

DIVISIONALS AS PRIOR ART

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The European Patent Convention (EPC) gives an applicant the possibility of dividing a pending European application by filing one or more divisional applications, which can be divided further. The European application can be a European direct application (EP application) or a European part of an International application (Euro-PCT application). The divisional applications take over the effective date of the earlier application or earliest application in a line of divisional applications.

Divisional applications may be of interest as they give the applicant a possibility of protecting those parts of the invention disclosed in the application as filed, including non-searched subject matter, specific embodiments not covered by the scope of claims of the parent application, and claims that have to be removed from the parent application due to lack of unity. To target a patent application against an infringing party, it is also possible to reduce the scope of the claims of the parent patent application, which it is hoped will lead to a faster-granted patent covering the potentially infringing product. A divisional application can be filed maintaining claims with broader scope of protection.

Article 54(3) EPC includes provisions to prevent the same idea being patented twice, even when two EP applications are filed so close in time that the earlier was not published prior to the filing date of the later. The earlier EP application is included in the state of the art for the later filed EP application, but only relating to novelty.

If an applicant enters the EP jurisdiction via an EP direct or Euro-PCT application claiming priority from an EP or national application, the applicant or representative must take considerable care not to violate Article 54(3) EPC.

Decision T1496/11, published September 12, 2012, describes important points in this regard. The decision concerns a Euro-PCT application (EP1), claiming priority from a national application (N), which described only some embodiments (“a printed or embossed feature [10]”) of a generic feature. EP1 did not claim the mentioned embodiments, but instead claimed the generic feature (“a feature [10] which can be inspected, enhanced or optically varied”) and for this reason could not validly claim priority from N.

Instead the applicant chose to divide EP1 to a divisional application EP2, which claimed the embodiments disclosed in N, and could therefore validly claim priority from N. EP2, as an EP application, therefore had a filing date prior to and a publication date on or after the filing date of EP1, and for this reason became state of the art relative to EP1 according to Article 54(3) EPC.

The same situation could arise if the applicant initially filed an EP direct application disclosing some embodiments of a generic invention, but not describing the entire generic invention, and afterwards claimed priority from the EP direct application in a PCT application, which only claimed the generic

“ALL EMBODIMENTS DESCRIBED IN THE PRIORITY APPLICATION SHOULD ALSO BE DESCRIBED IN THE EP APPLICATION, EG, BY COPYING AND PASTING THE ENTIRE DESCRIPTION OF THE PRIORITY APPLICATION INTO THE EP APPLICATION.”

invention. When entering the EP jurisdiction with a Euro-PCT application, a divisional application claiming the embodiments disclosed in the initial EP direct application would become state of the art relative to the Euro-PCT application.

Applicants or representatives for applicants entering the EP jurisdiction should therefore be very careful. All embodiments described in the priority application should also be described in the EP application, eg, by copying and pasting the entire description of the priority application into the EP application, or alternatively by carefully disclosing the same embodiments as in the priority application along with possible new embodiments in the EP application.

If a generic invention is claimed in the EP application and only some embodiments of the generic invention are disclosed in the priority application, the applicant should nevertheless always remember to include examples of all the embodiments of the generic invention in the EP application, and furthermore remember to claim all relevant embodiments, so that dividing the EP application into divisional applications is possible.

If an EP application containing a generic term has already entered the EP jurisdiction without properly disclosing and claiming the relevant embodiments from a priority application, the possibility of filing a separate national application or national utility model application in accordance with Article 135(1)(b) EPC should be considered. This application can claim the embodiments of the priority document or from the remainder of the generic invention, because national applications and national utility model applications are not subject to Article 54(3) EPC. Always be careful when entering the EP jurisdiction and claiming partial priority. ■

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