

## POTENTIAL PROBLEMS WITH THE FILING OF EPO DIVISIONAL PATENT APPLICATIONS

There is a possible change to the European Patent Office's practice regarding divisional applications. Although we hope that the current practice will not change or, if it does, that the change is not retroactive, we are recommending certain procedures in order to safeguard applicants' rights.

### *Background*

Under Article 76(1), an EPO divisional patent application should not contain subject matter that was not disclosed in the parent application as originally filed.

- If a divisional application is found to contain such added subject matter, it has been possible to amend the application in order to correct the problem.
- EPO Board of Appeal 3.4.2 has now recently decided (in Decision T39/03) that this represents a misinterpretation of the European Patent Convention and that, if a divisional application contains added subject matter, it should be refused a filing date. By the time that the defect is discovered, it would usually be too late to file a replacement divisional application.
- However, in recognition of the fact that their interpretation of the EPC is controversial, they have referred the question to the Enlarged Board of Appeal (EBA) for a definitive ruling. The EBA is unlikely to make such ruling in less than a year. In the meantime, applicants have to recognise (i) that the EBA might agree with Board 3.4.2 and (ii) that the EBA's decision *might* be retroactive.
- The apparently sensible precaution of filing the divisional as an exact copy of the parent specification, and then filing a preliminary amendment, is not permitted under the EPC; an application cannot be amended until the search report has been issued. Hence, it can be impossible to present claims to the subject matter that one wishes to be searched. However, if the subject matter has not been searched, then it cannot be pursued in that application.

### *EPC's advice*

We consider that it is unlikely that, even if the EBA agrees with Board 3.4.2, they will make the decision retroactive. However, as noted above, we cannot exclude the possibility. We are therefore recommending to our clients the following two options:

Option 1: a divisional application is filed in the usual way but the amended claims are scrutinised extremely closely, preferably by two of our European patent attorneys, in order to be as sure as possible that no subject matter is being added.

Option 2: if there is any appreciable risk that the amended claims could be considered to add subject matter, and this cannot be avoided without defeating the object of filing the divisional, then a parallel divisional application is filed which is an exact copy of the parent application. Hence, if the amended application is considered to contain added subject matter, and is therefore denied a filing date, at least there is still a pending application which might be amended or from which a further divisional application could be filed.

EPO divisional applications are already expensive, often because of an accumulation of back renewal fees. The increased scrutiny in Option 1, particularly if it involves a second professional opinion, will increase costs. However, we consider that these costs are necessary and justifiable. Option 2, of course, is even more expensive, since it involves two divisional applications. However, in some circumstances, the cost of Option 2 may be justifiable in order to maximise the possibility of obtaining protection for the subject matter in question.

We hope that the present situation will be resolved as quickly as possible, with the EBA deciding that the former/existing EPO practice can continue. However, in parallel, we are lobbying the EPO in order to try to change the Convention so that an application can be amended (within a defined period after filing) before the search report is issued. This could be beneficial even if the EBA decision is adverse.

Please contact Richard Bassett for further information.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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