

An antidote to toxic divisionals?

For the past few years, opponents have started to use a divisional patent application in an attempt to invalidate its own parent.

Under European patent law, documents which can be used to attack a European patent application include 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 opponents argue that a broad claim of a parent patent is not entitled to the earliest priority date. They argue 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.

This practice has, ironically, divided the European IP world. It has caused concern throughout the profession, because potentially any divisional application with a priority-claiming example is fatal for its parent. Once the divisional application is published, the applicant cannot remedy the situation.

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.

The practice relies on a patent claim only being allowed a single priority date. The practice of assigning a single priority date to any one claim is, in turn, based on interpretation of a phrase in a decision (G3/91) of the EPO Enlarged Board of Appeal, the highest judiciary body in the European patent system.

Recent Board of Appeal decisions have challenged the accepted interpretation of G3/91, in a way that allows the problem of such "toxic divisionals" to be avoided.

As a result, one Board of Appeal has referred the issue to the Enlarged Board of Appeal, for clarification on the matter.

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The Board has not yet formulated the questions it wants the Enlarged Board to answer, and it is likely to be at least a year until the Enlarged Board decides, but we are delighted that there is clear progress to resolve the situation.

We look forward to the final clarification of this troubling issue.