

European Divisional Applications

Summary

A divisional patent application is one created when a ‘parent’ application is divided in order to seek protection for subject matter disclosed, but not (or no longer) claimed, in the parent 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 when the parent application describes more than one invention. It is also 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.

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 to address 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 application, regardless of whether that disclosure was in a claim or in the description.

It is 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 the deadline for divisional filing is missed, then the only way in which this can be rectified is, by using the EPC's re-establishment procedure. This procedure 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. The parent application must be pending when the divisional application is filed, i.e. the parent cannot be granted, refused or withdrawn. In this regard, it is worth noting that 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.

In April 2010, Rule 36 EPC was amended to introduce further restrictions as to when a divisional application may be filed, but with effect from 1 April 2014 these further restrictions were lifted.

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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