

## **EPO Practice: Unity of Invention & Divisional Applications**

There have been a couple of interesting and potentially important Decisions on divisional applications from EPO Boards of Appeal recently but as the filing of a divisional application does not usually come into consideration unless a non-unity objection has been raised, I thought that I had better start by giving a brief explanation of EPO practice as regards unity of invention.

The requirement for unity of invention is laid down in Article 82 of the European Patent Convention which states simply:

“The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

What Article 82 is intended to mean is clarified by Rule 30 which says that where a group of inventions is claimed in the same application the unity requirement is fulfilled only if there is a technical relationship among those inventions involving one or more of the same or corresponding *special technical features*. According to Rule 30 *special technical features* means those features that define a contribution which each of the claimed inventions considered as a whole makes over the prior art. And the rule goes on to make it clear that it doesn't matter whether the group of inventions is defined in a number of separate independent claims or as alternatives in the same claim. By *special technical features* is meant the particular technical feature in any one claim that defines the contribution that the claimed invention has made over the prior art. Therefore, where there is more than one independent claim, it is necessary to identify the or each *special technical feature* of each claim. Then it is necessary to determine whether or not there is a technical relationship between those special technical features. If there is, then unity of invention is established. If not, there will be a non-unity objection.

If there are two or more independent claims, the Examiner will begin by identifying the subject-matter common to them. If the common subject-matter lacks novelty, there will be a non-unity objection.

If the common subject-matter is novel and inventive, there will be no non-unity objection.

The situation where the common subject-matter is novel but arguably non-inventive is less clear - it is a matter for to the Examiner's discretion. In general, EPO Examiners have a fair amount of discretion in deciding on unity of invention.

If, say, the first independent claim is to a *product*, then an independent claim for a *process specially designed for the manufacture of that product* will be allowed in the same application.

If, say, the first independent claim is for a *process*, an independent claim for *apparatus specifically designed to carry out the process* will be allowed in the same application.

So independent claims for a *product*, a *process specifically adapted for the preparation of the product and apparatus specially designed to carry out the process* will be allowed to remain in the same application.

In chemical cases, if separate independent claims are to an *intermediate* and to the *final product*, these will be allowed to remain in the same application if the intermediate and final products have a common essential structural element and provided that the intermediate and the final products are directly interrelated, which means that there should not be too many process steps between the intermediate and the final product.

Again, in chemical cases, where a single claim contains a list of alternatives (in the US known as a Markush grouping) then these will be considered to relate to the same invention if the alternative have a common activity or display a common structural element.

The situation is further complicated by Rule 29(2) which came into force at the beginning of 2002 and which places severe restrictions on the possibility of having more than one independent claim in the same category - in other words, product, process, apparatus or use - even if the independent claims meet the requirements for unity of invention as laid down by Article 82 and Rule 30. The main reason for this restriction was to discourage the filing of a US-type set of claims with many independent claims of only slightly-differing scope.

If a valid non-unity objection has been raised the applicant has the option of filing a divisional application.

The first thing to note is that any divisional application must be filed before the parent application has been granted. There is no way of filing a divisional once the parent has issued as a patent.

Let us say that the applicant has filed a European application with three sets of independent claims which I shall call sets A, B and C, appearing in the text in that order.

When the file goes to the search examiner the search examiner will search only the first invention, in other words, the first independent claim and any claims that are dependent on the first independent claim. This will be claim set A. He may search the other inventions if this is considered to be economical, in other words, if not much extra time would be required.

If the search examiner does not search all the claim sets, the EPO will invite the applicant to pay a supplementary search fee for each of the unsearched sets of claims - in this case claim sets B and C. These fees can be paid "under protest" and will be refunded if the applicant is able to persuade the EPO that the non-unity objection was unjustified. It is a good idea to pay the search fee for any set of claims that is likely to be important enough to warrant the filing of a divisional application because by paying the search fee with the parent application, the applicant receives a European search report before having to go to all the expense of filing the divisional application - he can decide whether or not a divisional application is worthwhile once he has received the search report.

Next, responsibility for the file is passed to an Examining Division, consisting of three examiners.

Whether or not the applicant has obtained a search report for one or more further inventions, only the first invention - claim set A - will be subjected to substantive examination. Whether or not a search report has been drawn up for the second and/or third inventions - claim sets B and C - the applicant will have the option of filing one or more divisional applications. During examination of the invention defined in claim set A, the applicant may not amend the

claims so as to destroy unity of invention or to introduce unsearched subject-matter into the claims.

The filing of divisional applications under the European Patent Convention is governed by Article 76(1) which provides that a divisional application may only be filed in respect of subject-matter which does not extend beyond the content of the earlier application as filed, and that if 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.

Today I shall be discussing what is meant by *the earlier application* and what is meant by the bar on a divisional application containing subject-matter that extends beyond the content of the earlier application.

According to Rule 25(1), the applicant may file a divisional application relating to any pending earlier European patent application. The word *pending* here is important as we shall see.

Problems have arisen in the EPO where divisional applications have been filed based on earlier divisional applications rather than directly on the original parent application.

At one time there was uncertainty as to whether or not it was even permitted to file a divisional application based on an earlier divisional application. The reason for this uncertainty was a discrepancy between the French-language version of the EPC and the German and English-language versions.

