

“Poisonous Divisionals” at the EPO

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1. Legal Basis – Art. 54(3)EPC

Art. 54 EPC

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.

1. Legal Basis – Reference Example: U.S. Code

§ 102 - Conditions for patentability; novelty

(a) Novelty; Prior Art. - A person shall be entitled to a patent unless -

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122 (b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

2. Problem

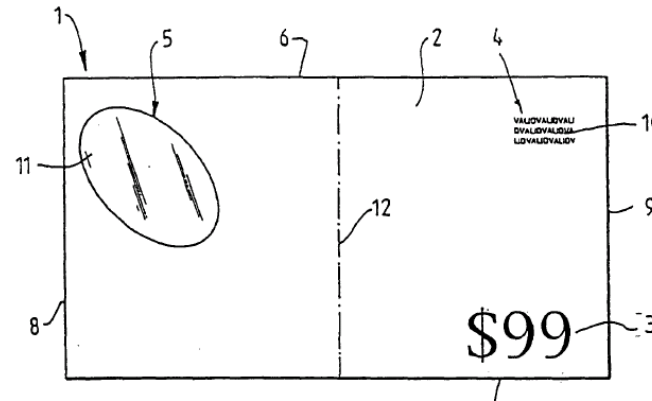
In some jurisdictions the applicant's own earlier filed but later published patent applications cannot form prior art for the subject matter claimed in a later application.

Under the EPC Article 54(3) EPC, however, no distinction is made between earlier applications of the same inventor or applicant and those of other inventors/applicants. The prior art effect is identical.

Rationale: Avoiding double patenting

Problem: "Whole-contents approach": The whole disclosure of the prior application is compared to the claimed scope of protection of the later application

3. Decision T 1496/11



Priority document = Divisional appl.

A security document (1) including ...

*the security device provided at the second portion (4) comprises a **printed or embossed** feature (10) which can be inspected, enhanced or optically varied **by the optical lens** when the first and second portions (5,4) are brought into register.*

Claim 1 of the patent

A security document (1) including ...

*the security device provided at the second portion (4) comprises a [**printed or embossed**] feature (10) which can be inspected, enhanced or optically varied **by the optical lens** when the first and second portions (5,4) are brought into register.*

3. Decision T 1496/11

*The general presentation of the invention on page 3, lines 21 to 29 of the priority document does not constitute a basis for omitting the "printed or embossed feature" from the security device disclosed in the context of the embodiment in which the selfverification means comprises an optical lens and on which the subject-matter of claim 1 is based, because this would constitute an **intermediate generalisation** in which said feature, which was only disclosed in combination with those of the embodiment, would have been arbitrarily omitted from the context of that combination. ...*

Thus the security device according to claim 1 (main request) has been generalised to include features produced by other means such as, for example, hot stamping or photo-lithography. The subject-matter of claim 1 (main request) thus does not constitute the same invention as that set out in the priority document (Article 87(1) EPC 1973).

3. Decision T 1496/11

The divisional application G25 of the patent in suit discloses an embodiment in which a flexible banknote may be folded upon itself and a self-verification means in form of an optical lens used to view an area of microprinting which constitutes the security device (column 8, lines 21 to 34 and figures 1 and 2). The description of this embodiment is identical to that provided in the priority document (page 9, lines 19 to 27 and figures 1 and 2). This embodiment of the divisional application G25 is therefore entitled to the claimed priority date of 10 October 1996 and thereby anticipates the subject-matter of claim 1 (main request) which is only entitled to the filing date of 08 October 1997.

