Kluwer Patent Blog

J1/24 – a New Landscape for Divisionals?

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The recently released judgment in J1/24 (relating to EP 3660979B1), from the Legal Board of Appeal at the European Patent Office (EPO) is a divisive judgment, which could potentially have far-reaching implications.

Existing legislation ignored/overturned by J1/24

The European Patent Convention is clear that a divisional application must be filed from a **pending** parent application, as dictated by Article 76 EPC, Rule 36(1) EPC. Traditionally potential divisional applicants would have therefore been aware that the final deadline to file a divisional patent in view of the grant of the parent is: *"up to but not including the day of mention of grant"* in the European Patent Bulletin (G1/09). Prior to the judgment in J1/24, once an applicant missed this deadline there appeared to be no room for mitigation.

However, EPO case law indicates that "pending" in terms of a patent application *"is a condition, not a time limit"* J24/03, J10/01– reason 15 and also the EPO Guidelines 2024, Part A, Chapter IV, 1.1.1. When one bears this in mind, whilst taking into account Article 106(1) EPC, which states that in principle an application will be pending again if a notice of appeal is filed, one can start to apprehend how Samsung Electronics, the Applicant in J1/24, managed to circumvent this alleged concrete divisional filing deadline and successfully file a divisional application after the mention of grant of the parent.

Whether the Board meant this or not, we are now left with a situation where an applicant may file a valid appeal against its own successful grant decision, keep the application pending and thus have a longer period of time to file a divisional. This once un-circumnavigable deadline of one day prior to the mention of grant is suddenly a grey area.

The above line of argumentation has been tried before, in J28/03, but was ultimately unsuccessful. This is because the Board stated that *"an appeal against [a] granting patent will only restore pendency of parent if [the] appeal is not "trivially inadmissible"*.

The question now arises, how do J1/24 and J28/03 differ for the former appeal to have succeeded whilst the latter was rejected? Further, in what situations is an appeal valid and therefore not deemed as "trivially inadmissible"?

Comparisons between J1/24 and J28/03

J28/03 dates back to the early 2000s. The applicant, having had the grant of their patent mentioned in the EP bulletin, appealed the decision to grant. Whilst the board ruminated on their judgment, the applicant filed a divisional arguing it should have been validly filed as the parent application should be perceived as pending until the Board of Appeal came to their judgment.

However, once deferred to the Board of Appeal, the divisional filing was adjudged to be invalid because, at the stage at which the EPO indicated that they intended to grant a patent, the applicant had approved the text for grant. Thus, the applicant was not "adversely affected" by the decision to grant, resulting in the appeal being labelled as "trivially inadmissible" and rejected.

Article 107 EPC defines persons that are entitled to appeal as those who are involved in proceedings before the EPO and are adversely affected by a decision.

For example, in opposition proceedings, it is clear who the adversely affected party is. If, for example, a patent is revoked in its entirety, only the proprietor is adversely affected. Conversely, if the patent is upheld as granted, only the opponent is adversely affected. If, however, the patent is maintained in an amended form based on an auxiliary claim request, both the proprietor and the opponent are adversely affected. The proprietor is adversely affected because the patent as granted has been revoked, whilst the opponent is also adversely affected because the patent has not been revoked in its entirety.

If a decision is favourable for a particular party they are unable to appeal it. So, one may wonder why, in J1/24, the applicant was able to argue that they were adversely affected by a decision to grant their own patent. Would a party in this position ever really be "adversely affected"? This is particularly the case, given that an applicant must actively approve the text for grant before a decision to grant is issued.

In J1/24, the applicant relied on an erroneous reference to a figure in view of revised guidelines for examination that were issued after they approved the text for grant (see below). This is clear from the applicant's Statement of Grounds of Appeal , which read:

> The amendments to page 2 are to delete reference to Fig. 24 in the statement "*Figures 3A to 3E, 21A to 21C and 24 and the corresponding parts of the description relate to an electronic device of an exemplary implementation outside the scope of the invention as claimed but useful for understanding the invention.*" such that it now reads "*Figures 3A to 3E and 21A to 21C and the corresponding parts of the description relate to an electronic device of an exemplary implementation outside the scope of the invention as claimed but useful for understanding the invention*".
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> On 1 March 2021, the Guidelines for Examination in the European Patent Office (referred to as the "Guidelines" hereafter) were amended. The amendments to the Guidelines were extensive and in particular change the Guidelines in relation to the requirements for the description of a European patent application in relation to meeting the requirements of Article 84 EPC. It is believed that, in view of the amended Guidelines being published on 1 March 2021, the applicant has been adversely affect by the decision to grant in spite of the applicant's approval of the text proposed for grant, where said approval was given when the November 2019 edition of the Guidelines was in force.

It may be surprising to some that an amendment to the EPO Guidelines would be enough to render an applicant adversely affected, particularly as the EPO Guidelines themselves have no legal authority.

Does this open the door for applicants to take advantage and come up with creative ways to argue that they have been adversely affected, to effectively extend the time in which they are able to file

divisional applications, or to file a divisional application when the original deadline of the day before grant had been missed in error?

Although it is certainly interesting, we view this decision with caution and would certainly not recommend relying on the strategy of appealing a decision to grant to buy extra time to file a divisional application, particularly as a very specific set of circumstances convened to allow the applicant to argue that they were adversely affected, and thus appeal the grant of their own patent.

That said, it may be something to keep in the mind as a last resort if an applicant is ever in the unfortunate position of having missed a divisional deadline, or if they have changed their mind about filing a divisional application, on a particularly important case.

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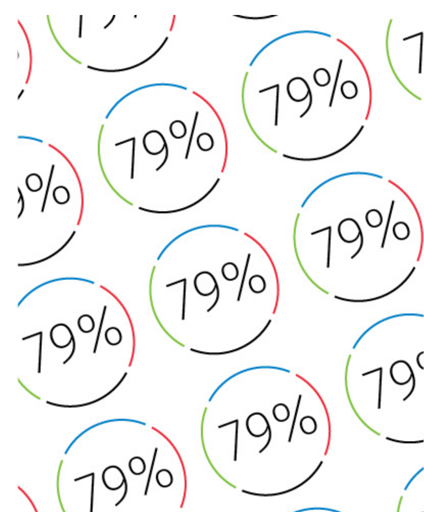

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