

EPO DIVISIONAL APPLICATIONS: THE ENLARGED BOARD CONFIRMS FORMER PRACTICE (DECISIONS G 1/05 AND G 1/06)

Background

In an earlier newsletter (November 2005), we reported on case law developments that sought to introduce changes into the practice of the European Patent Office in relation to divisional patent applications. In Decision T 39/03, it was held that a divisional application containing added subject matter should be refused a filing date; the existing practice of allowing amendment to excise the contentious subject matter was deemed a misinterpretation of Article 76 EPC (which governs the filing of divisional applications). In Decision T 1409/05, which addressed the issue of cascading divisional patent applications, it was held that the claims of a second or further generation divisional application must be limited to subject matter *claimed* (not just disclosed) in the immediate parent application. Both these decisions were issued by the same Technical Board of Appeal (Board 3.4.2).

In recognition of the fact that its interpretation of the EPC was controversial, Board 3.4.2 referred Decisions T 39/03 and T 1409/05 to the Enlarged Board of Appeal for a definitive ruling on the points of law raised (as G 1/05 and G 1/06, respectively). The Enlarged Board subsequently decided to consolidate both referrals. A further referral, G 3/06, was also consolidated with G 1/05 and G 1/06 but later terminated following the withdrawal of the parties from their appeals.

The decision of the Enlarged Board in G 1/05 and G 1/06

On 28 June 2007, the Enlarged Board issued its decision in consolidated cases G 1/05 and G 1/06. The main points of its decision are as follows:

- Where a divisional application is filed containing added subject matter, amendment of the application to excise such matter is permissible (providing that the amendment complies with the other requirements of the EPC).
- Such amendment is allowable irrespective of whether the parent application is still pending.
- Thus, the Enlarged Board did not agree with the interpretation of Article 76 EPC put forward in Decision T 39/03 that divisional applications containing added subject matter should be refused a filing date.
- With respect to cascading divisional applications, the Enlarged Board held that there was no general requirement in the EPC for the claims of a second or further generation divisional application to be limited to subject matter claimed (not just disclosed) in the immediate parent application.

- In determining allowable claim scope of cascading divisional applications, it is simply necessary for the relevant subject matter to have been disclosed in each of the preceding applications on filing and to have been present (*i.e.* not unequivocally abandoned) in the immediate parent at the time of filing the divisional application in question.
- Thus, the Enlarged Board also did not agree with the interpretation of the EPC put forward in Decision T 1409/05.

In reaching its decision, the Enlarged Board emphasised the general principle that divisional applications should be treated in the same manner as ordinary applications unless specific provisions of the EPC require something different. As an example of such specific provisions, the Enlarged Board highlighted that the effective filing date afforded to a divisional was the filing date of its original parent application.

Our advice

It would appear that common sense has prevailed and the Enlarged Board of Appeal has restored former practice in relation to European divisional applications; the maverick Decisions T 39/03 and T 1409/05 may now be ignored.

However, we continue to recommend that care be taken to include all of the relevant content of the parent application, including the subject matter of the original claims, when filing a divisional application. This is important for that divisional application itself and for any subsequent divisional application for which it might serve as a parent application.

Please contact your usual contact at Eric Potter Clarkson 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 LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

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