4. Example 1: Generalization

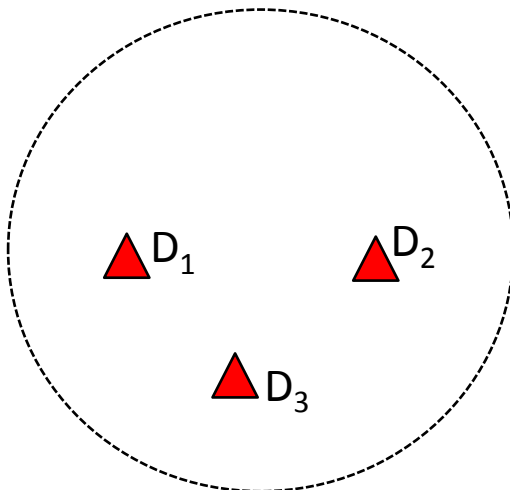
Priority application P1:

3 embodiments

$A+B+C+D_1$

$A+B+C+D_2$

$A+B+C+D_3$



Family member 1:

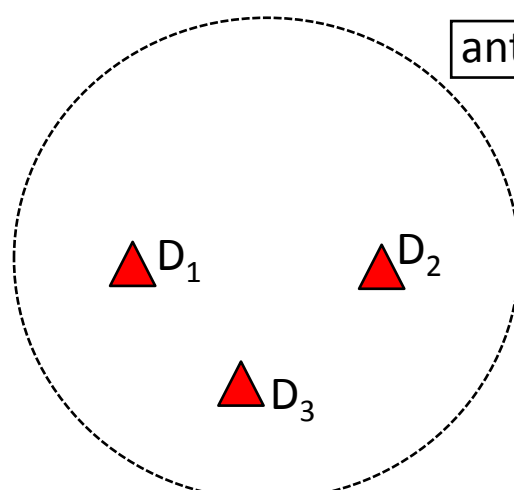
3 embodiments

$A+B+C+D_1$

$A+B+C+D_2$

$A+B+C+D_3$

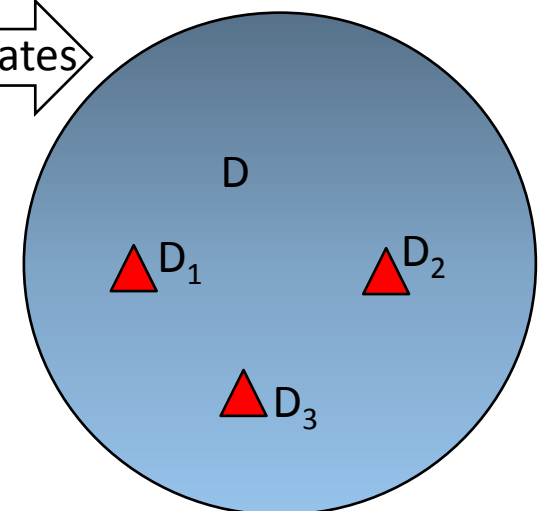
enjoying priority of P1



anticipates

Family member 2:

Element D is a generalization of (D_1, D_2, D_3) , not enjoying priority of P1



4. Example 2: Mutual anticipation

Priority application P1:

Narrow embodiment
disclosed

Family member 1:

