

EPO Enlarged Board of Appeal to tackle divisional poisoning

The controversial issue of “poisonous divisionals” has attracted much attention in the European patent world in recent years, with numerous commentators speculating on the possible far-reaching effects of the EPO and national courts ruling that a parent patent application may be citable as novelty destroying prior art against its own divisional, and vice versa. Now, in case G 1/15, an EPO Board of Appeal has referred a series of questions to the EPO’s Enlarged Board of Appeal in an effort to clarify the correct approach to this complicated issue.



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The referral originates from EPO case T557/13, in which Infineum USA (the proprietor of a European divisional patent directed to the use of a fuel cold flow improver) appealed against the revocation of the patent in opposition proceedings. In those proceedings, the opposition division held that claim 1 of the divisional lacked novelty over its own parent.

The divisional and its parent both claimed priority from a UK priority patent application which disclosed only specific example embodiments of the invention. The opponent successfully argued that claim 1 of the divisional was not entitled to priority because the generic subject matter of the claim was not disclosed in the priority application. That claim nevertheless still encompassed Example 1, which was disclosed in both the parent and in the priority application. Thus, the disclosure of that example in the parent was citable under Article 54(3) EPC as ‘novelty only’ prior art against claim 1 of the divisional (Article 54(3) EPC ‘novelty only’ prior art being European patent applications having a priority or filing date earlier than the effective date of the case in question, but published later).

Infineum argued that because the example was disclosed in the priority application, then at least for that small area of its scope, claim 1 was entitled to

the earliest priority date. However, in a previous decision of the Enlarged Board (G2/98), it was held that a single claim can only have multiple (different) priority dates if the claim consists of a limited number of clearly defined alternative subject matters.

During opposition, the above test for multiple priority dates was applied strictly. The opposition division rejected the proprietor’s argument that claim 1 of the divisional must be entitled to priority to the extent that it covered subject matter disclosed in both the parent and in the priority application. Instead, the division agreed with the opponent in concluding that 1) claim 1 of the divisional covered the use of any of a large class of compounds, and 2) that the compounds disclosed in the priority application were not clearly defined alternative subject matters in claim 1 of the divisional, and so did not meet the test set out in G2/98.

As a result of Infineum’s appeal, a number of questions have been referred to the Enlarged Board. The first four questions ask if the test given in Enlarged Board decision G2/98 for whether or not a claim has multiple (different) priority dates is appropriate to determine if a generic claim is entitled to multiple priority dates, and give the Enlarged Board an opportunity to set out a new test. The fifth

question is specifically directed to divisionals, and asks if there can ever be a problem of “poisonous divisionals” in the case of generic claims where only specific alternatives are disclosed in a priority application.

The EPO has invited third parties to file written statements with their observations on the questions referred to the Enlarged Board (submissions must be made by 1 March 2016), and a final decision is expected in the next 1-3 years. In the meantime, the President of the EPO has issued a Notice indicating that all proceedings before the examination and opposition divisions for which the outcome depends entirely on the Enlarged Board’s decision will be stayed until that decision is issued.

The Enlarged Board’s decision on this case will be of great interest, not only to current and future patent applicants, but also to those considering opposing a European patent. For applicants, that decision will undoubtedly shape patent application filing strategies, both in deciding whether or not to file divisional applications, in what form to file divisional applications, and in how far to go in updating applications at the end of the priority year. For opponents, the decision will undoubtedly shape what arguments are put forward during opposition and maybe also which patents to oppose in the first place. We shall of course let you know when the Enlarged Board has made its decision!

If you have any questions regarding this referral to the Enlarged Board, or if you would like to discuss how it may influence filing and/or opposition strategy, please do not hesitate to get in touch with your usual Abel & Imray contact.

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