

Divisional Applications – A Decision Approaches...

In a Decision of August 2005 (T39/03), the Technical Board of Appeal (TBA) referred a number of questions to the Enlarged Board of Appeal (EBA) relating to the filing of Divisional Applications. These questions are currently pending before the EBA under G1/05.

On 9 May 2006, the EBA decided to consider the questions referred to it under G1/05. Their deliberations were interrupted due to a dispute as to partiality of one of the members of the EBA. The findings of the EBA on this point were subsequently issued in an interlocutory decision on 7 December 2006. This issue of partiality has now been resolved. We therefore expect a decision on the main referral to be issued in the next few months.

The questions were referred because the TBA disagrees with the present practice of the European Patent Office (EPO) on amendments which are allowable in respect of divisional applications.

According to the EPC, a divisional application may only contain subject matter which is in the parent application as filed. Previously, EPO practice has been to allow the applicant to remove, from a divisional application, any offending additional subject matter, after filing. However, in the Decision T39/03, the TBA decided that a divisional application containing added subject matter is an invalid application from the start and therefore removal of the added subject matter after filing cannot save the application. The TBA felt that the current EPO approach is too relaxed. They indicated that, in their opinion the only case in which such a divisional application should be allowed to be amended after filing is when the parent application is still pending when the correcting amendments are filed.

The EBA are considering which of the two approaches is correct. Because the decision by the EBA will be binding on the EPO, any examination or opposition proceedings which concern a divisional application and whose outcome is entirely dependent on the outcome of the decision of the EBA, can be suspended pending the outcome of this decision, at the request of one of the parties - not automatically – and at the discretion of the relevant body of the EPO.

In the meantime, we recommend that any divisional application filed at the EPO uses the same text as the parent. This will be certain to avoid any inadvertent addition of subject matter.

However, if the applicant wishes to pursue alternative subject matter, which is only contained in the description of the parent application as filed, consideration should be given to filing a second divisional application, one of the two divisional applications containing the newly claimed material from the original description, the other using the same text as the parent application. This is because, for such subject matter to be in the claims of the granted divisional patent, it must be contained in the claims of the application as filed. In doing so there is always a risk that the new claims are held somehow to add matter to the disclosure of the parent application. Thus, the divisional application mirroring the parent application will act as a back-up, albeit an expensive one. A decision on which divisional application to pursue can be made once the outcome of the EBA case is known.