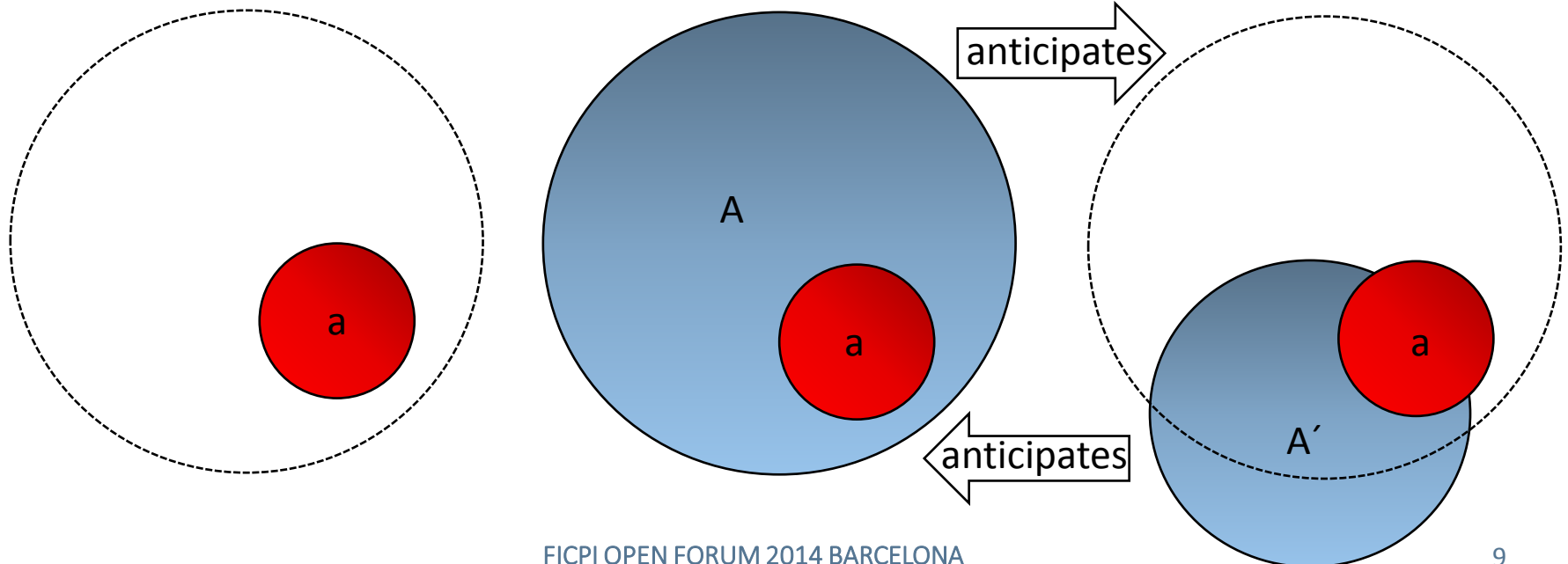
Narrow disclosure a
entitled to priority P1

Broad claim A not
entitled to priority P1

Family member 2:

Narrow disclosure
entitled to priority P1

Claim A' not entitled to
priority P1

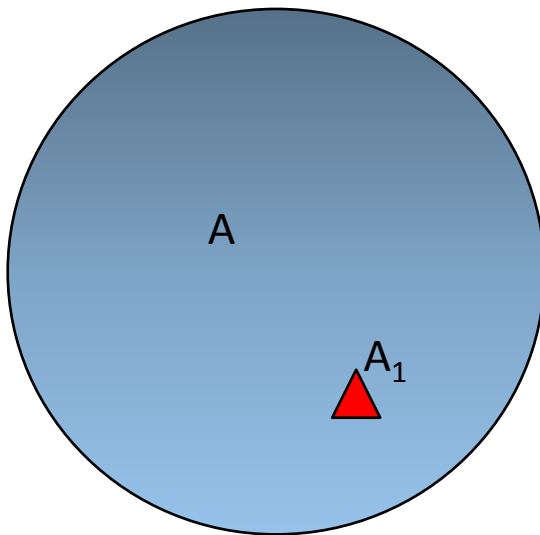


4. Example 3.1: Selection

Priority application P1:

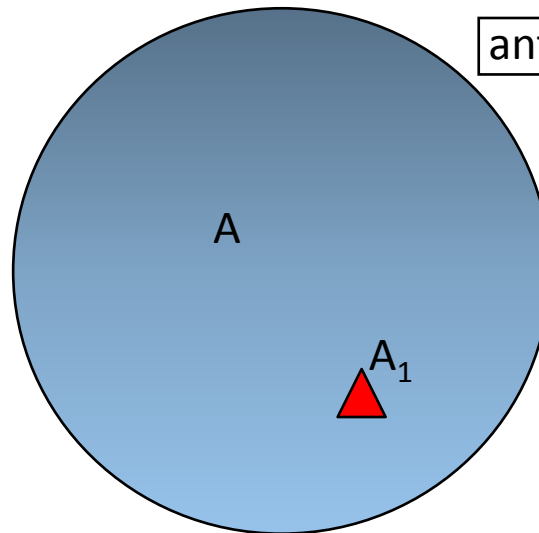
Broad claim

narrow embodiment



Family member 1:

