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Progress Report on EPO's Review of Divisional Practice

The current review of EPO divisional practice by the Enlarged Board of Appeal, pending as Enlarged Board of Appeal case G1/05 (see the January 2006 issue of this Newsletter), has been extended in recent weeks.

As a reminder, the existing case G1/05 is looking at the questions:

- Can a divisional application which, at its actual filing date, extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?
- If the answer is yes, is this still possible when the earlier application is no longer pending?
- If amendment is possible when the earlier application is no longer pending, are there any further limitations of substance to this possibility beyond the "new matter" rules, and in particular can the corrected divisional application be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

The related fresh cases **G1/06** and **G3/06** have now been started and consolidated with G1/05.

G1/06, which arises from the referring case T1409/05, is concerned with the requirements that each divisional must fulfil in a "cascade" situation of three or more "generations" of divisionals.

G3/06, which arises from the referring case T1040/04, is concerned with what a patentee can do, in (post-grant) opposition proceedings on a divisional case, to cure new matter introduced when the divisional application was filed.

As previously mentioned in this Newsletter, where these issues arise in the examination of pending applications, the issues are not being examined until the outcome of the Enlarged Board of Appeal proceedings is published. However, chemical Board of Appeal 3.3.06 in decision T739/05 has issued a robust refusal to suspend its consideration of these issues in pending appeals, on the basis that the long established past practice can and should be followed unless and until any contrary approach is clearly established (Reasons, section 6).

It is expected that the complications caused by the recent consolidations will cause substantial delays to the Enlarged Board of Appeal's deliberations. We will keep you informed of developments.

For the time being, we urge extreme caution over possible issues of new matter when the text is being finalised for a possible divisional application in the EPO.

→ http://www.european-patent-office.org/dg3/g_dec/pending.htm

→ <http://legal.european-patent-office.org/dg3/pdf/t050739eu1.pdf>

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It's Enough to Make You Swear!

In the June 2005 issue of this Newsletter we reported the current inconsistencies between the EPO Boards of Appeal on the issue of whether "second medical use" patents could be granted or upheld if they lack data to make the claimed use plausible.

In particular, we noted that the liberal Boards appear to be relying on case law from the non-medical arts to support the proposition that post-published test data can be used to support such patents, even though the data was not included in the application as filed.

In a case that reinforces that it is possible – at least at Board of Appeal level in the EPO and in certain Boards – to obtain such patents on the sole basis of **post-published** test data, Board 3.3.02 in case T715/03 has recently allowed claims to the use of ziprasidone against *inter alia* Tourette's Syndrome (TS), a well-publicised disorder which in extreme cases can cause its sufferers to swear involuntarily – and often loudly!

It appears from the decision that the inventor admitted he was aware of clinical data to support the claims when the application was filed, but failed to include it. Not only was the applicant allowed to support the claims by referring to the (later) publication of that data, but the (prior) published information that ziprasidone was “in late phase III development” for possible anti-TS activity was held not to prejudice an inventive step.

→ <http://legal.european-patent-office.org/dg3/biblio/t030715eu1.htm>

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EPO Examines “First Application” Status in a Priority Analysis

In Decision T449/04, EPO Board of Appeal 3.2.02 recently had the opportunity to consider whether a priority-founding application (“PR”) is to be considered to fulfil the necessary “first application” condition for the relevant subject-matter, when there existed also an earlier application (“D1”) (from which priority was not claimed) in which the same subject-matter was presented merely as non-inventive “comparison examples”.

The Board held that the existence of D1 did **not** prevent PR from constituting the first application for the invention claimed in the European application, so that priority from PR was validly claimed (Reasons, section 2).

The decision is interesting, because it raises the question of whether any European patent application can validly claim priority in relation to “comparison examples” present in the priority document.

It would seem that such a situation would be incompatible with T449/04. If D1 could have founded a hypothetical European patent application claiming, with priority, the subject-matter of D1’s comparison examples, D1 would then have existed with relevant rights outstanding at the filing date of PR, so that PR could not be the “first application”. Although in practice such an attempt to direct the claims of a European application onto the original comparison examples would normally fail for other reasons (for example, impermissible extrapolation from the specific to the generic, under the strict test for priority established by the Enlarged Board of Appeal in case G2/98), T449/04 provides an interesting additional viewpoint on the matter from the angle of the “first application” requirement for priority.

→ <http://legal.european-patent-office.org/dg3/pdf/t040449eu1.pdf>

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