



**Dr Christopher Moore - Associate Director  
& Senior Patent Attorney**

**Tel: 0121 454 4962**

**Email: [christopher.moore@hlbbshaw.com](mailto:christopher.moore@hlbbshaw.com)**

**[www.hlbbshaw.com](http://www.hlbbshaw.com)**

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**Tactical use of divisional applications**

**Q My company has a single European patent application which is not yet granted and which covers our best-selling product. A competitor has launched a very similar product, which is taking market share from our product but which seems to be slightly different from how my invention is defined. Is there anything that I can do?**

A The writer is not the first person to have seen a competitor greedily eyeing a successful product and seeking to 'design around' any protection whilst taking the nub of the innovation and obtaining the benefit of at least some of the hard work of the originator (in fact that, in part, is a stated purpose of the patent system).

A patent will usually provide cover for a concept encapsulated in a product rather than the product itself. Therefore, the writer should first obtain a professional opinion as to whether or not the competitor's product falls within the scope of the existing patent application (specifically the claims).

If the writer is correct, and the competitor's product falls outside the scope of the claims, the next step is to carefully review the entire content of the patent application to identify any subject matter contained in the application that could support an alternative valid claim covering the competitor's product.

If a suitable alternative claim can be formulated, then a so-called 'divisional application' including this claim should be filed. A divisional application is an application derived from a pending patent application (parent application).

New, more restrictive rules for the filing of European divisional applications are coming into force on 01 April 2010. Under current rules, a divisional application may be filed at any time as long as the parent application is pending. As of 01 April 2010, the opportunities and

timeframes for filing divisional applications will be limited. Therefore, the writer should urgently seek advice from his representative as to the relevant deadlines in his case.

In any case, the writer would be well advised to investigate the possibility of filing a divisional application as soon as possible, since any action for infringement could not be brought against the competitor until after grant.

Once the divisional application is published the writer could then bring it to the attention of his competitor to potentially start the clock to receive damages from the competitor.

Therefore, the divisional application should be filed with a request for accelerated prosecution to ensure that the examination and grant process is conducted as quickly as possible.