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**Datasheet for the decision
of 7 May 2009**

Case Number: T 0051/08 - 3.5.05

Application Number: 05076491.9

Publication Number: 1591840

IPC: G03G 15/00

Language of the proceedings: EN

Title of invention:

Automatic service requests over the world wide web

Applicant:

CANON KABUSHIKI KAISHA

Opponent:

-

Headword:

Res iudicata in a divisional application/CANON

Relevant legal provisions:

EPC Art. 108,
EPC R. 99(2), 101(1)
RPBA Art. 12(2)

Relevant legal provisions (EPC 1973):

EPC Art. 111(2), 112(1)(a), 113(2)

Keyword:

"Binding effect of a decision taken in the parent application"
"Principle of *res iudicata* applied in the divisional
application"
"Admissibility of the appeal (no)"
"Referral to the Enlarged Board of Appeal (no)"

Decisions cited:

G 0001/97, G 0001/05, J 0027/94, J 0003/95, J 0010/07,
T 0032/82, T 0729/90, T 0934/91, T 0167/93, T 1180/04

Catchword:

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.



Case Number: T 0051/08 - 3.5.05

D E C I S I O N
of the Technical Board of Appeal 3.5.05
of 7 May 2009

Appellant: CANON KABUSHIKI KAISHA
3-30-2 Shimomaruko
Ohta-ku
Tokyo (JP)

Representative: TBK-Patent
Bavariaring 4-6
D-80336 München (DE)

Decision under appeal: Decision of the Examining Division of the
European Patent Office posted 10 August 2007
refusing European application No. 05076491.9
pursuant to Article 97(1) EPC 1973.

Composition of the Board:

Chairman: D. H. Rees
Members: P. Schmitz
P. Corcoran

Summary of Facts and Submissions

- I. European patent application 05 076 491.9 was filed as a divisional application of application 97 307 545.0 on 29 June 2005. In a decision dated 10 August 2007, the examining division refused the application for lack of inventive step of the main and the auxiliary request.
- II. The appellant (applicant) filed a notice of appeal on 10 October 2007 and paid the appeal fee on the same day. With the statement setting out the grounds of appeal submitted on 13 December 2007, the appellant filed an amended set of claims and argued why it was inventive.
- III. In a communication dated 16 April 2008, the board questioned the admissibility of the appeal. It set out that no reasons had been provided why the decision under appeal was incorrect. Instead, amended claims had been submitted. However, the board was barred from deciding on these claims because they corresponded to the second auxiliary request of the parent application which had been refused in decision T 1180/04 dated 7 July 2005. Thus this subject matter had become *res iudicata* and therefore could not form a suitable attempt to remove the factual basis for the rejection.
- IV. In reply, the appellant put forward two "concepts" based on which the appeal was argued to be admissible. The first concept was that the appeal was sufficiently substantiated because each dependent claim had to be considered as a kind of auxiliary request. Dependent claim 7 had not been decided on in decision T 1180/04 and thus had not become *res iudicata*. Therefore it had to be regarded as an attempt to overcome the objections

of the department of first instance. Concept two took as its starting point that a parent and a divisional application were two independent applications. The question of substantiation of an appeal in a divisional application was argued to be completely independent from what had ever been filed or decided in the parent case. The only restriction in this context was the prohibition of double patenting. However, the filing of claims identical to claims which had been filed but not granted in the parent case was not in conflict with this principle.

- V. At the appellant's request, oral proceedings were held on 7 May 2009.

The appellant additionally submitted that for an appeal to be admissible it was sufficient to file new claims which identifiably formed the basis of the further procedure. In this case it was not necessary to set out why the decision under appeal was incorrect. For the appeal to be admissible it was not a condition that these claims were also allowable. What had to be examined first was whether the newly filed claims were capable of overcoming the objections of the first instance irrespective of whether, for whatever reason, they would be allowable or not. Furthermore, the principle of *res iudicata* did not apply to divisional applications because the binding effect only applied to the case decided but not to parallel ones. If the principle of *res iudicata* applied to divisional applications, the Enlarged Board of Appeal would have stated this in G 1/05. At least it seemed appropriate to refer this question to the Enlarged Board of Appeal.

