

Filing divisional applications in Europe: a dangerous hobby?

The EPO Boards of Appeal have recently considered a series of important issues relating to divisional applications

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In the United States, it is quite common for applicants to file one or more divisional or continuation applications for important technological developments. To that end, patent attorneys sometimes try to draft new claims in a still pending application that may read on products already on the market from competitors and file these claims in such a divisional or continuation application. The parent application of the divisional or continuation application may itself be a divisional or continuation application.

The great advantage is, of course, that one sees the competitor's product and one can seek the proper words from the description or drawings, and try to map a new claim on the existing product. Of course, also in the United States, care should be taken not to extend the subject matter of the application as originally filed. However, the United States Patent and Trademark Office (USPTO) is, in practice, rather flexible.

The European Patent Office allows divisional applications to be filed from a pending patent application, although the concept of continuation applications, whereby the USPTO allows subject matter to be added, is missing in Europe. But by filing one or more divisional applications from a divisional application in a sequence, it seems that some European patent applicants are attempting to copy the United States continuation application practice. However, adding subject matter is not allowed: the European Patent Office (EPO) has always been stricter in its requirements as to extension of subject matter than the USPTO.

In recent decisions of the Boards of Appeal (BoA) of the EPO, very important questions of law as to divisional applications have been referred to the Enlarged Board of Appeal (EBoA). This article discusses and explains these questions. Moreover, some issues not addressed by the BoA's will be addressed.

Questions referred to EBoA in decision T39/03

In decision T39/03, dated 26th August 2005, BoA 3.4.2 decided to refer several questions of law to the EBoA and these questions are now pending as G1/05. Basically, the main question addressed by T39/03 is: "Is a divisional application containing added matter on the date of filing a valid or invalid application and can it be corrected during proceedings before the EPO, even if the parent is not pending anymore?"

BoA 3.4.2 had already dealt with some other issues relating to divisional applications in earlier decisions T720/02 and T797/02. These were issued the same day and have largely the same content.

In T720/02, the BoA was confronted with the following situation. The decision under appeal related to a patent application that itself was a divisional application from an earlier application (the parent application), where the parent application itself was in turn a divisional application from a still earlier application (the grandparent application). The examining division examining the application had decided that the application contained an extension of subject matter as the main claim was missing a feature that had been presented consistently as being essential.

With reference to earlier decision

T1158/01, this BoA concluded that the EPC does allow the filing of a divisional application from an earlier application that itself is a divisional application. However, the issue discussed at length in T720/02 was the time limit for filing a divisional application from another divisional application. The BoA referred to Rule 25(1) EPC which reads as follows: "The applicant may file a divisional application relating to any pending earlier European patent application."

Afraid of the possibility of filing an almost endless chain of divisional applications, something that would leave the public in great uncertainty as to which potential rights are outstanding, the BoA observed that Rule 25(1) establishes the time period in which all possible divisional applications should be filed (ie, all possible divisional applications from a parent application can be filed only while the parent application is pending). In the Board's view, it should be evident to the public which other inventions will be claimed by the applicant of the parent application before it is granted. Any other solution would be detrimental to the public interest: "By the mere filing of recurrent cascading divisional applications, to leave the public completely uncertain during most of the life of a patent as to how much of the subject-matter of the original patent application might still be claimed. This would indeed pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications."

The BoA even expressly denounced the current US system in this respect: "The obviously unacceptable consequences of the position advocated by the appellant, which in effect would result in the setting up of a system of 'continuation applications' of the type explicitly provided for in the US patent law, but for which there is no basis in the [European Patent] Convention."

Therefore, the BoA decided that, in order for a divisional application of which the parent application is itself a divisional application to meet the requirements of Article 76 and Rule 25(1) EPC, it must be directed to an object that is already claimed in the parent application. In other words, a first divisional must contain in its claims all subject matter that is eventually to be divided from an application.

Interestingly enough, the BoA expressly stated that this view was so obvious that it concerned a referral to the EBoA as unnecessary.

In T39/03, the same BoA supported its earlier views as expressed in T720/02.

However, the essential issue here was related to another legal problem of divisional applications. In T39/03, the decision under appeal related not to a divisional from a divisional application, but to a first generation divisional application. Again, the problem was that the examining division was of the opinion that a feature that was presented in the earlier application as being essential was missing from the divisional claims such that they contained added subject matter. The BoA supported this point of view.

However, the BoA raised the issue that it may well be that this cannot be corrected anymore in proceedings before the EPO since Article 76(1) requires: "A European divisional application must be filed directly with the European Patent Office in Munich or its branch at The Hague. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority."

The BoA considered Article 76(1) to imply that, if the requirements of Article 76(1) are not met, the divisional application cannot be afforded a filing date and is, therefore, invalid.

In its decision, the BoA devoted much attention to the consequences of this line of reasoning to chains of divisional applications: if in a chain of divisional applications an intermediate application turns out to be invalid due to being filed inclusive of added subject matter, all the divisional applications being filed after this intermediate application and being (in)directly dependent upon this intermediate application should be considered "invalid" too.

Understanding the great legal consequences of this reasoning for many applicants and patent proprietors, the BoA decided to refer the following questions to the EBoA:

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?

Note that the last portion of question 3 (“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?”) seems a little strange. If it asks for an express denial of the option to change the original subject matter of the divisional application to subject matter not forming unity of invention with this original subject matter, there seems to be no way of getting a positive answer. There is no way claims in a pending application in Europe can be substituted by a set of claims that are directed at a different invention. Maybe this portion of question 3 is an attempt to smuggle a question relating to chains of divisional applications into the referral, in the sense that it requests the EBoA to give an opinion about whether a first divisional should already claim all subject matter that should be divided out of the parent application (a question that could not expressly be asked since the case at hand was not about a divisional from a divisional application).

