

2.4.3 Final decision on subject-matter in the parent application or a sibling application – res judicata

a) Decisions affirming cross-procedural res judicata effect

In T. 51/08 the appellant submitted amended claims corresponding to the second auxiliary request of the parent application which had already been refused on appeal. The board held that subject-matter on which a final decision had been taken by a board of appeal in the parent application became res judicata and could not be pursued in the divisional application (see also T. 790/10, see however also T. 2145/11, in which the board distinguishes its case from T. 51/08 as the claims at issue were not identical to those in the proceedings related to the parent patent).

In T. 1155/13 an objection of lack of sufficiency was raised by the appellant against the patent based on a divisional application. The board considered, however, that T. 468/09 had dealt with an insufficiency objection in relation to the patent granted on the basis of the parent application. Since decision T. 468/09 was res judicata and dealt with insufficiency of disclosure in relation to the same embodiments, and the facts were the same, the current board had no power to examine this objection again (with reference to T. 51/08).

b) Decisions leaving open the question of cross-procedural res judicata effect

In T. 1643/10 the board left open the question of whether, or to what extent, decisions regarding a parent or a sibling application represent res judicata for a divisional application. For the board in T. 1666/14 too, there was ultimately no need to answer this question because the claims at issue in the examination appeal proceedings brought before it in relation to the divisional application differed from those decided on in the earlier opposition appeal proceedings concerning the parent application. It nevertheless took the view that, where decisions had been taken on a parent application in both examination appeal and opposition appeal proceedings, only the latter decision could, if at all, have binding effect on the relation between the parent and divisional application. See also T. 2145/11, T. 1870/16 and T. 1270/20, in which the boards similarly held there could be no res judicata because the claims were not identical.

c) Decisions doubting cross-procedural res judicata effect

In T. 2084/11 the appellant (opponent) had argued that the invention's reproducibility was res judicata, a final decision having already been taken on the parent application. The board noted that the EPC did not mention res judicata, let alone regulate its applicability in the context of separate proceedings on parent and divisional applications or any resulting patents. EPO proceedings on a divisional were essentially independent of those on its parent (see T. 1254/06). The board therefore doubted that a final decision taken in opposition appeal proceedings (here revocation of the patent) could have any "cross-procedural" res judicata effect at all on separate opposition (or opposition appeal) proceedings concerning a patent granted on a divisional. T. 167/93 had already said that res judicata, whilst a generally recognised principle, was of extremely narrow scope and