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## EPO puts an End to the Practice of Resurrecting Invalid Claims in a Divisional Application

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An interesting case decided by Technical Board of Appeal 3.5.5 in May 2009 strives to put an end to the (occasional) practice of some applicants and/or their European representatives of trying to again pursue in a divisional application a claim that was finally rejected in the parent application. The decision further develops existing case law in two aspects:

(i) Firstly, the Board gave the principle of *res iudicata* a broad interpretation, extending beyond Article 111(2) EPC. This Article stipulates the binding effect of a Board of Appeal decision on the lower instance in the event that the case is remitted. It reads as follows: „If the Board of Appeal remits the case for further prosecution to the department whose decision was appealed, that department shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts are the same. If the decision under appeal was taken by the Receiving Section, the Examining Division shall also be bound by the ratio decidendi of the Board of Appeal.” The Board now held that the general principle of *res iudicata* is not limited to these cases, but extends to divisional applications as well. That is, if a claim has been finally revoked by a Board of Appeal in a parent application, then applicant is barred from pursuing the same claim again in a divisional.

(ii) Secondly, the Board even went one step further and decided that the principle of *res iudicata* even prevents a Board of Appeal from reconsidering the same claim again as a matter of law; i.e. the Board may not even start examining such a claim which is outright inadmissible from the outset.

The application of these two principles to the concrete case turned out to have disastrous consequences for the applicant who had appealed a decision of the examining division rejecting his application. In the case at stake, the appellant had not directly contested the correctness of the first instance decision, but chose to base its grounds of appeal on amended claims, which corresponded more or less to an auxiliary request he had unsuccessfully pursued in the parent application earlier. This strategy resulted in that appellant’s appeal was thrown out as inadmissible. The Board held:

*“Subject matter on which a final decision has been taken by a board of appeal in the*

*parent application becomes res iudicata and cannot be pursued in the divisional application. If the statement setting out the grounds of appeal in a case does not go beyond submitting and arguing for a set of claims which constitutes such subject matter, the appeal is not sufficiently substantiated.”*

That is, the Board was of the view that it was barred from deciding on appellant’s resurrected claims on account of the principle of res iudicata. Therefore such claims could not form a suitable attempt to remove the factual basis for the rejection. Even worse, since the appellant did not challenge the correctness of the examining division’s decision and chose not to pursue the main request which it pursued in the first instance, there were no claims before the Board of Appeal that it was entitled to review. Thus the entire appeal had to be dismissed as inadmissible.

It did not even help the appellant that one dependent claim that he pursued on appeal had undisputedly not been considered in the parent application, since at least the independent claims were clearly identical to the ones held invalid in the parent application. The Board held that in accordance with Article 113(2) EPC 1973, it can only decide upon the European patent application in the text submitted to it or agreed by the applicant. It is well-established practice that an applicant can file a main and auxiliary requests. However, if he wishes to do so, this has to be clearly indicated. Dependent claims are indeed potential fall-back positions in case the independent claim is not allowable. However, they cannot per se be considered as being submitted as independent claims and forming auxiliary requests, as long as they are not expressly requested and formulated. Assuming that dependent claims are auxiliary requests would be pure speculation and would be in conflict with the principle of party disposition which is enshrined in Article 113(2) EPC 1973.

Board of Appeal 3.5.5 was of the view that the principle of res iudicata is so well-established and generally accepted in the contracting states and so clearly derivable from the existing case law of the Boards of Appeal that it even rejected appellant’s auxiliary request to refer the question of the scope of the res iudicata maxim to the Enlarged Board of Appeal. The Board held:

*“The res iudicata maxim is based on the need for an end to all litigation. It provides legal certainty, while taking account of the general public concern for the settlement of disputes (expedit rei publicae ut finis litium sit). It prohibits parties from challenging what has already been decided (J 3/95, point 6 of the reasons). It must be avoided that the same case is decided twice, possibly with a different outcome. The divisional application gives the applicant, within certain limits, the possibility to pursue the same subject matter as in the parent application. Since the aim of the res iudicata maxim is to avoid relitigation of the same subject matter by the same parties, it must inevitably apply to a divisional application.”*

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T 08 0051 Res iudicata – Divisionals

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