



PD53 Patent Law and Procedures | D531 Patent Law and Processes

WIPO Study on Substantive and Procedural Requirements Regarding Voluntary Division of Patent Applications by Applicants EPO contribution

Introduction

The European Patent Office's (EPO) legal basis for divisional applications is Article 76 and Rule 36 EPC, which also reflect the principles laid down in Article 4 G of the Paris Convention. Divisional applications may be filed to respond to an objection under Article 82 EPC due to a lack of unity of invention (so-called "mandatory" divisional applications). They may also be filed of the applicant's own volition ("voluntary" divisional applications).

1. Voluntary divisional applications – substantive and procedural requirements

The substantive and procedural requirements under the EPC legal framework apply to voluntary and mandatory divisional applications alike.

Article 76(1) EPC provides that divisional applications shall be filed directly with the EPO and sets out the key substantive requirement for filing a divisional application, namely that it may be filed only in respect of subject-matter which does not extend beyond the content of the earlier (or "parent") application as filed. Provided this requirement is met, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority. A divisional application can also be an earlier application within the meaning of Article 76(1) EPC for one or more further divisional applications.

All contracting states designated in the earlier application at the time of filing a divisional application are deemed designated in the divisional application (Article 76(2) EPC).

In accordance with Rule 36(1) EPC, a divisional application may be filed in relation to any pending earlier European patent application. An application is pending up to, but not on, the date that the European Patent Bulletin mentions the grant of the patent. If an application has been refused, the application is still pending within the meaning of Rule 36(1) EPC until expiry of the time limit for filing the notice of appeal.

Divisional applications shall be filed in the language of the proceedings of the earlier application. If the latter was not in an official language of the EPO, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of filing the divisional application (Rule 36(2) EPC).

The filing and search fees shall be paid within one month of filing the divisional application. If these fees are not paid in due time, the application shall be deemed withdrawn (Rule 36(3) EPC). An additional generation-specific fee is due in the case of a divisional application filed in respect of any earlier application which is itself a divisional application (Rule 38(4) EPC; Article 2 1b. of the Rules Relating to Fees). The renewal fees already due in respect of the earlier application at the date on which the divisional application is filed shall also be paid for the divisional application and shall be due on its filing. These fees, and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee. If these fees are not paid within that period, they still may be paid within six months of the said date, provided that an additional fee is also paid within that period (Rules 51(2) and (3) EPC). If the renewal fees already due on the earlier application and additional fees are not paid in due time, the divisional application shall be deemed to be withdrawn (Article 86(1) EPC).

2. Processing voluntary divisional applications

The practice for processing divisional applications is described in the Guidelines for Examination in the EPO, A-IV, 1 and C-IX, 1. The Guidelines reflect the relevant case law of the boards of appeal.

The substantive examination of a divisional application should in principle be carried out in the same way as for any other application. The claims of a divisional application need not be limited to subject-matter already claimed in the parent application's claims.

In examination of a divisional application, the examining division may exceptionally issue a summons to oral proceedings as the first action if:

- the parent application was refused or withdrawn and there is no prospect of a grant for the divisional application, even taking into account the applicant's reply to the search opinion
- the content of the claims on file is substantially the same as or broader than the subject-matter of claims that were examined for the refused or withdrawn parent application or that served as a basis for the search of the divisional application
- one or more of the objections that are crucial to the outcome of the examination procedure and that were raised in either the search opinion established for the divisional application, the parent's refusal or a communication issued for the withdrawn parent still apply.

The annex to the summons issued as the first action in examination must deal with all the applicant's requests and be as detailed as a communication under Article 94(3) EPC. The summons should be issued with at least six months' notice. Oral proceedings may be cancelled or postponed if the applicant's submissions contain a genuine effort to overcome the examining division's objections.

3. Double patenting

As acknowledged by the Enlarged Board of Appeal, the prohibition on double patenting applies to divisional applications under Article 125 EPC (G 4/19). It is a principle of procedural law generally recognised in the majority of contracting states that two patents cannot be granted to the same applicant with claims directed to the same subject-matter. In line with that, a European patent application can be refused under Article 97(2) EPC if it claims the same subject-matter as a European patent that has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.

This would especially be the case in the following typical situations: two applications filed on the same day, parent and divisional applications, or an application and its priority application. An applicant can be allowed to proceed with an application that has the same description as a patent already granted to them as long as it does not claim the same subject-matter.

Where two or more European applications from the same applicant designate the same states and their claims have the same filing or priority date and relate to the same invention, the applicant must amend one or more of the applications so that the subject-matter of their claims is no longer the same, withdraw overlapping designations or choose which one of those applications is to proceed to grant. Otherwise, once one of the applications has been granted, the others will be refused under Article 97(2) EPC in conjunction with Article 125 EPC. If the claims of those applications only partially overlap, no objection should be raised. However, when, for example, the subject-matter of an independent claim in an application is the same as that of a dependent claim in a granted patent held by the same applicant, an objection of double patenting will be raised.

If two applications with the same effective date are received from two different applicants, each must be allowed to proceed as though the other did not exist.