Broad claim + narrow
embodiment entitled
to priority P1

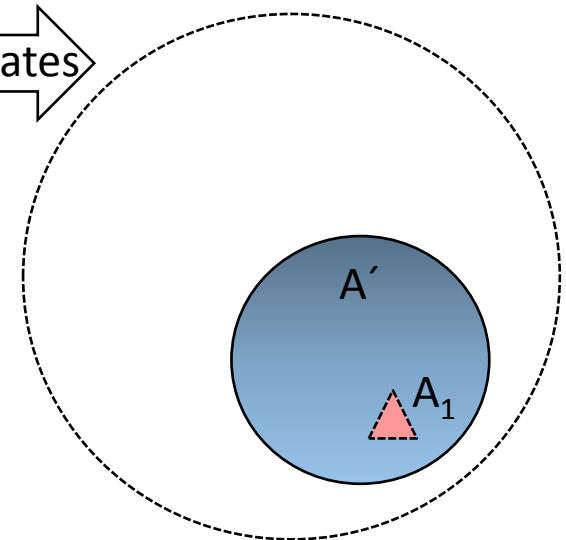


anticipates

Family member 2 :

Narrower claim A' not
entitled to priority P1

Anticipated by A₁

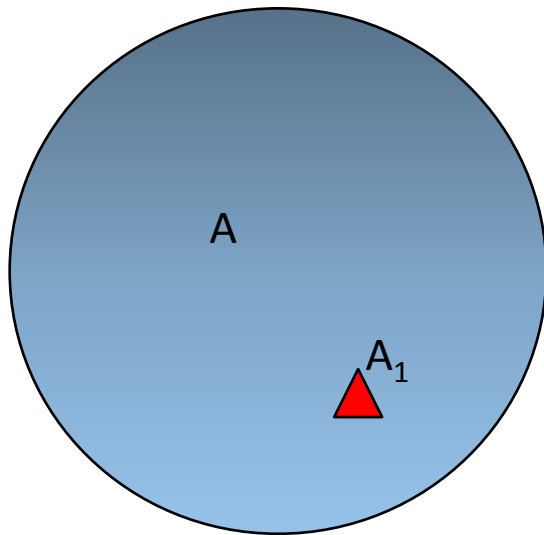


4. Example 3.2: Selection

Priority application P1:

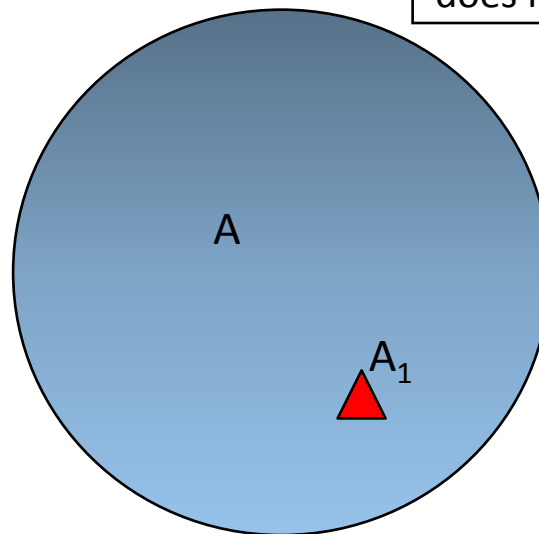
Broad claim

narrow embodiment



Family member 1:

