

Divisionals – a danger to themselves?

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Recently, some UK patent attorneys put forward a theory that they called "poisonous divisionals". Their theory was that a divisional patent application could be used to invalidate its own parent.

The basis for their argument lies in the rules on overlapping European patent applications. Under European patent law, documents which can be used to attack a given European patent application includes any European patent application which has a filing date before, but a publication date after, the filing date of the given application. Those "intervening" applications are only available for an attack of lack of novelty.

The, somewhat torturous, theory relies on a patent claim only having a single earliest - priority - date. Whether this is correct, or whether a claim can have multiple priority dates, remains open to debate.

The attorneys foresaw a situation where a broad claim of a parent patent was not entitled to the earliest priority date. They argued that, if a divisional application disclosed subject matter which was entitled to the priority date, and fell inside the broad parent claim, the divisional application was an "intervening application" - the subject matter had an earlier effective filing date than the parent, even though it was published long after the parent - and could be used to attack the novelty of the parent claim.

The attorneys' theory provoked fierce debate in the UK profession, but was seen as a somewhat academic exercise. Most attorneys did not believe that the Patent Offices and Courts would seriously apply the principle. Unfortunately, a Board of Appeal at the European Patent Office (EPO) appears to have done so.

The Board of Appeal, in decision T1496/11, found a parent application anticipated by its own divisional. The example of the divisional application claimed priority but the broad claim of the parent patent, within which the example fell, could not. The Board found that the example in the divisional application anticipated the broad claim of the parent patent.

This decision has caused concern throughout the profession. If it becomes established practice at the EPO, any divisional application with a priority - claiming example is potentially fatal for its parent. Once the divisional application is published, the applicant cannot remedy the situation.

There are reasons why we believe that the EPO might not follow this case.

We have heard informally that many EPO examiners do not agree with the Board. This is partly because the Board did not give the broad claim partial priority. If a divisional application and a parent application share the same subject matter then, if the claim is allowed partial priority, that subject matter cannot anticipate the claim. The portion of the claim covering the subject matter has the same priority date as the divisional application, and the divisional ceases to be an "intervening publication".

Furthermore, on a fundamental level, the EPO believes that the divisional and parent applications are linked, under the European Patent Convention, and it is inequitable to cite one against the other.

We wonder whether the Board took this decision, possibly with the agreement of the patentee, solely to provoke the EPO to refer the issue to the Enlarged Board of Appeal, for a definitive answer.

For the time being, the practice of the examining divisions remains the same, and most will not cite divisional applications against parent applications. Of course, the same cannot be said for opponents, and it now seems that some Boards of Appeal are willing to entertain such an attack.

We recommend that applicants take care when considering filing divisional applications, and take steps to delay the prosecution of those divisional applications while the European Patent Office formulates an agreed practice on this "poisonous divisional" issue.

Update

Regrettably, almost 2 years on, the situation remains unresolved. More worryingly, other Boards of Appeal have followed T1496/11 in deciding that the "poisonous divisionals" argument is valid. As a result, opponents are increasingly using the technique to attack any patent with a corresponding divisional application.

We have learnt that, internally, the EPO is split. A number of EPO lawyers believe that the approach is justified by the precise wording of the European Patent Convention. However others, including many examiners, are uncomfortable with the argument, primarily because of the intimate relationship between the two applications. Such examiners (who also sit on opposition divisions) are happy to be given a reason not to follow the argument. Many look for patentees to cite a Board of Appeal decision, T1222/11.

The fundamental assumption which gives rise to the whole argument underlying "poisonous divisionals" is, as stated above, that a claim can have only one priority date unless it contains two distinctly defined embodiments, which may be given different dates. T1222/11 challenges this view and argues that the two embodiments need not be distinctly defined to be given different dates.

Under the reasoning of T1222/11, the parent claim can have two dates. The part of the claim covering the disclosure of the divisional application takes the priority date (meaning that the divisional cannot be cited against it) and the remainder of the claim takes the filing date (against which the divisional can be cited, but cannot anticipate). This simple approach avoids the difficulty of divisionals being fatal prior art against their parent.

We have also heard, very informally, that at least one Board of Appeal is considering referring the issue to the Enlarged Board of Appeal, for a final decision on the matter. We very much hope this happens, as the current uncertainty does not benefit the patentees, the opponents or even the EPO itself.