

EPO's Enlarged Board of Appeal Decides Important Issues Relating to Divisional Patent Applications

The Enlarged Board of Appeal of the European Patent Office has delivered its keenly awaited decision in Case G1/05 (consolidated with G1/06) on issues concerned with divisional European patent applications.

Background

A "divisional" application is a patent application that is derived from (or "divided out of") an existing ("parent") application in order to obtain grant of claims directed to subject-matter that was disclosed in the parent application, but which is not covered by the claims of that application, for instance because that subject-matter has been deleted from the claims (perhaps in response to an objection of lack of unity of invention) or indeed where that subject-matter, though described in the parent application, has never been claimed in that application. The legal basis for such applications is found in Article 76 of the European Patent Convention. Article 76(1), second sentence states that 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; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application ..."

It has long been the practice of the EPO to allow a divisional application to be amended should it be found during examination that its content went beyond the content of the parent application. This practice had been called into doubt by a Board of Appeal of the EPO, which suggested that non-compliance with Article 76(1) could not later be rectified, and so a divisional application that did not comply with Article 76(1) could not be accorded a filing date and should be treated as if it had never been filed.

The questions before the Enlarged Board

In case G1/05, the following questions were referred to the Enlarged Board:

(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?

Case G1/06 was concerned with sequences of divisional applications (ie the situation in which a divisional application is filed, and then a "divisional of the divisional"). In principle, there is no limit to the number of divisional applications that may exist in such a sequence. The questions referred to the Enlarged Board 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 said divisional be nested within the subject-matter of the claims of its predecessors? or

(b) that all the divisional predecessors of said divisional comply with Article 76(1) EPC?

The Enlarged Board invited the President of the EPO to comment on this issues, and also received a number of *amicus curiae* briefs from interested parties, including several professional bodies whose members represent patent applicants in proceedings before the EPO.

The Enlarged Board's Decision

We are pleased to report that the Decision of the Enlarged Board is favourable to applicants, in that it fully endorses the practices that have hitherto been adopted by the EPO and on which applicants have come to rely.

In particular, in relation to the first question posed in case G1/05, the Enlarged Board held that it is permissible for an applicant to amend a divisional application after that application has been filed, so as to comply with the requirements of Article 76(1) EPC. Thus, an application that does not comply with those

requirements at the time of filing is not irredeemably invalid, but may be corrected. The Enlarged Board went on to state that there is no requirement that the predecessor application should still be pending at the time that amendment is made to correct a non-compliance with Article 76(1). This is important, since the majority of divisional applications are filed shortly before the predecessor application proceeds to grant, and so the predecessor application usually ceases to be pending before there is any substantive examination of the divisional. Finally in relation to Case G1/05, the Enlarged Board held that there are no special limitations or restrictions on amendment of divisional applications. This means that amendments of a divisional application are allowed to the same extent as amendments of any other, non-divisional applications. In response to the specific question put to it, the Board stated unequivocally that a divisional application can be amended in such a way that it claims subject-matter disclosed in the divisional application as filed (as well, of course, as in the predecessor application), but which was not encompassed by the claims of the divisional at the time the divisional was filed.

In its answer to the questions referred in Case G1/06, the Enlarged Board stated that, in the situation of a sequence of divisional applications each having been divided out from its predecessor, the filing date of the first application can be accorded to the subject-matter of a divisional application if, but only if, that subject-matter was disclosed in each of the earlier applications in the sequence and was still present (ie had not been unequivocally and definitively abandoned) in each earlier divisional application at the time the next application in the sequence was filed. In other words, for subject-matter to be validly claimed in a divisional application, that subject-matter must have been continuously present in the sequence of applications at all times up to the date on which the divisional application was lodged.

It follows that any subject-matter that is omitted from a divisional application cannot be reintroduced in a subsequent divisional application.

The Enlarged Board thus answered the first question referred to it in Case G1/06 in the affirmative, and so did not address the second question. The Board noted that its decision leaves available to applicants the possibility of repeatedly filing divisional applications directed to subject-matter on which the EPO has already given a negative opinion, as might be done for instance to create doubt on the part of third parties as to the full extent of patent protection that will ultimately be granted. The Board regarded this as unsatisfactory, but concluded that if such actions are considered to be an abuse of the law then additional procedural measures and/or legislation are required to address the issue.

Practical advice

The Enlarged Board's decision endorses previous EPO practice, and so does not prompt any fundamental changes in the way that divisional applications are handled. However, the Board's remarks in relation to the questions referred to it in Case G1/06 emphasize the importance of the following:

- Whenever any subject-matter is deleted from a European patent application (whether that application is the first European application in a sequence or a divisional), the applicant should reserve the right to reintroduce that subject-matter later and/or to pursue that subject matter by means of one or more divisional applications.
- When a divisional application is filed, care should be taken to ensure that it contains not only all the subject-matter of the parent application that it is envisaged will be claimed in the divisional, but also all subject matter from the parent for which there is any possibility that protection might be sought through a subsequent divisional to the divisional. Obviously, the safest option is generally to ensure that every application in the sequence initially contains the entire disclosure of each preceding application in the sequence. Normal practice when filing a European divisional application is to use the description (and drawings, if any) of the original application with a set of claims specific to the divisional application. Particular care should be exercised to ensure that one does not thereby omit any subject-matter that was disclosed only in the claims of the original application.

Adamson**Jones**
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Important Note : Whilst we have endeavoured to ensure that the information contained in it is accurate, this note is for general information only and does not constitute specific legal advice.