

European Patent Team Divisional Applications

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European Divisional Applications – Questions and Answers Summarized

One of the sessions in our seminar in Tokyo earlier this year was devoted to important – and at that time unanswered – questions which had been raised in relation to European divisional patent applications. Many of these questions have now been answered by the Enlarged Board of Appeal (EBA) of the EPO.

The fundamental questions answered by the EBA are summarized below.

BASIC QUESTION

Parent application



Divisional with new matter as filed
Is correction of the new matter flaw in the divisional possible?

The Basic Question asks if it is possible to correct a divisional which is flawed when it is filed because it includes new matter over its parent application.

The answer is YES. New matter can be removed from a divisional – after filing of the divisional – to correct the new matter flaw in the divisional.

TIMING QUESTION

Parent application no longer pending



Divisional as filed contained new matter and still contains new matter
Is correction of the divisional still possible?

The Timing Question asks if correction of the new matter flaw in the divisional is possible even after the parent is no longer pending (i.e. the parent has been refused or withdrawn, or has become a granted patent).

The answer is YES. Correction of the new matter flaw in the divisional is possible even if the parent is no longer pending. More generally, the divisional is an independent application; the fate of the divisional does not depend on the fate of the parent.

SCOPE OF PROTECTION QUESTION



Can the target of protection in a divisional application be different from the target of protection indicated in its parent application?

The Scope of Protection Question asks if a divisional can claim protection for disclosed matter which is not claimed or otherwise specifically indicated to be a target for protection in the parent application.

The answer is YES. The divisional can seek protection for any subject-matter disclosed in the parent and in the divisional.

CASCADE QUESTION



Do special restrictions apply if the parent application is itself a divisional of an earlier application?

The Cascade Question asks if there are special issues relating to “cascaded” divisional applications, i.e. do special restrictions apply to a divisional the parent of which is itself a divisional of an earlier application?

The answer is NO. Of course, a cascaded divisional (if necessary, after correction) may not include new matter over any of the earlier applications on which it is based (parent, grandparent etc.). Beyond this, however, there are no special restrictions on cascaded divisionals.



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Problems Resolved by the Enlarged Board of Appeal of the EPO

A handful of European Patent Office (EPO) Board of Appeal decisions questioning established EPO practice relating to divisional applications have caused uncertainty for applicants. The Enlarged Board of Appeal (EBA) has now resolved the uncertainty in favour of applicants. In brief: -

- A divisional application that has a new matter problem as filed is not incurably invalid. The problem can be corrected.
- Divisional claims need not be confined only to matter already indicated to be a subject of protection in the parent. Other matter – provided it is present in the parent and divisional – can be claimed.
- The established liberal EPO regime regarding cascades of divisionals, in some ways resembling US continuation practice, is affirmed as legally correct.

QUESTIONS

- 1) Contrary to EPO law, a divisional as filed contains new matter. Does this mean that the divisional is not validly filed, so there is no possibility of correction by removal of the new matter after filing?
- 2) If such correction of the divisional is in principle possible, does availability of correction depend on the status of the parent, i.e. must the parent still be pending – not refused, withdrawn or granted – when correction is requested?
- 3) Are there restrictions on what can be claimed in a divisional, related to what its parent indicated was intended to be a subject of protection?
- 4) Are there any additional conditions or restrictions which apply to a “cascaded” divisional application, i.e. a divisional the parent of which is itself a divisional application?

ANSWERS

- 1) Presence of new matter on filing does not mean that the divisional is invalid. Correction by removal of the new matter is possible after filing of the divisional.
- 2) After filing, a divisional is an independent application. The status of the parent is of no relevance to the divisional.
 - New matter can be removed from the divisional even if its parent application is no longer a pending application (e.g. has been refused, withdrawn or granted).
- 3) There are no restrictions on what is claimed in a divisional, related to what its parent application indicated was intended to be the target of protection.
 - A divisional is required only to satisfy – at least after correction – the explicit requirements of EPO law, which forbid new matter not present in the parent. The divisional may claim matter present in the parent (and in the divisional) even if this was not explicitly indicated in the parent to be an intended subject of protection.
- 4) No additional restrictions or conditions apply to a “cascaded” divisional application.
 - A cascaded divisional is required only to satisfy – at least after correction – the explicit requirements of EPO law, which forbid new matter not present in *all* of its predecessor applications in the cascade. If matter is explicitly abandoned in any predecessor application, it cannot be reintroduced. The divisional may claim matter present in all of its predecessors even if this was not explicitly indicated in any predecessor to be an intended subject of protection.

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In Detail – The Decision of the Enlarged Board of Appeal concerning EPO Divisional Practice

The long-awaited decision of the EPO Enlarged Board of Appeal (EBA) upholds established practice of the EPO and can be considered a favourable outcome for patent applicants.

Two EBA cases, G1/05 and G1/06, were dealt with in consolidated proceedings, resulting in a single decision. The cases arise from referrals to the EBA of specific questions relating to divisional applications by Technical Boards of Appeal in case T39/03 and T1409/05.

