2.3 Therefore, there is no need to decide whether "substantive rights" consist only of the rights under Article 67 EPC or whether there are further substantive rights deriving from an application, as claimed by the appellant. It is sufficient to determine at what point in time a patent comes into existence, thereby terminating the pendency of the corresponding application.
- 5.2.4 The law answers this question clearly and unambiguously. According to Article 97(3) EPC, the decision to grant a European patent takes effect on the *date* on which the mention of the grant is published in the European Patent Bulletin. Thus, it is the date (German: *der Tag*; French: *la date*) that counts and not a specific point in time on a specific date or the

chronological order of events on that specific date. Likewise, according to Article 64(1) EPC, a European patent confers on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each contracting state in respect of which it is granted, the same rights as would be conferred by a national patent granted in that state. Thus, the date of publication and not the event of publication as such is the precondition for conferring the protection provided for by that article.

- 5.2.5 By choosing the date as the relevant criterion, the legislator determined an incontestable and foreseeable point in time at which jurisdiction passes to the national instances and at which the patent confers on its proprietor the rights defined in Article 64(1) EPC in relation to third parties (see J 24/10, Reasons 6). Consequently, the Receiving Section was correct in considering that the pendency of an earlier application ends on the day before the mention of the grant of the European patent in the European Patent Bulletin (see G 1/09, Reasons 4.3.2 as *obiter dictum*; J 7/04, Reasons 3; J 24/10, Reasons 3).
- 5.2.6 In this context, the appellant argued that the drafters of the EPC did not envisage the possibility of determining the chronology of the relevant events with the required certainty and precision, as is the case now with the online publication of the mentions of the grant of patents. There was nothing in EPC law that would prevent the EPO from attaching legal consequences to the chronology of events taking place on the same date.
- 5.2.7 The board is not persuaded by this argument. The legislator could have chosen the chronological order of

events as the relevant statutory criterion even though it did not have access to today's technology. However, it decided not to do so, which is why the chronology is irrelevant. Besides, the current solution provides an equally reliable and precise way to determine the point in time at which a European patent comes into existence.

5.3 Retroactive effect of the publication of the mention of the grant

5.3.1 The appellant further argued that, if the substantive rights deriving from an application ceased on the day before the publication of the mention of the grant, they would do so due to a retroactive effect of said publication since it did not happen precisely at midnight but rather at some point later in the day. This retroactive effect should be treated in the same way as the retroactive effect of the final refusal of an application under Article 67(4) EPC. In the latter case, a divisional application filed before the refusal becomes final is considered to have been validly filed.

5.3.2 The board is not convinced by this argument either, for the following reasons.

(a) First, the argument is based on the assumption that Articles 64(1) and 97(3) EPC establish a retroactive effect of the publication. However, under these provisions it is not the specific time of publication that matters, but the date. As a consequence, the above provisions do not establish a retroactive effect of the publication, but the legal fiction that a European patent always comes into existence (and the pendency of a European patent application always ends) at exactly

00.00 hrs on the day of publication, regardless of the actual time at which the publication took place on that day.

- (b) Second, and related, there is no basis for the claimed analogy with the situation under Article 67(4) EPC, where a retroactive effect is expressly stipulated. An analogy with the situation under Article 67(4) EPC would have been conceivable only if, for example, Article 67(1) EPC had been worded as follows:

"A European patent application shall, from the date of its publication, provisionally confer upon the applicant the protection provided for by Article 64, ... until the (moment on which the) mention of the grant of the European patent is published in the European Patent Bulletin."

Only in this case could it have been argued that, by referring to the date rather than the event of publication, Article 97(3) EPC imposes a retroactive effect.

- (c) In view of the above, whether or not a distinction can be drawn between the consequences of the retroactive effect of a decision to reject becoming final and of publishing the mention of the grant is irrelevant. Hence, the appellant's submission in this context that there were always uncertainties as to the factual occurrence of the publication on the announced date or as to the validity of the publication is also irrelevant. The possible uncertainties do not alter the fact that a patent comes into existence and the pendency of the corresponding application ends at 00.00 hrs on the

day of the (actual and valid) publication of the mention of the grant.

- 5.4 To summarise, the mention of the grant of the European patent deriving from the earlier application No. YY YYY YYY.Y was published in the European Patent Bulletin on 25 April 2018. Consequently, the pendency of the earlier application ended on 24 April 2018. The filing of the divisional application in hand on 25 April 2018 thus did not comply with the requirements of Article 76(1) and Rule 36(1) EPC.
- 5.5 Referral to the Enlarged Board (Article 112(1) (a) EPC)
- 5.5.1 The appellant requested that, should the board be minded to dismiss the appeal, the question reproduced in point IX above be referred to the Enlarged Board.
- 5.5.2 Under Article 112(1) (a) EPC, a board can refer any question to the Enlarged Board if it considers that a decision is required:
- in order to ensure uniform application of the law,
or
 - if a point of law of fundamental importance arises.
- 5.5.3 In the absence of any diverging case law, there is no need to ensure uniform application of the law in the present case. More specifically, the present board comes to the same conclusion as the boards which have already dealt with the fact pattern at issue so far, i.e. the Enlarged Board in G 1/09 and the Legal Board of Appeal in J 24/10 (see point 5.2.5 above). Hence, it is irrelevant that the Enlarged Board in G 1/09 provided its explanations in an *obiter dictum*.

- 5.5.4 Moreover, it is true that the question of when the pending status of a European patent application ends is relevant to a large number of similar cases and could therefore be seen as an important point of law. However, it is established case law that a referral is not justified if the question could be answered without doubt by reference to the EPC (see Case Law of the Boards of Appeal of the European Patent Office, 9th edition 2019, last two paragraphs of section V.B.2.3.7, with further references cited there). This is the case here, as has been shown in points 5.2.4 and 5.2.5 above.
- 5.5.5 Consequently, the question as to why the Enlarged Board used the word "*normally*" in G 1/09, Reasons 4.3.2 ("*Thus, in the case of a decision to grant, the pending status of the European patent application normally ceases on the day before the mention of its grant is published ...*") has no bearing on the board's decision on the referral request.

Order

For these reasons it is decided that:

1. The debit order in Form 1038E of the amount "EUR 1 860" in the "Fees" box is corrected to the amount of "EUR 2 255".
2. The request for a referral to the Enlarged Board of Appeal is rejected.
3. The appeal is dismissed.

The Registrar:

The Chairman:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated