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# European Case Law Update

- Unity of Invention
- Divisional Applications

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# Unity of Invention

Inventions must be linked by one or more technical features that distinguish the inventions from the prior art.

EPO rarely allows more than one independent claim in each of the following categories:

Product Process      Apparatus Use

(Rule 29(2) EPC)

# What claims are allowed?

Independent product / apparatus claim

+

Method of manufacture of product / apparatus

+

Method of use of product / apparatus

*Providing that* the methods are limited to that product / apparatus

## Search

- EPO searches 1<sup>st</sup> invention only (*i.e.* relating to 1<sup>st</sup> independent claim)
- Other inventions also searched if ‘economical’
  - *i.e.* not much extra time required
- If unity is lacking, the EPO invites applicant to pay supplementary search fee
  - can be paid ‘under protest’
  - fee is refunded if EPO agrees that no further search was needed

## Examination

- If only a part of an application was searched, only that part can be examined
- If more than one invention was searched, applicant must choose which invention is examined
- Unsearched inventions can only be examined if a divisional application is filed
- Amendments must not
  - destroy unity of invention
  - introduce unsearched subject matter
- NB Lack of unity is not a ground for opposition

## Article 76(1)

‘ ... [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; 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.’

## Rule 25(1)

‘The applicant may file a divisional application relating to any *pending* earlier European patent application.’



# What does *earlier* mean?

- The original Art 76(1) EPC differed in the 3 official languages:
- English and German: ‘... *earlier* application as filed ...’
- French: ‘... *initial* application as filed ...’
- In 2000, the French version of the EPC was amended to be consistent with the English and German versions.

# T1158/01: TridonicAtco GmbH & Co. KG

Parent

↓  
division

1<sup>st</sup> generation divisional

↓  
division

2<sup>nd</sup> generation divisional

## Comments

Revoked during opposition

Withdrawn (after filing of 2<sup>nd</sup> generation divisional)

Refused (subject-matter extended beyond 1<sup>st</sup> generation divisional. Could not divide from parent because parent was granted before filing date of 2<sup>nd</sup> generation divisional)



Appealed

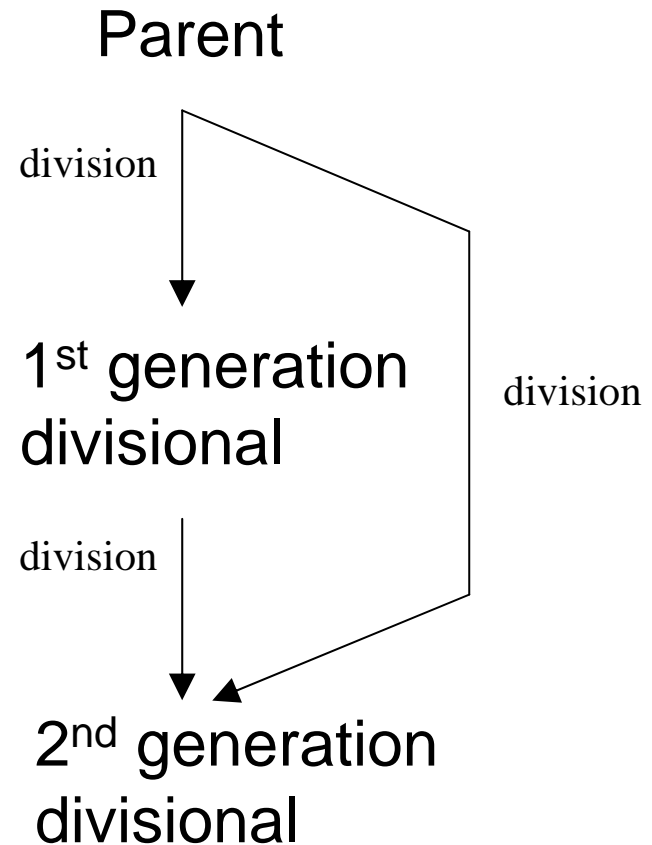
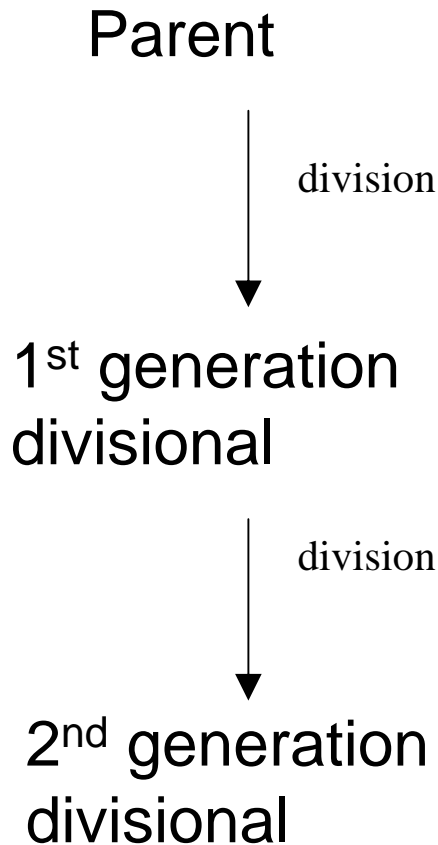
# Technical Board of Appeal

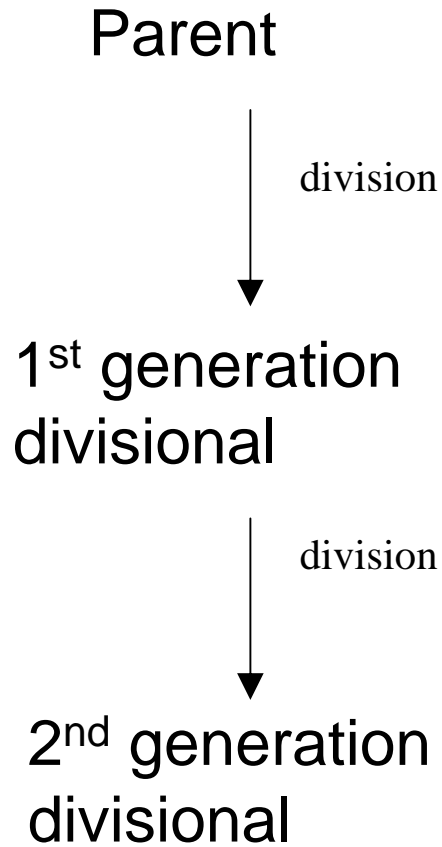
- The 1<sup>st</sup> generation divisional contained added matter (contrary to Article 76(1) EPC) and was therefore not valid.
- Consequently, the 2<sup>nd</sup> generation divisional was not entitled to the parent's filing date or priority claim.

## Conclusion

- This decision confirms earlier EPO case law which said that when a 2<sup>nd</sup> generation divisional is examined the validity, from the viewpoint of Article 76(1) EPC, of the 1<sup>st</sup> generation divisional must also be examined.

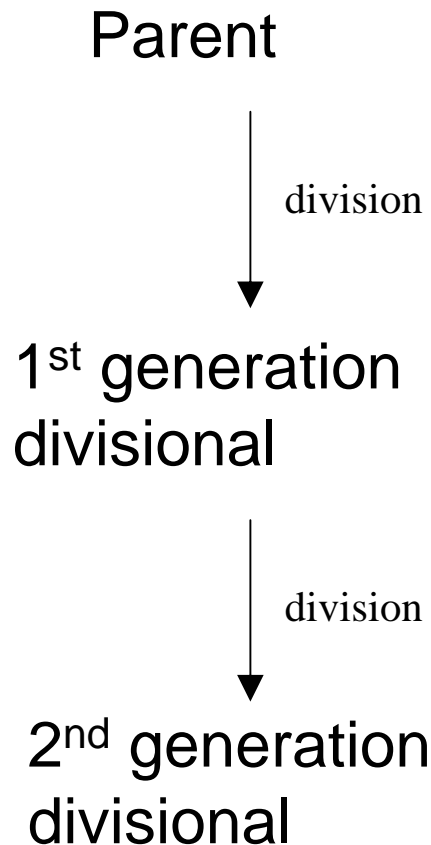
# Different hierarchies of divisional applications





- If the 1<sup>st</sup> generation divisional is not valid under Article 76(1), then the 2<sup>nd</sup> generation divisional will not be valid.
- If the 1<sup>st</sup> generation divisional is not valid, must the parent application be pending for the 2<sup>nd</sup> generation divisional to be valid?
- If the 1<sup>st</sup> generation divisional is not valid under Article 76(1), then the 2<sup>nd</sup> generation divisional will not be valid.

# T0720/02 & T0797/02: Seiko Epson Corporation



Question: Can subject-matter not claimed in a 1<sup>st</sup> generation divisional be the object of a 2<sup>nd</sup> generation divisional?

Answer: No

*n.b.:* The 2<sup>nd</sup> generation divisional was only divided from the 1<sup>st</sup> generation divisional, it was not divided from the parent application.

# The Board of Appeal's reasons

- The Applicant should give the public a fair idea of the monopoly sought.
- The *claims* of the 1<sup>st</sup> generation divisional should determine the scope of protection sought for the 1<sup>st</sup> generation divisional *and* subsequent divisional applications.

# Best practice when filing divisional applications at the EPO

- File the *full* description of the original parent application (unamended)
- File all the original claims that are not already included in either the parent or in an earlier divisional application
- Divide from and claim priority from the parent and all divisional applications that are still pending
- Check that you have not added subject matter



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