VI. The appellant requested that the appeal be considered as admissible, additionally that the following question of law be referred to the Enlarged Board of Appeal:

"Can a statement of grounds of appeal which is based on the patentability of a set of claims which was not subject of the appealed decision be declared as inadmissible, because a board of appeal had taken a negative decision on the patentability of the independent claims of this set of claims in the parent application?"

VII. At the end of the oral proceedings the chairman announced the decision.

Reasons for the Decision

1. The question to be decided is whether the statement setting out the grounds of appeal meets the requirements of Article 108, third sentence EPC. According to the established jurisprudence of the boards of appeal the statement of grounds should specify the legal and factual reasons on which the case for setting aside the decision is based. This is now also enshrined in Rule 99(2) EPC, which is applicable in the present case (see J 10/07, OJ EPO 2008, 567). The arguments must be clearly and precisely presented to enable the board to understand immediately why the decision under appeal is alleged to be incorrect (Case Law of the Boards of Appeal of the European Patent Office, 5th edition, 2006, VII.D.7.5.1). In the present case, no reasons at all were given as to why the decision of the examining division was wrong.

2. Instead the appellant filed an amended set of claims. It is accepted in the jurisprudence that an appeal may be admissible if, despite its not being clear from the statement of grounds why the contested decision is incorrect, claims are put forward which overcome the objections of the department of first instance or remove the factual or legal basis for the rejection (T 729/90 dated 29 October 1993; Case Law of the Boards of Appeal, *supra*, VII.D.7.5.2(d)). The idea is that an appellant should not be forced to pursue claims which he accepts are not allowable or he is no longer interested in and where he is prepared to amend the application in order to meet the first instance objections. It would be pure formalism which serves neither the appellant nor the board of appeal if he were to be compelled to provide arguments relating to the decision under appeal before being entitled to submit amendments during the course of the appeal procedure.

3. In the present case, the appellant has submitted a set of 18 claims which undisputedly corresponds, at least in its independent claims, to auxiliary request two of decision T 1180/04 concerning the parent application. In decision T 1180/04, the then competent board decided that independent claims 1 and 12 were not inventive and dismissed the appellant's appeal. In G 1/97 (OJ EPO 2000, 322, point 2(a) of the reasons) the Enlarged Board of Appeal stated that decisions of the boards of appeal become final as soon as they are issued. This means that the board's ruling becomes binding. This principle of *res iudicata* is generally accepted in the contracting states and acknowledged by

the boards of appeal (see e.g. J 3/95, OJ EPO 1997, 493; T 167/93, OJ EPO 1997,229). The meaning of the legal term *res iudicata* is old and well-established: it defines "...a matter finally settled by a Court of competent jurisdiction, rendering that subject matter conclusive as to the rights of the parties and their privies" (see Black's Law Dictionary, 5th Edition). Such a final judgement by a court of competent jurisdiction therefore constitutes an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or privies (T 934/91, OJ EPO 1994, 184, point 3 of the reasons). Once a final judgement has been handed down, subsequent judges who are confronted with a suit that is identical to or substantially the same as the earlier one and between the same parties, are prevented from deciding on it a second time.

- 3.1 The appellant was of the opinion that the principle of *res iudicata* could not be applied in the case of a divisional application when a decision on the same subject matter had been taken by a board of appeal in the case of the parent application. The board cannot share this view since it is inherent in the principle of *res iudicata* that subsequent proceedings should be avoided. 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, *supra*, 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.

3.2 The appellant argued that the only restriction imposed on divisional applications by the Enlarged Board of Appeal in G 1/05 (OJ EPO 2008, 271) was the prohibition of double patenting. At the end of its decision, the Enlarged Board had expressed its dissatisfaction with regard to divisional applications but had not mentioned *res iudicata* as a tool to cope with it. The board observes that the point of law dealt with in G 1/05, *supra* did not concern the *res iudicata* issue and not having addressed this issue does not mean that the Enlarged Board held that it does not apply. Moreover, the principle of *res iudicata* has nothing to do with the prohibition of double patenting. An inventor is awarded a patent for having disclosed his invention to the public. This right he only gains once and therefore double patenting is to be avoided. Once a patent has been granted he should not be in the position to duplicate his rights. In contrast, the principle of *res iudicata* aims to avoid duplicated or contradicting judgements.