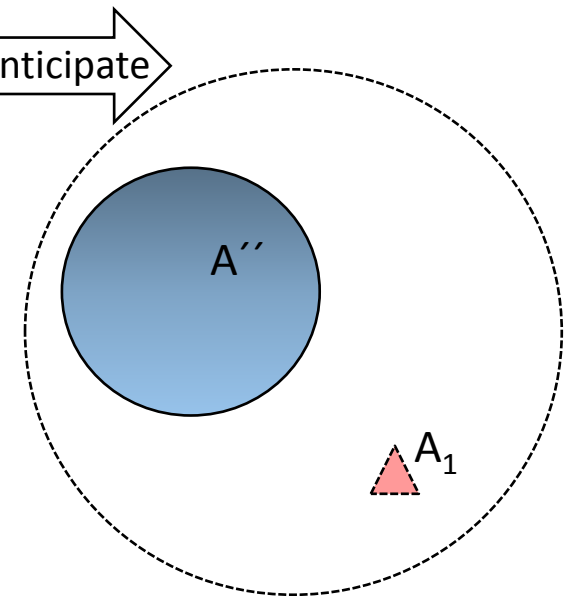
Broad claim + narrow
embodiment entitled
to priority P1



does not anticipate

Family member 2:

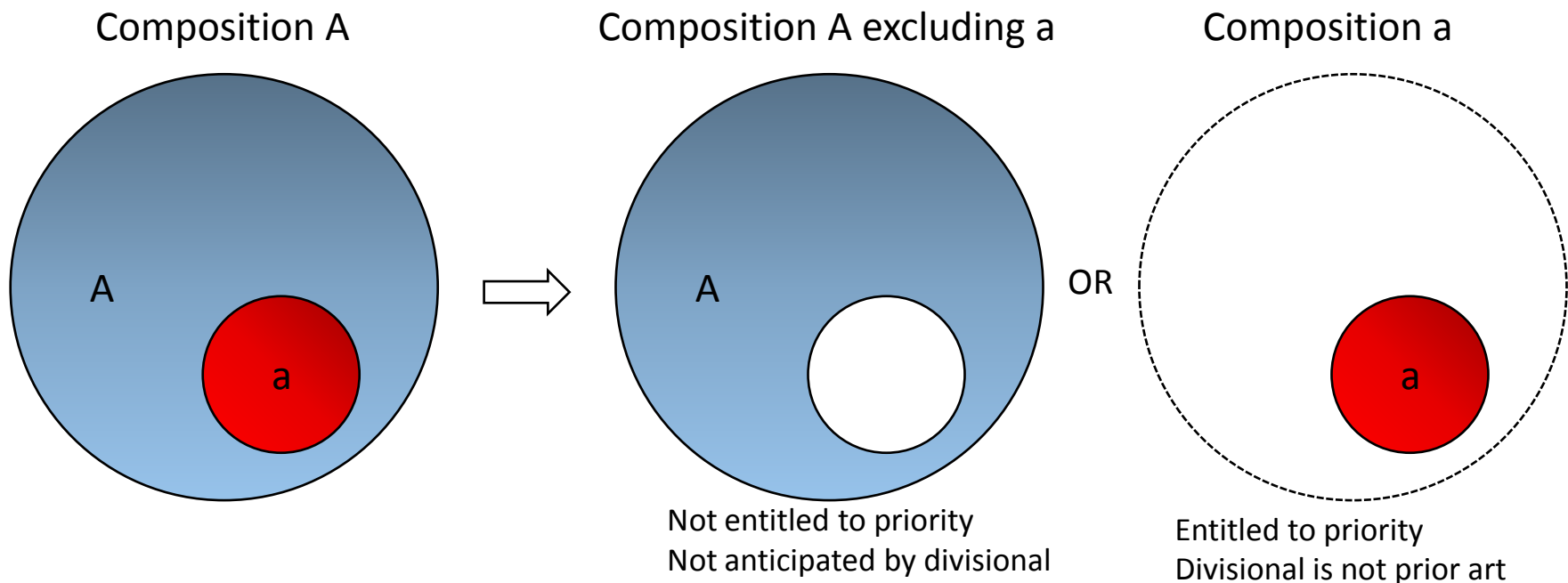
Narrower claim A'' not
entitled to priority P1
Not anticipated by A₁



