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Divisionals at the EPO - established practice prevails

Summary

The decision of the EPO Enlarged Board of Appeal in combined cases G1/05 and G1/06 has finally been issued. The previously established practice of the EPO in respect of divisional applications has been affirmed, bringing a welcome conclusion to a period of considerable uncertainty.

In brief, the Enlarged Board decided that a divisional application containing subject matter extending beyond the content of the earlier application as filed can validly be amended at a later date to remove the added matter, whether or not the earlier application is still pending. Subject to the rules relating to “unsearched” subject matter, a divisional application can also be directed to any aspect of an invention disclosed in the divisional, whether or not that invention was claimed, either in the divisional as filed or in a preceding parent. If a divisional is filed that is identical to its parent, amendment of the divisional is permitted.

Regarding a sequence of cascading divisionals, the subject matter of a divisional application must be contained in any and all preceding applications from which it is divided. New matter cannot be reintroduced into a divisional of a preceding divisional if it was not in the preceding divisional as filed. Moreover, it is never possible to claim in a divisional matter that has been unequivocally and definitively abandoned, either in connection with that divisional or any preceding application.



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The decision of the Enlarged Board of Appeal of the European Patent Office (EPO) in combined cases G1/05 and G1/06 was finally issued on 28 June 2007. The established practice of the EPO in respect of divisional applications has been affirmed, bringing a welcome conclusion to a period of considerable uncertainty.

The Enlarged Board was asked to decide on several questions relating to:

- i) the amendment of divisional applications whose subject matter on filing of the divisional extended beyond the content of the parent application as filed,
- ii) whether it was necessary for a divisional application in a sequence of successive divisional applications, each divided from its predecessor ('cascading' divisionals) that anything disclosed in that divisional be directly, unambiguously and separately derivable from the disclosure of each of the preceding applications as filed, and
- iii) what could be claimed in a divisional application and whether claims in a second generation application had to be within the scope of claims in a first generation divisional application.

The Enlarged Board decided:

1. A divisional application containing subject matter extending beyond the earlier application as filed is not 'invalid'. As such, there is no such thing as an 'invalid' application. A divisional application can be amended at a later date, just like any other application, to remove added matter so as to comply with that requirement. Only in the case of certain formal defects might a European patent application not be accorded a filing date, but this is something that is apparent immediately on the face of the documents filed, and not something that might only come out at some later date during substantive examination.
2. It was stated that an important principle of the European Patent Convention (EPC) is that "the question whether or not an application complies with the substantive requirements of the EPC is to be decided on the text finally submitted or agreed by the applicant after any objections have been drawn to his attention and he has been afforded an opportunity to comment and also an opportunity to overcome the objection by means of an amendment."
3. "A divisional application is a new application which is separate and independent from the parent application... Therefore an amendment to remove added matter not disclosed in the parent application as filed is allowable irrespective of whether the earlier application is still pending or not."



4. A divisional application is “to be treated in the same manner and subject to the same requirements as an ordinary application.”
5. “Third parties need to be aware that whilst any divisional application is still pending, any of its content as filed may yet be the subject of patent claims either in the divisional application itself, or in further divisional applications.” It was also stated that a divisional can be directed by amendment to aspects of an earlier application also disclosed in the divisional application as filed but not claimed in the divisional as filed.
6. In each of a sequence of cascading divisionals, the subject matter of a further divisional application must be contained in the predecessor application (the immediate parent) at the time the further divisional is filed. Thus, content omitted on filing a member of the divisional cascade higher up the sequence cannot be re-introduced into that member or into later divisional applications.
7. Furthermore no matter can be claimed, whether in a divisional or in a parent application, that has been unequivocally and definitively abandoned by that time.
8. A divisional may be filed that is identical to its parent application. However, double patenting provisions preclude the grant of such a divisional in that form.
9. Interestingly, the Enlarged Board confirmed that there is no corresponding practice under the EPC to the United States practice of Continuation-in-Part applications, where subject matter in the application may have different effective dates of filing. Although claims in a patent application may be entitled to different priority dates under the EPC, when a European divisional application is filed it will either be entitled to the date of filing of the first parent application (by virtue of it not having any subject matter that was not included in each preceding application from which it is divided), or (if not subsequently amended) it will be refused. There is no possibility of a divisional application taking its own date of filing.
10. This leads to the interesting question as to what happens when a new application mistakenly claims divisional status from a preceding application. Presumably correction will be allowed where the mistake is self-evidently a mistake, but perhaps there are situations where it may not be so clear, and care might be required.

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