

European Divisional Applications

Summary

A divisional patent application is one created when a 'parent' application is divided in order to seek protection for some of the subject matter in the earlier application. A properly filed divisional retains the filing and priority date of the parent application but thereafter is treated independently. A European divisional application is limited to member states designated in the parent application at the time the divisional was filed.

Divisional applications are most often used where the parent application describes more than one invention, although it is possible for a European divisional application to have claims relating to the invention of the parent claims, but which are broader than or overlap with the parent claims.

There are a number of important points to be aware of in connection with divisional applications at the European Patent Office (EPO):

- The subject matter of the divisional cannot extend beyond the disclosure of the parent application as filed.
- It is permitted to file a divisional based on an application that is divided from a still earlier application.
- Divisional applications must be filed based on a pending parent application, and within certain time limits set by new Rules as follows:
 - A divisional filing for any subject matter in the parent is possible within two years of notification of the first communication from the Examining Division.
 - A divisional application may also be filed within two years of notification of a new lack of unity objection made by the Examining Division.

Further discussion on each of these points is set out below.

Restrictions on subject matter

Article 76 (1) of the European Patent Convention (EPC) states that a European divisional application may be filed only in respect of subject matter which does not extend beyond the content of the parent application. The subject matter of the divisional application should be directly and unambiguously derivable from the parent application as filed, taking account of subject matter that is implicitly disclosed to the skilled person. The test applied by the EPO is the same as for 'added matter' under Article 123(2) EPC and this is discussed in more detail in the note entitled " Added Matter/Extension of Protection at the European Patent Office".

If an added matter objection is raised then a divisional application can be amended after filing to avoid the objection. However, no interchange of subject matter between the parent and divisional is allowed, and amendment of a divisional application cannot add matter compared to the divisional application as filed. It is generally advisable for all of the subject matter of the parent to be repeated in the divisional to provide the best basis for future amendments. The description and drawings of a divisional application can be identical to the description and drawings of the parent application and the description can include clauses repeating the parent claims in order to avoid any inadvertent removal of subject matter.



A divisional may claim an invention that is disclosed in a parent claim or statement of invention. It is also possible to use any set of features that is disclosed in the parent application as the basis for a divisional claim, provided that the claimed combination of features is not an unallowable extension of subject matter. The divisional claims can overlap with the parent claims, and one application may claim its own subject matter in combination with that of the other. However, although the EPC contains no explicit prohibition of 'double patenting' the EPO will nonetheless object to divisional claims with the same scope as the parent claims.

Further divisional applications

More than one divisional application can be filed and it is permissible to file a divisional application based on an application that is itself divided from an even earlier application. Hence, there may be a chain of divisional applications. In each case the filing date will be based on the filing date for the earliest application in the chain, which may for example be a 'grandparent' or a 'great-grandparent' application. The subject matter of any new divisional application cannot extend beyond the disclosure of its immediate parent application.

Deadline for filing divisional applications

It is important to ensure that a European divisional application is filed in due time. If a deadline for divisional filing is missed, then this cannot be rectified except by using the EPC's re-establishment procedure, which has a strict requirement for 'all due care' to have been taken to meet the deadline. The deadline for filing a divisional application is set by Rule 36 EPC as in effect from 1 April 2010. This Rule distinguishes between mandatory division, where a divisional application is prompted by an objection of a lack of unity of invention and voluntary division, where there is no such objection. In each case, the parent application must be pending when the divisional application is filed, i.e. the parent cannot be granted, refused or withdrawn. According to G1/09 after a refusal by the Examining Division the application is still pending for the purpose of divisional filings until expiry of the deadline for filing an appeal, even if an appeal is not subsequently filed. Also, an application is pending when an appeal against a refusal by the Examining Division is ongoing.

Voluntary division: Any voluntary divisional application must be based on a pending parent application and must be filed within two years of notification of the Examining Division's first communication (office action) in respect of the earliest application where a communication has issued. If there is a chain of divisional applications, then the earliest application where a communication has issued could be an earlier application in the chain, e.g. a grandparent application. The deadline is calculated from 'notification' of the communication, and hence the deadline will be the date of the communication, plus ten days 'notification', plus two years.

Mandatory division: A divisional may be filed on the basis of a pending application within two years of notification of a communication from the Examining Division where a new objection of a lack of unity of invention is raised. If a non-unity objection arises at the search stage and is not corrected in a response to the Search Opinion, then the Examining Division's first communication should repeat the objection and open a new two year window for divisional filings. A new deadline is set each time that a new non-unity objection is raised. This appears to be intended to prevent unfair treatment of an applicant when a new lack of unity of invention objection is raised. However, the EPO has confirmed that divisional filings during the re-opened time limit can be directed to any allowable subject matter, and do not need to be limited to claims or inventions that were the subject of the objection of lack of unity of invention. It will hence be possible to utilise this provision to retain more flexibility for divisional filings under the new Rules.



For example, if an application claims a single invention but discloses multiple inventions in the description then a voluntary divisional can be filed where the claims include multiple inventions. To maintain flexibility it may be advisable for all divisional filings to be deliberately provided with claims that lack unity, thus giving rise to the possibility of opening a further two year window for divisional filings as a consequence of an objection to unity of the divisional claims. This practice has the potential to extend the period for divisional filings well beyond the initial two year window for voluntary division.

Further advice

As European patent attorneys, Dehns can advise on how to maximise the benefit of a European patent application. If you require advice in relation to European divisional applications then please contact us using the details below.

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