5. Counter-measures: Multiple priorities

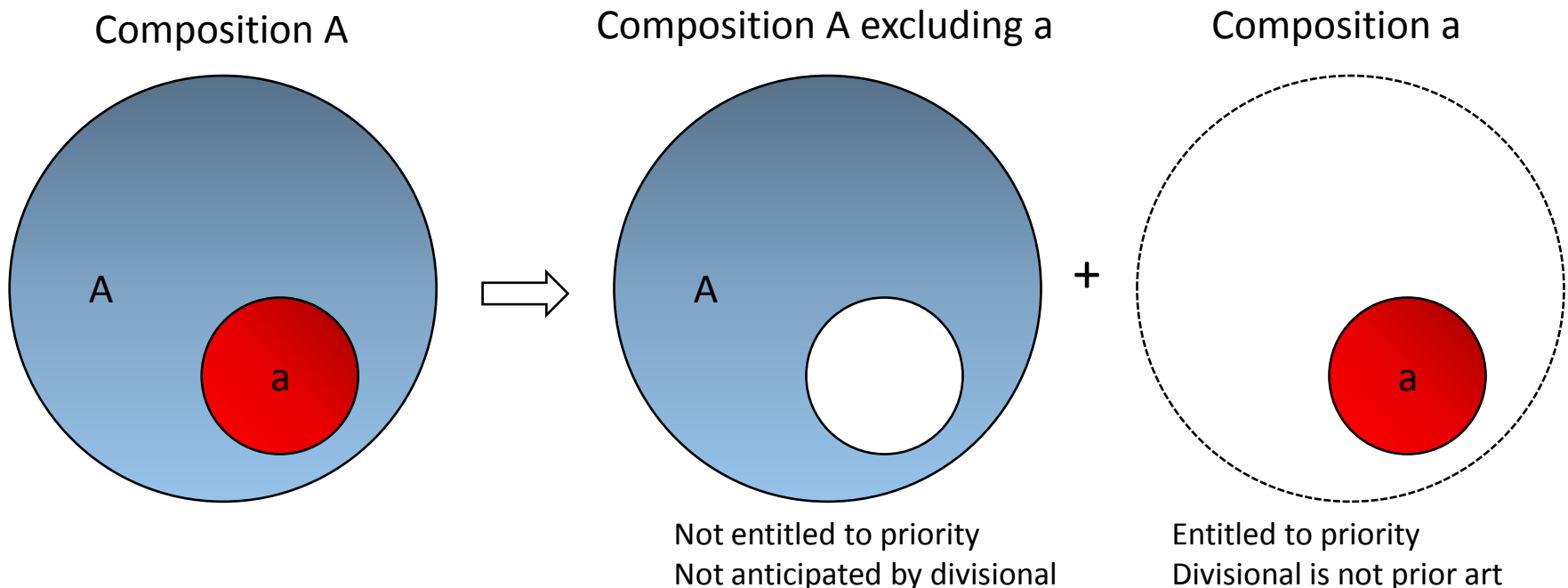
Under certain conditions – as explained in the previous presentation by Christopher Rennie-Smith – a claim can enjoy multiple priorities:

"Composition comprising A" could be re-written as: "Composition comprising (A excluding a) OR a" without changing the scope of the claim.



6. Counter-measures: Disclaimers

According to decisions G 1/03 and G 2/10 of the Enlarged Board of Appeal it is possible to introduce a “non-disclosed disclaimer” in a claim in order to restore novelty over a prior art reference under Art. 54(3) EPC.



7. Proposal: Detoxify Family Members

In a single patent application an embodiment in the description entitled to the claimed priority cannot “kill” a claim not entitled to this priority.

This situation should not change if the application is split up into a parent and a divisional application.

It is therefore suggested to exclude as earlier applications in Art. 54(3) EPC patent applications derived from the same European patent application (family members).