Questions referred to EBoA in decision T1409/05

In T1409/05, BoA 3.4.03 found several issues where it had great difficulty in supporting the point of view expressed in earlier decisions such as T720/02 and T39/03.

T1409/05 dealt with a situation where a divisional was filed from a parent application that itself was also a divisional application. So, it could officially raise all issues dealt with by BoA 3.4.2 both in T720/02 and in T39/03. And so it did.

For deciding whether a divisional application contains added subject matter which is not allowed by Article 76(1), T1409/05 refers to still earlier case law. This earlier case law has consistently shown over the years that “content of the application” as referred to in Article 76(1) is to be interpreted as “the total technical information content of the disclosure”, including claims and description. So, its conclusion is that Article 76(1) does not provide any basis for the point of view that a divisional application of a divisional application can be directed only to subject matter already claimed in the

parent application. Any support, even in the description or drawings, in any earlier application is enough.

Moreover, it concluded that public uncertainty as to when subject matter is divided from a pending application (that itself may be a divisional in a chain of divisional applications), possibly resulting in misuse or unfairness, is no legal concept. It even observed that uncertainty is inherent to the patent system where applications remain secret for a period of 18 months after the first priority date!

As to whether a divisional application can be declared invalid due to the application containing added subject matter in view of its parent, as defended in T39/03, this BoA has no doubts whatsoever: “There is no basis in the EPC for the concept of an “invalid” application and it does not seem appropriate to draw legal consequences from the perceived properties of non-existent legal categories. In fact, the terms ‘valid’ or ‘invalid’ do not occur in the EPC.”

So, the conclusion of this BoA is that every pending application should have been accorded a filing date. In its view, the requirements of Article 76(1) are mere requirements for grant (ie, the legal consequence of not meeting the requirements of Article 76(1) is that the application shall not be allowed to proceed to grant). The requirements of Article 76(1) are, thus, similar to requirements such as novelty and inventive step.

So, according to this BoA, a divisional application cannot become simply invalid due to one of its predecessors in a chain of divisional applications being invalid for being filed with claims that contained added matter relative to one or more earlier applications in the chain.

In fact, the legal remedy to all uncertainties as referred to by these earlier BoA decisions seems to be straightforward for this BoA: just check whether any subject matter is “smuggled in” in a divisional application by comparing its content with all earlier applications in the chain as filed: “On this board’s interpretation it would suffice for compliance with Article 76(1) EPC that what is disclosed in the application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed.”

Even though this BoA based its interpretation on well-established case law, it recognised the conflicts with the reasonings of several recent other decisions, and it referred the following questions of law to the EBoA:

1. *In the case of a sequence of applications consisting of a root (originating) application followed by a 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 predecessors? or*
 - b. *that all the divisional predecessors of said divisional comply with Article 76(1) EPC?*

Question referred to EBoA in decision T1040/04

In the last decision to be discussed here, T1040/04, BoA 3.2.03 had to decide about a case where it had found that a patent opposed in opposition proceedings contained extended subject matter in its description (so, not in its claims). This BoA recognised that this situation could result in similar questions as those referred to the EBoA in T39/03. However, the BoA also recognised that in view of T39/03, the EBoA would most probably not deal with granted patents in opposition proceedings. Therefore, in order to avoid the risk of obtaining a decision of the EBoA that did not deal with this situation, in T1040/04 BoA decided to refer the following question to the EBoA: "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 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 fulfil said requirements?"

Still open issues not referred to EBoA

In the writer's view, in T1409/05, the BoA has missed at least two issues that could have been referred to the EBoA:

- As indicated above, this BoA concluded: "On this board's interpretation it would suffice for compliance with Article 76(1) EPC that what is disclosed in the

application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed." However, this is not exactly the same as what is required by Article 76(1), which says: "It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed." So, Article 76(1) seems to allow a test of extension of subject matter relative only to the direct parent application and not to each earlier application. Of course, a test relative to all earlier applications is much better from a legal point of view (no one can smuggle subject matter into the description of a divisional and then later claim it in a divisional from that divisional anymore), but it would have clarified things if this issue had been referred to the EBoA too.

- In T1409/05, the BoA states that the EPC does not define valid or invalid patent applications. Thus T1409/05 concludes that the requirement of Article 76(1) that the divisional "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed" cannot result in invalid patent applications. Thus, the BoA concludes that the filing date is the filing date of the parent application.

However, Article 76(1) seems to support another possible interpretation as it also states: "In so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority." So, in the writer's view, not meeting the requirement of avoiding extension of subject matter can also result in the observation that the claim of the application of being a divisional application is not granted. Then, the sanction would be that the effective filing date is not the filing date of the parent application but the actual filing date with the EPO. Of course, if correction is allowed during prosecution, this can be corrected (like an improper claim of priority due to extension of subject matter can be corrected during prosecution).

Of course, this interpretation would result in other problems:

1. the parent would become prior art to the application where the parent may provide serious inventive step problems;

2. moreover, this interpretation would introduce similar problems as encountered in the analysis made in T720/02: a divisional application from an earlier divisional application could all of a sudden lose its effective date if the earlier divisional application turns out to contain added matter. This problem can still be present after all divisional applications in a chain of applications have been granted, resulting in great legal uncertainty for patent proprietors.

Thus, bearing all these uncertainties in mind and being unsure about what the EBoA is going to decide, the writer's advice would be the following: if one is considering protecting more than one other invention than the one already claimed in a patent application, either file a separate divisional application per separate invention within the time limit prescribed by Rule 25(1) or file one divisional application with separate sets of independent claims per invention within that time limit.