



Divisional Patent Applications **in the European Patent Office** **Handle with Care!**

In the light of recent developments at the European Patent Office, extra care is needed in the preparation and filing of divisional patent applications at the European Patent Office (EPO).

Divisional Patent Applications - Background

Patent applications often contain subject matter that is directed to more than one invention. However, it is only possible to protect one invention in a single patent. Accordingly, the EPO will raise a non-unity objection against applications having claims that are directed to more than one invention. Therefore, in order to pursue patent protection for additional invention(s) in cases where a patent application receives a well-founded non-unity objection, or possibly for strategic reasons if the applicant wishes to keep some subject matter pending for longer periods, the additional invention(s) may be divided out from the first invention by filing a so-called “divisional” application under Article 76 EPC. Divisional applications can only be derived from a pending patent application. The initial patent application is referred to as the “parent” application and covers the first invention, and the divisional application covers the additional invention(s). Further divisional applications may also be filed as discussed in (2) below.

(1) Validity of Divisional Applications

A divisional application “may be filed only in respect of subject matter which does not extend beyond the content of the earlier parent application as filed; insofar as this provision is complied with, the divisional patent application shall be deemed to have been filed on the date of filing of the earlier application” (Article 76 EPC).

Hence, in cases where the EPO considers a divisional to include added subject matter, established practice is for the EPO to ask the applicant to remove that added subject matter when responding to the first examination report. If the added matter is removed, the divisional application is prosecuted in the normal way. However, if the applicant refuses to remove the added subject matter, then the divisional application is refused. Therefore, under the existing practice of the EPO, if the subject matter of a divisional application, as filed, is later found to include added subject matter over the parent application, then this is rectifiable.

However, recent developments in case law before the EPO have cast some doubt on the current practice of the EPO. Various decisions have issued in which the Appeal Boards were of the opinion that it should not in fact be acceptable to allow an applicant to remove added subject matter from a divisional patent application in order to ensure that the application was validly filed. The decisions state that if a divisional patent application does include added matter, then it has not been validly filed, and moreover, it cannot be remedied by removing the added subject matter. Hence, it would not be possible to

obtain patent protection for the subject matter covered in the claims of such 'invalidly' filed divisionals.

These decisions clearly raise serious concerns as to whether we can rely on the existing practice of the EPO being applied for divisional applications in the event that, during substantive examination, it is decided that the divisional application includes subject matter that goes beyond the content of the parent application.

Because these decisions raise an important point of law, various questions concerning added subject matter and divisionals have been referred to the Enlarged Board of Appeal of the EPO, and these cases are currently pending as G1/05 and G3/06. The EPO has suspended proceedings for any divisional applications whose outcome depends on the result of these decisions.

(2) Cascading Divisionals

In some cases, the parent application, and hence a first divisional application, may contain subject matter directed to further inventions, for which patent protection is also sought. In circumstances where the parent application is no longer pending (eg it is has been granted, abandoned, or refused), it is necessary to file a second generation divisional application from the pending first generation divisional application. The second generation divisional that is derived from the first generation divisional may be referred to as a grandchild divisional, and such consecutive divisional applications are referred to as "cascading" divisionals.

Recent Appeal Board decisions have issued, which question what subject matter may be claimed in a grandchild (and subsequent) divisional patent application. In T797/02, it was held that:-

"The invention or group of inventions defined in the claims of the first generation divisional application as divided out of the parent application determines the essential content of that divisional application. To meet the requirements of Article 76 EPC, any further subsequent divisional must be directed to objects encompassed by such an invention or group of inventions."

Hence, according to T720/02, it is only possible to support a second generation divisional (ie a grandchild divisional application) derived from a first generation divisional on the basis of subject matter contained in the claims of the first generation divisional application. Accordingly, it would not be possible to include in the grandchild divisional claims to any subject matter that is included in only the description of the first generation divisional. This is in complete contrast to existing practice before the EPO in which we would routinely include claims in a grandchild divisional directed to any subject matter for which there was full basis anywhere in the specification of the first generation divisional, for example in the description. The important question of whether the view taken in T797/02 has also been referred to the Enlarged Board of Appeal, and is currently pending as G1/06. Again, the EPO has suspended proceedings for any divisional applications whose outcome depends on the result of this decision.

Our Advice

The EPO will issue a single decision on the topic of divisional patent applications based on the three pending decisions G1/05, G1/06 and G3/06. However, it is possible that we will have to wait at least a year or so before the decision is made. It is difficult to predict what the final decision will be, and for this reason, there is a significant degree of legal uncertainty concerning how the EPO will examine divisionals in future.

However, on 11 July 2006 the President of the EPO sent a letter to the Head of the EPO Enlarged Board of Appeal providing his view on the subject of divisionals. In his letter, the President states that he is of the opinion that the current EPO practice is correct and should be maintained. Thus, a divisional application, including one which includes added subject matter, should be treated like any other European patent application, and should be allowed to be amended at a later stage of the examination procedure, irrespective of whether or not the earlier application is still pending. Moreover, the President believes that a second generation divisional application should be allowed to be directed to aspects not specifically claimed in the first generation divisional.

While the President's opinion is non-binding on the Enlarged Board of Appeal, it may be persuasive. Hence, Adamson**Jones** hopes that current EPO practice will be maintained, that the EPO will not follow these, in our view, 'rogue' decisions, and that there will be no change to the usual EPO practice in respect of divisional patent applications. Nevertheless, in view of these decisions, and because there are currently several options open to our clients when filing divisional patent applications, Adamson**Jones** will advise clients on a case-by-case basis. For example, we believe that extra care should be taken to avoid adding subject matter in divisionals in order to minimise the risk of the divisional being found irretrievably invalid. In addition, particular caution should be taken when drafting the claims of cascading divisional applications. For example, in cases where the parent patent application includes more than one invention (for example, when the description includes multiple statements of invention, which could possibly represent multiple inventions), it may be prudent to ensure that all of the inventions for which patent protection may be desired at a later date are either specifically covered in the claims of a single divisional application that is filed directly from the parent, or that each of the remaining inventions are covered in the claims of separate divisionals filed from the parent whilst the parent is still pending. Either option, we believe, should reduce the risk of losing subject matter for which protection may be ultimately required.

If you have any specific questions about the issues referred to above, then please contact us for a more detailed discussion.

Adamson**Jones**
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NB : The information in this note is for general guidance only, and is not a substitute for professional advice.