

Divisionals: a strategic and powerful tool for improving and safeguarding your patent rights

How and when to use this tool effectively

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In patent law, a divisional patent application is a type of patent application that derives from an earlier pending patent application ("parent") and claims subject-matter of said parent, while maintaining the same priority date, as required e.g. under Art. 76 and Rule 36 EPC. Divisionals can be mandatory – to overcome lack of unity objections by dividing the original application into separate divisionals each claiming a different part of the invention – or even voluntary, without a unity objection, claiming aspects originally disclosed in the parent and even claiming very similar subject matter as that of the parent. However, the subject-matter claimed in a divisional may not be identical (i.e. prohibition of double-patenting) or extend beyond the earlier parent.⁽¹⁾

Under European practice and also in many other jurisdictions, divisionals can be in turn split into further divisionals ("grandchildren" or "cascading divisionals") so that, even if the parent is withdrawn, refused or revoked, the invention remains protected in some way, unless the divisional is itself challenged.

Since divisional applications can be filed as long as the parent application is pending, the ability to file them even on a voluntary basis provides significant strategic advantages for Applicants because, although related to the parent, once granted, the divisional is its own independent patent.

In view of the above, voluntary divisionals turn out to be of particular strategic importance even with regard to "top tier" patents, i.e., those patents involving high-level or economically important technologies and ideas.

Although in new divisional applications it is not possible to add new subject matter but rather it is necessary to base the application on the whole content of the parent application, it is nevertheless possible to plan appropriately what to describe within the original application with the purpose of using it later to derive one or more divisionals.

For example, an Applicant can keep the initial filing costs relatively low by submitting a single application where aspects that might be independently protected in later stages via a voluntary divisional are already disclosed at an appropriate level of details. Here of particular relevance is how the original disclosure is drafted having in mind the future potential divisional.

Applying for voluntary divisionals, an Applicant may thus obtain multiple patents which protect different and independent embodiments of the same invention. Having a plurality of patent applications protecting different applications of a given technology can also facilitate licensing agreements, allowing exclusive licensing to multiple licensees.

A further advantage given by the divisional tool is also the ability to file, where the description of the parent application so permits, a divisional application whose claims are "tailored" to reflect a third-party solution which could be possibly in infringement. Thus, an Applicant may want to file a divisional application to obtain claims that capture a specific competitor.

A separate reason for divisional filings is to maintain pendency of the application family, for instance by claiming very similar or partially overlapping subject matter as that of the earlier patent. In fact, by strategically using divisionals, it is possible to keep the same or very similar subject-matter of the earlier application "pending" for as long as possible, up to even the full potential life of the parent application, for whatever reasons needed, be it strategic reasons related to competitors and market and/or procedural reasons related to how the examination is evolving.

In combination with the above, a divisional can also be a strategic way of disincentivizing competitors from entering the market, even if the patents themselves are never granted.

In fact, it is well known that it is easier for competitors to deal with granted patents, and thus with a well-defined scope of protection, than with pending applications in which the scope of protection is constantly evolving and, moreover, may in turn generate additional divisional applications. Therefore, keeping an application pending for a long time may create an obstacle, even if only temporary, to competitors.

A divisional can also be filed for defensive/precautionary purposes, such as when for a "top tier" patent there is an inkling that it might be subject to opposition proceedings once granted. In such a case, filing a divisional application prior to publication of the grant allows a right to the technology of interest to be kept alive even if the parent is then revoked.

Divisionals could be strategically filed each to protect specific and distinct aspects originally disclosed (e.g. a product, a device, an assembly, a whole apparatus, machine or plant, a manufacturing method, a method of using, the use of a substance, first and further medical uses): this might lead the competitors astray as to what would be the actual protection strategy and in particular the core aspects that are underlying the inventive idea.

This approach would put a heavy burden on the competitor, who finds himself in the position of having to invest resources in opposition and litigation procedures against multiple members of the same patent family, without actually excluding the risk of potential damages from a national court, even if the divisional patent is later revoked in a national proceeding or at the EPO.

According to EPO sources, historically about one-third of the opposition cases result in complete revocation of the patent, and about one-third or even something more result in some reduction of claim scope. Thus, oppositions before the EPO may represent an incumbent threat to the validity or scope of protection of patents.

Filing divisionals can thus be seen even as a "life insurance" for cutting edge technology patents or patents whose economic relevance is high, to survive in some way possible opposition and/or revocation actions and, ideally, they should be considered in the budget dedicated to patent protection of a specific and relevant project. This should be planned at an earlier stage in the life of a patent and might become relevant for instance during the examination procedure of the parent, when the "bell rings" and observations of a third party against the parent are submitted before the relevant Patent Office.

Special attention in this regard should also be given to the strategic use of divisionals in view of the new upcoming Unitary Patent (UP) and Unified Patent Court (UPC), under which, in the case of e.g. infringement or revocation actions, any decision relating to European Patents and Unitary Patents will take effect in one shot in all UPC member states.

For example, patents for which it is decided (because of various reasons) that they should fall under the UPC jurisdiction, could, as a precautionary measure, be subjected to one or more

divisional that, in contrast, are kept under the traditional European system via the “opt-out” under Article 83(3) UPCA, in order to avoid any centralized adverse effect. Or vice versa, opting-out the parent so that any litigation is handled before the national courts and let the divisional be subjected to the new UP/UPC system. Of course, the strategy should be tailored on a case-by-case approach and may also depend on the relevance and strength of the specific patent.

Therefore, if the patent could be seen as a theft protection device for your ideas, then the divisional could be seen as the “warranty” or “insurance” to be activated in order to keep your anti-theft system working as long as possible and “to protect your patent protection”.

All the above considered, it is thus clear that divisionals, besides being a procedural aspect useful to go around unity objections, are more and more becoming a powerful tool to implement strategies to protect relevant technologies and markets and thus improving competitiveness of companies. Their importance should not be underestimated and they should be carefully planned and introduced into the best practice approaches to protect ideas worldwide, especially now, at the dawn of the new UP/UPC system in Europe.

1. The right to file divisional applications is enshrined in Art. 4G of the Paris Convention.