The questions referred to the EBA from case T39/03 were:

- 1) Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?
- 2) If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?
- 3) If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

The EBA answered question (1) in the affirmative, thus allowing a divisional application which, at the time of filing, contains subject-matter not disclosed in its parent application to be subsequently amended to remove that subject-matter. The EBA considered Article 76(1), its legislative history and the need to balance interests of applicants and third parties, and concluded that these matters 'point in favour of an interpretation of Article 76(1) EPC permitting an applicant to amend a divisional application after the application has been filed so as to comply with the provisions of that article, provided always that the amendment complies with the other requirements of the EPC'.

The EBA also answered question (2) in the affirmative. The EBA stated that 'a divisional application is a new application which is separate and independent from the parent application' and quoted from previous EBA Decision G4/98 where the EBA considered 'that the procedure concerning the divisional application is in principle independent from the procedure concerning the parent application and that the divisional application is treated as a new application' and that 'actions (or omissions) occurring in the procedure concerning the parent application after the filing of the divisional application should not influence the procedure concerning the latter'. Accordingly, the EBA concluded that 'an amendment to remove added matter not disclosed in the parent application as filed from the divisional application as filed is allowable irrespective of whether the earlier application is still pending or not'.

In answer to question (3), the EBA held that there were no further limitations of substance on a divisional application beyond those imposed by Articles 76(1) and 123(2) EPC. Thus, the EBA held that 'a divisional application can be directed by amendment to aspects of the earlier application also disclosed in the divisional application as filed but not encompassed by the claims of the divisional application as filed'. The reasoning was essentially the same as used in answering question (2).

The questions referred to the EBA from case T1409/05 were:

- 1) In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?
- 2) If the above condition is not sufficient, does said sentence impose the additional requirement
 - a. that the subject-matter of the claims of the said divisional be nested within the subject-matter of the claims of its divisional predecessors? or
 - b. that all the divisional predecessors of said divisional comply with Article 76(1)?

In answer to question (1), the EBA held that this was indeed a necessary and sufficient condition and stated that 'according to the filing date of the first disclosure of the subject-matter concerned in the root application is only justified if the said subject-matter was disclosed in each of the preceding (earlier) applications as filed and if it was still present (i.e. it was not unequivocally and definitely abandoned by that time) in each earlier predecessor application at the time the - further - divisional application was filed so that it was thereby existing at all times throughout after its disclosure in the root application as filed up to and including the date of filing the divisional application under consideration'.

Thus 'Content which has been omitted on filing a member higher up [*i.e. earlier*] in the sequence cannot be re-introduced into that member or in divisional applications lower down [*i.e. later*] in the sequence from it' and 'Conversely, content which has been added on filing of a divisional application a sequence higher up [*i.e. earlier*] cannot be claimed in a divisional application down [*i.e. later in*] the sequence'.

Having decided that the condition outlined in question (1) is a sufficient condition to be met by a divisional application, the EBA held that there is no requirement for a divisional application to meet the further requirements mooted in question (2)(a) and (b), as these further requirements have no basis in the EPC. Thus, the Board held that there is no requirement for the claims of a divisional application to be nested within the claims of its divisional predecessors or for all of the divisional predecessors to satisfy the requirements of Article 76(1). In this regard, the EBA stated that 'it is irrelevant as to whether earlier members of the sequence as filed did not comply with Article 76(1), second sentence, EPC in respect of other subject-matter contained in them or whether they were maintained or rejected after the further divisional application in the sequence had been filed'.

In addition to answering the above questions, the EBA also made clear that for a patent granted on a divisional application to be valid the patent had to comply with Article 76(1) EPC, i.e. it could not validly contain subject-matter not disclosed in its parent application. In this regard, the Board flatly rejected the notion of according different parts of a divisional application different filing dates depending on whether or not they were included in the parent application, stating 'There is no room under the EPC for a divisional application to have as filing date the date of its actual filing with the EPO. By the same token, there is no support in the EPC for the idea that within one and the same application - be it a divisional application or not - different filing dates may be attributed to different parts of its subject-matter filed within that application at different points in time'.

End of the Story?

While affirming that the established EPO approach to sequences of divisionals is correct, the EBA concluded its reasoning with these remarks: "The Board finds it unsatisfactory that sequences of divisional applications each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years. If administrative measures, such as giving priority to the examination of divisional applications and bundling and speedily deciding co-pending divisional applications so as to minimize the possibility for applicants to keep alive subject-matter on which the Examining Division had already given a negative opinion in one application by means of refiling the same subject-matter again and again, are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be." It is observed that it may be easier for the legislator to take action to remedy "abuses" when EPC 2000 comes into force at the end of this year.

In Passing

It is noted that the EBA upheld, in passing, the current practice of the EPO of denying so-called double patenting, stating that 'an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent therefor'.

An Unanswered Question?

A further question concerning divisional applications, referred to the EBA in case T1040/04, was not directly answered. For formal reasons (withdrawal of all original appeals in case T1040/04, removing legal basis for the EBA to address the question) the EBA was unable to provide a direct answer. The question was "Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?". In view of the tenor of the EBA approach to the questions answered, and comments by the EBA, there is little doubt that the answer is yes: a patent granted on a divisional application can be amended in opposition proceedings to remove added subject-matter present when the divisional application was filed. This is in line with established EPO practice.