3.3 The appellant quoted a passage in Schulte (Patentgesetz mit EPÜ, 8th Edition, Art 111 EPC No. 44, Anhang zu § 73) allegedly supporting his view where it is stated that the binding effect only applies to the case decided and not to parallel ones. However, this citation refers to decision J 27/94 (OJ EPO 1995, 831)

which deals with a different situation. In J 27/94 the board of appeal decided that the department of first instance is not bound by a decision of a board in which the board had decided on a specific legal problem, when the same legal problem arises in another case. Moreover, while it is true that Article 111(2) EPC 1973 provides for the binding effect of a judgment only for the decided case, the general principle of *res iudicata* goes beyond this and aims at avoiding any subsequent ruling on the same subject matter in other proceedings between the same parties.

4. It follows from the preceding that the set of claims submitted with the statement setting out the grounds of appeal has become *res iudicata*. Since the board cannot take a decision on this subject matter, it can not be pursued in the present application.

5. The next question which needs to be answered is what consequence this has for the admissibility of the appeal. As set out above, instead of dealing with the reasons of the decision under appeal, amendments can be filed which overcome the objections of the department of first instance. The appellant submitted that the question of whether the amendments overcome or are capable of overcoming the objections of the department of first instance concerns the allowability rather than the admissibility of the appeal. However, a substantive examination presupposes that the board is entitled to perform this examination. In the present case, the board is prevented from doing so for procedural reasons. The board does not even have a discretion it could use in the appellant's favour. Therefore, the amendments could not from the outset remove the factual or legal

basis for the rejection.

6. In this context it is worthwhile considering the purpose of the requirement that grounds have to be given for an appeal. Article 12(2) RPBA stipulates that the statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely why it is requested that the decision under appeal be reversed, amended or upheld, and should specify all the facts, arguments and evidence relied on. A similar provision is to be found in Rule 99(2) EPC which has been introduced by the EPC 2000 and which codifies the existing case law. The statement of grounds is not just an intermediate step in the procedure, but sets the framework of the appeal within which the board will perform its substantive examination. Submitting amendments on which the board is prevented from deciding does not leave any room for such an examination. There is no case for the Board to examine. This is clearly in contradiction to the purpose of the requirement of giving grounds of appeal, which would degrade the statement of grounds to a purely formal act.

7. The appellant argued that the appeal was sufficiently substantiated because with the statement of grounds of appeal claims 1 to 18 had been filed and each dependent claim had to be considered as a kind of auxiliary request. Claim 7, in which the appellant was interested, and which had not been decided upon in decision T 1180/04, had to be regarded as an attempt to overcome the objections of the department of first instance.

8. The board cannot concur with this view. In accordance with Article 113(2) EPC 1973, the board can only decide upon the European patent application in the text submitted to it or agreed by the applicant. It follows that, when deciding on the appeal, the board has no authority under the EPC to order the grant of a European patent containing claims which are different from those submitted by the applicant in their content or interdependency (T 32/82, OJ EPO 1984, 354, point 19 of the reasons).

9. 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. The applicant has to identify which requests he wants to have examined and in which order. 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 and according to which it is the applicant who sets the framework of the examination by his requests.

10. Summarising the above, the statement of grounds of appeal does not meet the requirements of Article 108, third sentence and Rule 99(2) EPC. Therefore the appeal is to be rejected as inadmissible according to Rule 101(1) EPC.

11. The appellant additionally requested that the question of law mentioned in the Facts under VI. be referred to the Enlarged Board of Appeal. This has to be interpreted as an auxiliary request. According to Article 112(1)(a) EPC 1973, the board of appeal shall refer any question to the Enlarged Board of Appeal in order to ensure uniform application of the law, or if a point of law of fundamental importance arises, if it considers that a decision is required. The question proposed covers a very special situation which cannot be considered as an important point of law since it does not seem relevant to a substantial number of cases. The board also does not consider it necessary that the more general point which is embraced by the question, i. e. whether the principle of *res iudicata* applies between a parent and a divisional application, be referred to the Enlarged Board. The principle of *res iudicata* is well established in the jurisprudence of the boards of appeal, although it seems that it has not yet been the subject of a decision within the framework of a parent and a divisional application. However, as set out above, its meaning is clear so that an answer can unequivocally be derived from the existing jurisprudence. The mere fact that this point has not yet been decided upon does not justify a referral. Therefore, this request is rejected.

Order

For these reasons it is decided that:

The appeal is dismissed as inadmissible.

The Registrar:

The Chairman:

K. Götz

D. H. Rees