

## Enlarged Board of Appeal Decisions G1/05 & G1/06 on Divisional Patent Applications

The Enlarged Board of Appeal of the European Patent Office has handed down an important decision clarifying the requirements for filing a valid divisional application in the European Patent Office.

### Background

The Enlarged Board decision, handed down in conjoined proceedings under numbers G1/05 & G1/06 after referrals by two Technical Boards of Appeal, is favourable to applicants, allowing a degree of flexibility during the filing and prosecution of divisional applications which had been put in doubt by several earlier decisions. The decision relates to the interpretation of Article 76(1) EPC.

### The Enlarged Board's key findings

- A divisional application which, on filing, contains subject-matter which extends beyond the disclosure of the earlier (parent) application (i.e. contains added subject matter) is not invalid *ab initio*.
- Such a divisional application may be amended to remove the added subject matter, irrespective of whether the earlier application is pending or not, provided that the amendment complies with the other requirements of the EPC.
- While a divisional application is pending, any of its original content may be claimed either in the divisional application, or in a yet further divisional application.
- It is **not** necessary that the subject matter of the claims of the divisional application be nested within the claims of its divisional predecessors.

The Board also considered the admissibility of divisional applications of divisional applications.

The Board reaffirmed existing practice that there was nothing in the EPC which prevented sequences of later divisional applications divided from earlier divisional applications.

However, the Board imposed one restriction: anything disclosed in the later divisional application must be directly and unambiguously derivable from what is disclosed in **each** of the preceding applications as filed in order for the later divisional application to be valid.

### Of additional interest are the Board's *obiter* comments.

Despite finding in favour of applicants, the Board observed that it is unsatisfactory that sequences of divisional applications containing the same broad disclosures as the original parent application can be kept pending until expiry of the parent application. It will remain to be seen if there is sufficient judicial impetus to take up the Board's invitation to consider whether such a filing practice is an abuse of procedure.

Furthermore, the Board took the opportunity to endorse the EPO's common practice of prohibiting double patenting, despite the absence of any statutory basis for such a prohibition.

The Board's decision should provide comfort to applicants. It paves the way for a more exploratory approach to claim drafting in divisional applications without the risk of invalidity at the first hurdle. Applicants can now tailor their divisional applications more closely to their needs at an early stage in prosecution.

The wording of Article 76(1) EPC is as follows: *A European divisional application must be filed directly with the European Patent Office at 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.*

### Need advice?

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