

# Kluwer Patent Blog

## T1496/11 – The mother of all self-collision?

Thorsten Bausch (Hoffmann Eitle) · Thursday, November 22nd, 2012

A recent Decision of the EPO's Technical Board of Appeal 3.2.05 found claims of a "mother" patent to lack novelty over the disclosure content of an EPO application that was a daughter (divisional) to the mother patent.

In many important jurisdictions, including the USA and Japan, Applicant's own earlier filed but later published patent filings cannot be used to attack the novelty of the subject matter claimed in a later filing that is put on file at the PTO before the PTO publishes the earlier filing. But under the EPC it is different. When it comes to "self-collision" the European Patent Convention Article 54(3) EPC is in a class of its own. No distinction is made between the earlier filings of "others" and the earlier filings of the same inventor. Those of the same inventor are just as effective as novelty-destroyers under Article 54(3) EPC. You could see this as the EPC's mechanism to stop "double patenting" and for denying Applicant the possibility to extend the maximum term of exclusive patent rights from 20 years to 21½ years.

For a thorough discussion of this difference between the EPC and the rest of the world, see for example the [24 September 2012 Report of the Tegernsee Experts Group](#).

A logical development of the laws under Article 54(3) EPC is that a divisional daughter application (Pd) at the EPO can be fatally toxic to the claims of the mother application (Pm) at the EPO. Likewise Pm can be fatally toxic to Pd, each application publication by the EPO prejudicing the patentable novelty of the other application.

This happens when both EPO applications claim priority to the same earlier application (under the Paris Convention) and the claim in view is not entitled to Convention priority. When the other application contains a disclosure of novelty-destroying subject matter which is entitled to that priority, that earlier-dated matter is prejudicial to the novelty of that claim. When the EPO publishes both applications Pm and Pd, each of those A publications is an "Article 54(3) publication" relative to the other of the two patent applications, Pm and Pd.

One can see that filing an EPO divisional application and taking it through to EPO A publication might be toxic to all the claims of both the resulting granted patents Bm and Bd.

Going back 20 years, few believed that Article 123(2) and 123(3) of the European Patent Convention could react together to deliver the explosive so-called Article 123(2)/(3) inescapable trap. But they could and they did.

Today, few believe that daughter divisionals could be fatal to their own mothers in Europe (or mothers their own daughters). But they can, as we see from [EPO Decision T1496/11](#). Unless the trend started by T1496/11 is reversed, Applicants and their legal advisers will need to be super-careful from now on, about whether even to file divisional applications at the EPO and, if so, with what claims. Once mother and daughter are both EPO-published, great care will be needed during EPO prosecution of the respective applications, to take to issue claims that are robust against novelty attacks based on the other of the respective publications.

If the killing fields of EPO opposition were not already brutal enough, they have just gone up another notch in brutality. T1496/11 and its progeny is going to put Applicants and their EPO representatives under even more pressure to “get it right first time” even back to the original drafting of the first filed priority application in the Applicant’s home country, before the Paris Convention priority year even starts. We suggest you think of the drafting of your priority date-defining patent applications as the first step in the patent litigation process.

Roy Marsh

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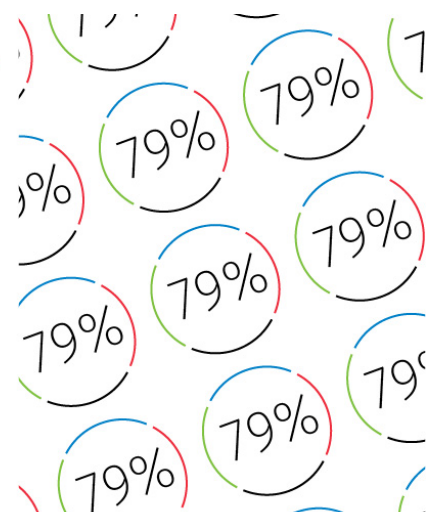
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