

3.5.7 Pendency in case of deemed withdrawal of earlier application and request for re-establishment

In J 4/11 (OJ 2012, 516) the Legal Board held that an application which had been deemed to be withdrawn for **non-payment of a renewal fee** was not pending within the meaning of R. 25(1) EPC 1973 in the period for filing a request for re-establishment of rights under Art. 122 EPC 1973 in respect of such non-payment, or in the period after which such a request was filed in the event of such request being refused. The mere existence of the right to file a request for re-establishment of rights in respect of a deemed withdrawn application did not mean that the application was still pending while the period for filing such a request was running. Likewise, the fact that a request for re-establishment of rights was actually filed could not make the application become pending again. The board stated that the point in time when the application was deemed to be withdrawn was the point when the due time for payment of the renewal fee expired; the loss of rights occurred on the expiry of the time limit that had not been observed and, as such, was final in itself. Filing a request for re-establishment did not provisionally revive a deemed withdrawn application. As to whether the applicant enjoyed substantive rights in respect of the earlier application which were (still) subsisting when the later application was filed (see G 1/09, OJ 2011, 336), the Legal Board held that in the case at issue the substantive rights under Art. 64 EPC were no longer subsisting. As to other possible rights, the right of the inventor under Art. 60 EPC was held to be no longer subsisting when the divisional application was filed, since the right ceased to exist if and when the application was finally refused, or was withdrawn or deemed to be withdrawn.

3.5.8 Pendency in case of deemed withdrawal of earlier application and no reaction to loss of rights communication under Rule 112(1) EPC

In J 10/16 the Legal Board found that a divisional application could not be filed from the point in time at which the parent application was deemed to have been withdrawn (here: after expiry of the six-month period under R. 161(1) EPC) and if the applicant did not act on the communication noting this loss of rights under R. 112(1) EPC. Where, after receiving such a communication, the applicant did not apply for a decision under R. 112(2) EPC, the rights were lost on expiry of the original unobserved time limit (see e.g. J 4/86, OJ 1988, 119; G 1/90, OJ 1991, 275; G 4/98, OJ 2001, 131; J 19/01; J 9/02); the communication became final; and the proceedings came to an end also **on expiry of the original time limit** – unless the legal effect in question was set aside by either further processing or re-establishment of rights. Communications under R. 112(1) and decisions under R. 112(2) EPC were purely declaratory findings of a loss of rights already having arisen by operation of law (see J 1/05).

3.5.9 Pendency in case of withdrawal of earlier application

The case underlying J 20/12 concerned a parent application which had been unconditionally withdrawn but the appellant had filed a **request to correct this withdrawal**. This request was ultimately refused by the Legal Board of Appeal (in decision J 1/11). After the request for correction, the appellant had filed a divisional application, which the Receiving Section decided not to process because the parent application had