

QUESTIONS AND ANSWERS RELATING TO DIVISIONAL APPLICATIONS AT THE EPO

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What is the time limit for filing a divisional application?

The applicant may file a divisional application relating to any pending earlier European patent application (see Rule 25(1) EPC). Since a European patent application is pending until the application is granted, the time limit for filing the divisional application is one day before publication of grant of the application. The European Patent Office informs the applicant of the date of grant of the parent application.

In the case of a decision rejecting the application by the Examining Division, it is possible to file a divisional application after having filed an appeal against this decision.

What is the deadline for requesting examination for a divisional application?

A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European Search Report (see Article 94(2) EPC).

Is it possible to file a divisional application with the same claims as those of the parent application?

A divisional application must satisfy the requirements of Article 76(1) EPC, second sentence, according to which it may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed. The filing of a divisional application with the same claims as the parent application does, in

principle, not contravene this requirement. Therefore, it is possible to file a divisional application with the same claims as those of the parent application unless the claims of the divisional are directed to subject-matter which was expressly abandoned in the parent application (see decision J 15/85). Even expressly abandoned claims may be reinstated in a divisional application under exceptional circumstances, namely if the filing of a divisional application was the real intention during the abandonment (see decision T 910/92).

It is, however, not possible to proceed in the parent and divisional applications with the same claims. In this respect, it is set out in the Guidelines for Examination in the EPO, Part C-VI, 9.1.6, that *“the parent and divisional applications may not claim the same subject-matter (see IV, 6.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B, respectively, which function in combination, one of the two applications may also include a claim for A plus B”*.

In the above mentioned Chapter IV, 6.4 of the Guidelines for Examination in the EPO, it is noted regarding double patenting that *“the European Patent Convention does not deal explicitly with*

the case of co-pending European applications of the same effective date. However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States (by confirming the designation through payment of the relevant designation fees) and the claims of those applications have the same filing or priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.1.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant”.

If in response to a double patenting rejection subject-matter from the specification is inserted into the claims, the Examining Division may object that the claimed subject-matter relates to unsearched subject-matter contrary to the requirements of Rule 86(4) EPC. Whether such subject-matter can then be further pursued in a (second) divisional application derived from the (first) divisional application is at present uncertain, as will be discussed below.

Summarizing the above, it is possible to file a divisional application with the same claims as the parent application, but the claims have to be amended later during the examination proceedings in order to be distinct in scope and directed to different inventions.

Is it possible to amend the claims of a divisional application before substantive examination begins?

Rule 86(1) EPC states that “before receiving the European Search Report the applicant may not amend the description, claims or drawings of a European patent application except where otherwise provided”. In other words, before receiving the European Search Report, the claims may only be amended upon request of the EPO in order to remedy certain deficiencies (see Rule 41 EPC).

Further, Rule 86(2) EPC stipulates that “after receiving the European Search Report and before receipt of the first Communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings”.

In summary, it is possible to amend the claims of a divisional application before substantive examination begins, but only after receipt of the European Search Report.

Can a divisional application include new claims that were not submitted in the parent application and at what point in time do the requirements of Article 76(1) EPC have to be met?

The filing of new claims in a divisional application is governed by Article 76(1) EPC, according to which the 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 other words, any subject-matter which is directly and unambiguously derivable from the parent application as filed may be claimed in the divisional application.

This finding may also be deduced from Rule 86(4) EPC (in combination with the Guidelines for Examination in the EPO, Part C-5.2(ii)) according to which it may be necessary to pursue *unsearched* subject-matter in a divisional application. The claimed subject-matter of a parent application belongs generally to the *searched* subject-matter so that it can be concluded from Rule 86(4) EPC in

combination with the above-mentioned passage of the Guidelines that a divisional application may contain claims directed to subject-matter not claimed in the parent application.

With respect to the point in time when the requirements of Article 76(1) EPC have to be met, it is noted in the Guidelines for Examination in the EPO: *“If a divisional application as filed contains subject-matter additional to that contained in the parent application as filed and the applicant is unwilling to remedy this defect by removal of that additional subject-matter, the divisional application must be refused under Art. 97(1) due to non-compliance with Art. 76(1)”*. This expresses the established practice of the EPO to allow the applicant at any later stage of the examining procedure to amend the divisional application so that it meets the requirements of Article 76(1) EPC.

However, the Guidelines for Examination in the EPO are not binding for the Boards of Appeal. In decision T 1158/01 issued in 2004, a Board of Appeal expressed reservations in this respect, noting the following: *“As the conditions of Article 76(1) EPC expressly have to be met when the divisional application is filed, and as, likewise expressly, the content of the earlier application as filed has to be taken into consideration, [...] it is at least questionable whether the noted deficiency could still have been remedied [if it had been noted in good time and] if the first-generation divisional had been amended accordingly”* (see item 3.2.2 of the Reasons for the decision).

Thereupon, the following questions were referred to the Enlarged Board of Appeal (pending as G 1/05) in decision T 0039/03:

(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?

As long as these questions have not yet been decided upon it is recommendable, when filing new claims in a divisional application, to observe the requirements of Article 76(1) EPC at the time of filing the divisional application, as it is at present uncertain whether a later removal of additional subject-matter will be accepted by the EPO.

A (second) divisional application can, furthermore, also be filed for an earlier (first) divisional application. In this case, it is at present uncertain whether the claimed subject-matter of the second divisional may extend beyond the claimed subject-matter of the preceding first divisional as filed (see decision T 1409/05).

Therefore, the following question was referred to the Enlarged Board of Appeal (pending as G 1/06):

- (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 divisional predecessor?

or

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

Finally, regarding amendments during opposition proceedings, the following question was referred to the Enlarged Board of Appeal (pending as G 3/06) in decision T 1040/04:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfill said requirements?

The referral to the Enlarged Board of Appeal pending under Ref. No. G 3/06 has been consolidated with G 1/05 and G 1/06. It remains to be seen how the Enlarged Board of Appeal will decide on the respective questions.