

May 2005

European Patent Office Moves to Stricter Requirements for Divisional Applications

The Boards of Appeal of the European Patent Office (EPO) have recently issued a number of decisions that signal a move towards stricter requirements for divisional patent applications.

The points of change arise out of Decisions T1158/01, T720/02 and T797/02, and are as follows:

- *Correction of any divisional application to remove new matter included when it was filed may now be more difficult or in some cases impossible (Decision T1158/01, paragraph 3.2.2, final sentence).*
- *A second-generation divisional application, filed on a first-generation divisional application that included new matter when it was filed, may now be incurably invalid (Decision T1158/01, paragraph 3.2.3).*
- *Freedom to claim subject-matter in a second- or subsequent-generation divisional application may now be constrained by the scope of the claims that were present in the first-generation divisional application (Decisions T720/02 and T797/02, paragraph 2.2 in each case).*

Of particular interest is the explicit statement, in Decisions T720/02 and T797/02 (paragraph 2.3 in each case), that an unconstrained divisional practice – which could in effect equate to a system of US-style continuation applications – would be “obviously unacceptable” in Europe.

→ <http://legal.european-patent-office.org/dg3/pdf/t011158ep1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t020720eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/t020797eu1.pdf>

Other recent decisions have maintained the strictness of the following points of divisional practice in the EPO:

- *The final deadline for filing the divisional application is the day before the date of grant of the patent on the application from which the divisional is filed, with no restoration possible under Article 122 EPC if that deadline is accidentally missed (Decision J7/04).*
- *The identity of the divisional applicant(s) must be exactly the same as the applicant or co-applicants named at the time on the application from which the divisional is filed (Decision J2/01).*

→ <http://legal.european-patent-office.org/dg3/pdf/j040007eu1.pdf>

→ <http://legal.european-patent-office.org/dg3/pdf/j010002ep1.pdf>

In view of the current uncertainty, we recommend that considerable care is taken when planning a divisional program in the EPO. We will, of course, be happy to advise you fully in specific cases.

David Brown – For further information email dbrown@haseltinlake.com

Costs Awarded in EPO Opposition Proceedings

Awards of costs are theoretically possible in European opposition proceedings but in practice are rare. Consequently, it is unusual for parties to request an award of costs, except in cases of obvious procedural abuse.

In case T1/00, EPO Board of Appeal 3.3.7 recently awarded costs in favour of the patentee where the opponent (appellant) had raised a relevant objection, based on prior art which had been mentioned in the patent specification, only at a very late stage in the appeal proceedings. This caused the Board to remit the case to the Opposition Division for further prosecution at the first instance level.

The costs awarded were (a) the actual costs charged by the patentee's European patent attorney in relation to the oral proceedings before the Board of Appeal and (b) the expenses of the expert who attended the oral proceedings on behalf of the patentee.

→ <http://legal.european-patent-office.org/dg3/biblio/t000001eu1.htm>

Ulrich Benedum – For further information email ubenedum@haseltinlake.com

Recent EPO Cases on Novelty

A number of recent EPO Board of Appeal Decisions have explored aspects of the law of novelty relevant to chemical cases.

- In **Decision T1081/01**, the Board held that the legal requirement of Article 54 EPC that the prior art "makes the invention available to the public" means that the mere termination – before the priority date – of a confidentiality agreement in respect of an item of prior art does not constitute an act which makes the prior art available to the public.

→ <http://legal.european-patent-office.org/dg3/pdf/t011081eu1.pdf>

- In **Decision T913/01**, the opponent successfully showed that no explicit or implicit conditions of confidentiality existed in the supply of test data by it to a third party, the data relating to the drying of materials provided to it by the third party for drying in the opponent's machinery. The only explicit confidentiality agreement presented in the evidence related to the transfer of the materials (not the resultant test data), and the evidence contained no indication of any more general obligation of confidentiality between the opponent and the third party. Further, it was held that the opponent could reasonably have been expected to have had a commercial need or desire to publicise data relating to the effectiveness of its machinery. The supplied data were thus made available to the public, and formed part of the state of the art.

→ <http://legal.european-patent-office.org/dg3/pdf/t010913eu1.pdf>

- In **Decision T226/02**, the question arose as to whether ageing of a retained sample of the prior art could have altered its relevant properties before those properties were tested by the opponent for the purpose of the opposition. The Board commented that in such a situation the parties must be prepared to obtain evidence as to the effects of ageing on the sample, and confirmed the well-established principle that, where the evidence of the alleged prior art lies solely in the hands of the opponent, the opponent must present all necessary evidence to establish what was made available to the public before the priority date.

→ <http://legal.european-patent-office.org/dg3/pdf/t020226eu1.pdf>

David Nash – For further information email dnash@haseltinlake.com



DAVID NASH, Partner – Bristol

UK and European Patent Attorney
MA Cantab (Natural Sciences)

Email: dnash@haseltinlake.com
Tel: +44 (0) 117 910 3200

DAVID BROWN, Partner – Bristol

UK and European Patent and Trade Mark Attorney
MA Cantab (Natural Sciences)

Email: dbrown@haseltinlake.com
Tel: +44 (0) 117 910 3200



ULRICH BENEDUM, Partner – Munich

German Patentanwalt, European Patent & Trade Mark Attorney
Diploma-Chemist (Munich), Ph.D in Natural Sciences (Chemistry & Biochemistry)

Email: ubenedum@haseltinlake.com
Tel: +49 (0) 89 6227 1760

DAVID RUSHTON, Attorney – Bristol

UK and European Patent Attorney
B.Sc. Newcastle (Chemistry), Ph.D Newcastle (Chemistry)

Email: drushton@haseltinlake.com
Tel: +44 (0) 117 910 3200



JOHN HUTCHISON, Attorney-in-training

B.Sc. Edinburgh (Chemical Physics)
Ph.D Cantab (Physical Chemistry)

Email: jhutchison@haseltinlake.com
Tel: +44 (0) 117 910 3200

MAGNUS JOHNSTON, Attorney-in-training

B.Sc. Aberdeen (Chemistry with New Materials Technology)
Ph.D Aberdeen (Chemistry)

Email: mjohnston@haseltinlake.com
Tel: +44 (0) 117 910 3200



MARK ROWLAND, Attorney-in-training

BA Cantab (Chemical Engineering)
M.Eng. Cantab (Chemical Engineering)

Email: mrowland@haseltinlake.com
Tel: +44 (0) 117 910 3200

Email hl@haseltinlake.com www.haseltinlake.com

London: Imperial House, 15 – 19 Kingsway, London WC2B 6UD
Tel: +44 (0) 20 7420 0500 Fax: +44 (0) 20 7420 0505

Leeds: West Riding House, 67 Albion Street, Leeds LS1 5AA
Tel: +44 (0) 113 233 9400 Fax: +44 (0) 113 233 9401

Munich: Rosenheimer Strasse 30, D-81669 Munchen, Germany
Tel: +49 (0) 89 6227 1760 Fax: +49 (0) 89 485 686

Bristol: Redcliff Quay, 120 Redcliff Street, Bristol BS1 6HU
Tel: +44 (0) 117 910 3200 Fax: +44 (0) 117 910 3201