

Newsletter

The European Patent Team

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European Divisional Patent Applications

Recent EPO Board of Appeal decisions address important questions relating to European divisional patent applications, in particular “cascading” divisional applications, where the parent of a divisional application is itself a divisional application.

One decision indicates that the presence in a divisional application *as filed* of subject-matter not present in its parent is fatal for any subsequent cascaded divisional. This means that when filing a divisional it should be very carefully considered whether the divisional – especially its claims – might cover subject-matter not clearly present in its parent.

Other decisions indicate that the claims of a cascaded divisional may only cover subject-matter which falls within the scope of the claims of the preceding divisional. This means that, at the time of filing first-generation divisionals, applicants should consider carefully all of the likely subject-matter they may wish to protect by way of divisionals, and either ensure that all of this subject-matter is *claimed* in a single divisional, from which further divisionals may be cascaded, or file a series of parallel, first-generation divisionals directed to each invention.

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Fatal Consequences?

Board of Appeal decision T1158/01 is primarily concerned with “cascading” divisional applications, but contains a comment which raises an issue potentially relevant to all divisional applications. In the case concerned a first-generation divisional application as filed contained subject-matter extending beyond that of the original parent application. According to Article 76(1) EPC, of course, a divisional application “may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed”. The Board of Appeal involved made the following comment: “*As the conditions of Article 76(1) EPC expressly have to be met when the divisional application is filed, and as, likewise expressly, the content of the earlier application as filed has to be taken into consideration, contrary to the appellant’s view it is at least questionable whether the noted deficiency could still have been remedied if it had been noted in good time and if the first-generation divisional had been amended accordingly.*”

This could suggest that, in the view of at least one Board of Appeal, the presence in a divisional *as filed* of subject-matter extending beyond the parent may be a fatal flaw which cannot be remedied by post-filing amendment of the divisional. However, this would be a major re-interpretation of the provisions applying to divisional applications, apparently at odds with earlier decisions which implicitly accept that such a flaw present on filing can be corrected subsequently, and with the Guidelines for Examination of divisionals.

More likely, we believe, the Board of Appeal is pointing out that the flaw in the first-generation divisional *as filed* may still be fatal for a second-generation divisional, cascaded from the first-generation divisional, even if the flaw can be remedied by post-filing amendment so far as the first-generation divisional is concerned.

To be valid, a divisional must inherit the filing date of its parent. Otherwise, the divisional is void. Article 76(1) EPC provides that if the divisional contains subject-matter extending beyond that of its parent, it does not inherit the parent filing date. This means that in the case concerned the first-generation divisional *as filed* failed to inherit its parent filing date. At least up to now, it has not been doubted that the divisional could be amended post-filing to remove excess subject-matter, to enable inheritance of the parent filing date. Beyond this, it appears not to have been doubted that such an inherited filing date, acquired only as a result of post-filing amendment, can in turn be inherited by a second-generation divisional, cascaded from the first-generation divisional.

The Board responsible for the T1158/01 decision now doubts that a filing date acquired by the first-generation divisional only as a result of post-filing amendment can in fact be inherited by the second-generation divisional. This means that if the first-generation divisional *as filed* could not be attributed an inherited filing date, as in the case concerned, there is no possible filing date which the second-generation divisional could inherit, with the result that the second-generation divisional is invalid and void beyond possible remedy.

Cascading European Divisional Applications – Limited Options?

That divisionals may be cascaded – i.e. that the parent of a divisional may itself be a divisional – was once put in doubt. However, it has since been affirmed that the parent of a divisional may be a divisional (for example T555/00, T1158/01 above, and T720/02, T797/02 below). At present there is no reason to believe that any inherent bar excludes cascading divisionals, but recent Board of Appeal decisions suggest that the options for exploitation of cascading divisionals may be more restricted than previously thought.

T1158/01, as discussed above, indicates that if, *as filed*, an earlier divisional in a cascade includes subject-matter beyond that of its parent application, then any divisional later in the cascade may as a result be incurably void.

Merely avoiding excess subject-matter might, however, not be sufficient. Recent Board of Appeal decisions indicate that the subject-matter covered by the claims of a later divisional in a cascade must fall within the scope of the claims of the preceding application in the cascade. If the claims of the later divisional cover subject-matter not covered by the claims of the preceding application, the later divisional is invalid - even if that subject-matter appears in the description of the preceding application.

T1158/01 includes an *obiter* comment which gives a first suggestion that a later divisional is valid only if the subject-matter covered by its claims falls within the scope of the claims of the preceding application: “The Board ... expressed doubts that the second-generation divisional in suit complied with Article 76(1) in relation to the first-generation divisional because although the descriptions of the parent and the first and second-generation divisionals were largely identical, the subject-matter of the second-generation divisional was not included in that part of the parent application which was the subject-matter of the first generation divisional”. Other more recent decisions by the same Board of Appeal – T720/02 and T797/02 – indicate firmly that the matter which can be claimed in a later divisional is dependent upon the subject-matter claimed – not merely described – in the preceding divisional in the cascade: “it is the board’s view that the invention or group of inventions defined in the claims of the parent application as divided out of the grandparent application determines the essential content of the parent application; and therefore to meet the requirements of Article 76 EPC any further divisional applications divided out of the parent application must be directed to objects encompassed by such invention or group of inventions.”

In justification of this view, the Board refers to general principles governing examination of European patent applications, and to public interest considerations, for example: “To allow subject-matter from a grandparent application which was reproduced in the description of a parent divisional application but not encompassed by the invention actually divided out of the grandparent application, to be further divided out of that parent application at a later date would be to allow applicants, by the mere filing of recurrent cascading divisional applications, to leave the public completely uncertain during most of the life of a patent as to how much of the subject-matter of the original patent application might still be claimed. This would indeed pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications.”

Other Recent Decisions Relating To European divisional applications

[1] Last Day For Filing A European Divisional Application:

Rule 25(1) EPC provides that “The applicant may file a divisional application relating to any pending earlier European patent application.” Decision J0007/04 of the Legal Board of Appeal confirms the guidance given by the EPO that a divisional application can be filed after issue of the decision to grant the earlier European patent application, but only up to the day before the mention of grant of the earlier European patent application is published (i.e. not on the day that the mention of grant of the earlier European patent application is published). A European patent application ceases to be “pending” at the end of the day before the mention of its grant is published.

[2] “Time Limit” For Filing A European Divisional Application?:

Decision J0007/04 mentioned above also reconfirms that, under the provisions of the EPC, there is no “time limit” for filing a divisional application (even though – see above - there is a last day on which a divisional application can be filed, which day is known in advance). This decision reconfirms earlier decisions to the effect that if a divisional application is in fact filed after the last permitted day the re-establishment of rights (*restitutio in integrum*) provisions of Article 122 EPC cannot be used to breathe life into that application.

[3] Who Can File A European Divisional Application?:

Decision J0002/01 teaches that, where the parent application stands in the names of joint applicants, the divisional application must be filed in the names of all those joint applicants. Even if the divisional application is directed to an invention the property of only one of the joint applicants, the divisional application must still be filed in the names of all the joint applicants.

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