As you probably all know, the European Patent Convention is published in the three official languages of the European Patent system (English, German, French) and the three texts all have equal legal status. The problem was that in the French text Article 76(1) referred to the *initial* application rather than the *earlier* application. When considering a parent application and a divisional application or a series of divisional applications, the words *initial application* could have meant only the original parent application and not any divisional applications filed subsequently. I am glad to say that this issue has been resolved by amendment of the French text of the European Patent Convention so that all three texts now refer to the *earlier application* and it is therefore now clear that a divisional application can be based on an earlier divisional application.

The first Decision that I want to refer to today is Technical Board of Appeal Decision T1158/01 in the name of TridonicAtco GmbH & Co. KG. This Decision is dated from July 2004. The parent application was revoked as a result of an opposition. The Decision to revoke the patent was upheld on appeal.

However, whilst the parent application was still pending a divisional application was filed. I shall refer to this as the "first generation divisional application". Later, a "second generation divisional application" was filed. It was divided out from only the first generation divisional application and not from the original parent application. The first generation divisional

application was then withdrawn.

The second generation divisional application was examined and was refused by the Examining Division on the ground of lack of inventive step. Whether or not this application had been validly filed under Article 76(1) was not considered by the Examining Division. The applicant filed an appeal against this refusal. However, the Board of Appeal, in examining the case, questioned whether the second generation divisional application complied with the requirement of Article 76(1). The Board came to the conclusion that it was obliged to consider whether the first generation divisional application had met the requirements of Article 76(1) and therefore whether it had been validly filed, before considering the validity of the second generation divisional application. In this case the Board came to the conclusion that the first generation divisional application had not been validly filed because it contained subject-matter that was not derivable from the parent application. You will recall that according to Article 76(1) a divisional application may only be filed for subject-matter that *does not extend beyond the content of the earlier application as filed*. The Board then came to the conclusion that because the first generation divisional application had *not* been validly filed, the second generation divisional application was automatically invalid. The appeal was therefore dismissed so that the application remained refused.

If both the parent and the first generation divisional application are still pending when the applicant comes to file a second generation divisional application, the applicant has the choice of dividing out the second generation divisional application either from the parent application or from the first generation divisional application or, indeed from both the parent and the first generation divisional application. It is the view of the EPO that if, when the second generation divisional application is filed, the parent application is no longer pending then the second generation divisional application may be divided out from the first generation divisional application only. This is based on Rule 25(1) where it is stated that a divisional application must be based on a *pending* earlier European patent application.

I now want to refer to two closely-related Decisions, both dated 23 September 2004. The Decisions are No. T0720/02 and T0797/02. Both applications were in the name of Seiko Epson Corporation and the two Decisions were issued on the same day by the same Technical Board of Appeal. These Decisions make it clear that a second generation divisional divided out of a first generation divisional is entitled to claim only subject-matter that had been defined in the claims of the first generation divisional and cannot go back to subject-matter that had been claimed in the claims of the parent application only.

If you would like to study these Decisions in detail in this case the first application of the series is referred to as the grandparent application and the first-generation divisional application is referred to as the parent application.

The subject-matter of the applications was in the field of electronics. Without going into this in any detail because this Decision would be applicable over all technical fields, the problem was that the claims filed with the second generation divisional application omitted features to which the claims of the first generational divisional application had been limited. To quote from the Decision of the Board:

*To allow subject-matter from a grandparent application (which is no longer pending) which was reproduced in the description of a parent divisional application but not encompassed by the invention actually divided out of a grandparent application, to be further divided out of*

*that parent application at a later date would be to allow applicants, 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.*

What the Board is saying is that if it were allowable for a second generation divisional application to be divided out from a first-generation divisional application but claim subject-matter that had not been claimed in the first-generation divisional application but had only been claimed in the no longer pending parent application, third parties would be left completely uncertain as to what subject-matter from the original parent application might eventually be claimed.

The Board then went on to say:

*It is the Board's view that the invention or group of inventions defined in the claims of the parent application (i.e. in this case the first generation divisional application) as divided out of the grandparent application (the original parent application) determines the essential content of the parent application; and therefore to meet the requirements of Article 76 EPC any further divisional applications divided out of the parent application must be directed to objects encompassed by such invention or group of inventions.*

What this paragraph means is that if a second generation divisional application is filed based only on a first generation divisional application and not on the parent application, the subject-matter that can be claimed in the second generation divisional application is restricted to subject-matter that was claimed in the first general divisional application and the applicants can not go back to subject-matter that was claimed only in the parent application.

I would like to sum up as follows:

- make sure the divisional gets filed before the application from which it is to be divided is granted as a patent.
- if you have several sets of claims A, B and C in the first application of a series, and you then decide to file a divisional covering the second set, set B, while the first application - with claim set A - is still pending, it is important that you also include claim set C in the divisional in case further down the line you want to file a second divisional by dividing claim set C out of the first application. When you file a divisional application it should include *any* set of claims that is not already being examined in another application of the series.
- when you file a divisional application make sure that you are not adding any subject-matter that was not in the parent application. The easy way of doing this is to make the description of the divisional application when you file it exactly the same as the originally-filed description of the parent application. Any unwanted subject-matter can of course be deleted later but you are not taking the risk of inadvertently adding any subject-matter that would make the divisional application invalid.