



DIVIDE AND RULE: EUROPEAN PATENT OFFICE ADDRESSES DIVISIONAL APPLICATIONS

The Enlarged Board of Appeal of the European Patent Office (“EPO”) (the EPO’s highest level of authority) in a long-awaited judgment has just addressed and clarified the status, examination procedures, and scope of European divisional applications, which are patent applications that are “divided out” from an original application after the original application has been filed, but retain the priority date of the original application. There were two separate cases (known as G1/05 and G1/06) considered at the same time by the Enlarged Board. The questions raised by each case were:

G1/05

- (i) Can a divisional application be amended after filing to remove any additional subject matter?
- (ii) Is this so even if the earlier application is no longer pending?

- (iii) Are there any other limitations on the ability to amend a divisional application?

G1/06

- (i) What are the requirements for sequences of divisional applications (*i.e.*, divisional applications of divisional applications)?

The relevant legislation that the Enlarged Board addressed is Article 76(1) of the European Patent Convention (EPC). This states:

A European divisional application must be filed directly with the European Patent Office in Munich or its branch at the Hague. It may only be filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed; insofar 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 and shall have the benefit of any right to priority.

The Enlarged Board's key findings are:

- A divisional application will not be declared invalid as a result of noncompliance with Article 76(1) at the time of filing and amendment is permitted during examination to make the divisional application conform (G1/05).
- Amendment to make a divisional application conform with Article 76(1) is permitted even if at the time of amendment the earlier application from which the divisional application is derived is no longer pending (G1/05).
- Amendments to divisional applications are not subject to any further limitations. Specifically, a divisional application can be amended to cover aspects of the earlier application which were also disclosed, but not claimed, in the divisional application as filed (G1/05).
- For a sequence of divisional applications, the subject matter disclosed in a divisional application must be directly and unambiguously derivable from the technical content of each of the preceding applications in the sequence as filed. There is no requirement for the subject matter of a divisional to have been claimed in the preceding applications (G1/06).

BACKGROUND

These two cases have provoked great interest, addressing as they do fundamental issues relating to the scope of divisional applications. The Enlarged Board invited the President of the EPO to comment and received briefs (as *amicus curiae*) from professional bodies; the Institute of Professional Representatives before the EPO, the Fédération Internationale des Conseils en Propriété Industrielle, and the Chartered Institute of Patent Attorneys all made submissions.

DETAILED FINDINGS

On the question of amendment (G1/05), the Enlarged Board found:

1. There was no justification for the proposal that a divisional application that did not comply with Article 76(1) on filing was invalid. Drawing support from the EPC itself, the Travaux Préparatoires (the negotiations that led to the EPC) and expressly distinguishing an old UK case (*Hydroacoustics Inc's Applications* [1981] FSR 538), the Enlarged Board confirmed that divisional applications are no different from ordinary applications and should be subject to the same requirements for grant. It is an important principle (which applies to all applications, including divisional applications) that whether an application complies with the substantive requirements for grant is on the text finally submitted after objections during examination have been addressed or have been overcome by amendment, which is specifically permitted by Article 123 of the EPC. This means that compliance with Article 76(1) is a matter for the Examination Division, not the Receiving Section. Put simply, the result is that amendment of a divisional application during the examination process is permitted.
2. Following a previous decision of the Enlarged Board (case reference G4/98), a divisional application is a separate and independent application from its parent. This means that amendment is allowable irrespective of whether the earlier application is still pending or not.
3. Because a divisional application is taken as a separate and independent application, it follows also that there are no limitations on the right to amend that are specific to a divisional application, and a divisional application is treated in the same way as an ordinary application. This includes the ability to amend the claims of a divisional application to aspects of the earlier application also disclosed in the divisional application, but not claimed in the divisional application as filed.

On the question of the requirements for a divisional application when it is part of a sequence of divisional applications (G1/06), the Enlarged Board found:

1. While Article 76(1) is not expressly worded to permit divisionals of divisionals, it does not prohibit them, and this was construed as sufficient to permit them. But, as it awards divisionals (through a legal fiction) the filing date of the originating application, subject matter of a divisional must be in the “total technical information content of the disclosure” of each application in the chain as filed (and still be present in each at the time the next divisional application is filed). There is not, however, a requirement that the subject matter of a divisional be contained in the claims of the preceding applications. This results in two consequences. First, content that was omitted on filing a divisional higher up the sequence cannot be reintroduced later on. Secondly, all divisional applications must relate back to a disclosure in the originating application. A divisional application cannot claim just part of the way back up the chain.

THE RESULT

The Enlarged Board’s decision is favorable to patentees and provides much-needed clarification on the status of divisional applications. Most importantly, for pending and future divisional applications, amendment during examination to cure an added matter objection is permitted, in the same way that it would be for an ordinary application. The clarification on the extent of the disclosure to be considered when looking at the question of added matter for cascading divisional applications is also important, and the express refusal to limit the disclosure to the claims of the parent allows greater scope for creative use of divisional applications when considering a patenting strategy.

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