

GERMANY



**Maiwald Patentanwalts
GmbH
Munich**

Derk Vos

EBA rules on validity of divisional applications

In its most recent Decision G 1/05, the Enlarged Board of Appeal (EBA) of the European Patent Office clarified several issues on the validity of divisional applications (first and subsequent generations) containing added subject matter at the actual filing date. In this decision the EBA consolidated three referrals from the Technical Boards of Appeal.

The first referral, T 39/03 (G 1/05), was directed to the question of whether a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it contained added subject matter, could be amended later in the proceedings in order to make it a valid divisional application. Furthermore, it was questioned if those amendments would also be possible if the earlier application were no longer pending. The EBA pointed out that the applicant may be given the opportunity to overcome the objection raised to meet the requirements for patentability. In addition, the EBA emphasized that, since a divisional application is an independent application, amendments to remove added subject matter are allowable irrespective of whether or not the earlier application was still pending.

The second referral, T 1409/05 (G 1/06), dealt with the problem of whether the fact that added subject matter which was created through the filing of a divisional application of an earlier generation in case of a subsequent, later divisional application inevitably leads to the invalidity of the later application if the deficiencies had not been overcome in the earlier application. The decision states that the fate of earlier member(s) of the sequence as filed is irrelevant for correctly filed subsequent divisional applications, provided that the subject matter of any divisional application could benefit from the filing date of the root application.

The third referral, T 1040/04 (G 3/06), was directed to the question of whether a patent granted on a divisional application, which at its actual date of filing contained added subject mat-

ter, could be amended during opposition proceedings. The EBA pointed out that there are no special rules in oppositions for divisional applications and that amendments to overcome the objections are allowed to meet the requirements for patentability.