

Client Advisory | February 2010

Changes to Divisional Application Practice Before the European Patent Office Enter Into Force on 1 April 2010

The EPO are introducing severe restrictions to the time limit for filing divisional applications on 1 April 2010. This change will have a significant impact on divisional practice and prosecution strategy in Europe.



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What will be the new time limit for filing a divisional application?

According to new Rule 36 EPC¹ this will be 24 months. This will start from either:

- (i) the first communication from the Examining Division concerning the earliest application – so called ‘voluntary division’; or
- (ii) a communication from the Examining Division in which a lack of unity objection is raised for the first time – so called ‘mandatory division’.

The application to be divided must be pending.

Search reports – such as those issued during the international (PCT) phase and search opinions do not trigger the time limits. The communication must come from the EPO Examining Division.

The notification of a summons to oral proceedings or the minutes of a telephone call or a personal interview can qualify as a trigger for the filing of a mandatory divisional application, provided that the finding of

lack of unity is raised for the first time on the occasion in question.

Is it possible to obtain an extension of time?

No. Further processing is also unavailable as a remedy.

When do the changes take effect?

The new rules only apply to applications filed on or after **1 April 2010**.

A 6 month transitional period will apply to those European patent applications on which the time limit will have already expired on 1 April 2010 making the deadline **30 September 2010**.

A 6 month transitional period will also apply to those applications on which the time limit has already been triggered. For these applications, the deadline will not expire before **30 September 2010**.

Which dates should be docketed?

If the actual deadline is not yet known then we recommend that a 24 month time limit is docketed from either:

¹ Rule 36 EPC:

- (1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:
 - (a) the divisional application is filed before the expiry of a time limit of twenty four months from the Examining Division’s first communication in respect of the earliest application for which a communication has been issued, or
 - (b) the divisional application is filed before the expiry of a time limit of twenty four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.
- (2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.

- (i) the date that the application either enters the European regional phase for a PCT application; or
- (ii) the date that the application is filed for a straight European patent application.

This will ensure that any decisions on filing of divisional applications are taken well in advance of the actual deadline.

Will I still be able to file a divisional of an already divided patent application?

We see no reason why this will not be possible as long as the further divisional(s) is filed in time.

For 'voluntary division', the 24-month time limit is calculated from the date on which the Examining Division's first communication is issued for the **earliest** application in the sequence. Importantly, the 24 month time limit triggered by the first communication from the EPO Examining Division on the earliest application triggers the time within which **all** divisional applications must be voluntarily filed.

If the time limit for voluntary division has expired then the mandatory divisional route could still be used if there is a 'genuine' lack of unity in the application and this time limit has still not expired.

Filing strategy

We have devised various strategies which we believe may reduce the impact of these changes on Applicants. If you would like further information in this regard then please contact us.

Practical implications of the rule changes

- Future decisions concerning the filing of divisional applications will need to be taken at a much earlier stage in prosecution.
- The rule change will severely limit the opportunity to file a divisional application in order to maintain prosecution options in advance of a possible refusal or withdrawal of the application. Thus, refusal of an application will need to be taken to appeal.
- The filing of further divisional applications (either from an original application or a divisional application) will be severely affected. The 24 month time limit (for voluntary division) is calculated from the date on which the Examining Division's first communication is issued for the **earliest** application in the sequence. Thus, all applications in the sequence will have to be filed within this 24 month time limit.

Recommendations

- We suggest that existing applications are reviewed to identify any

divisionals that need to be filed well in advance of the deadline.

- We expect a deluge of applications to be filed at the EPO as the 1 April 2010 and 30 September 2010 deadlines approach. Inevitably, this will result in a (further) delay in proceedings. For some cases, this delay may be advantageous and so we would recommend filing one or more divisionals closer to the 30 September 2010 deadline. For those cases on which a delay is undesirable, consideration should be given to filing well in advance of the deadline.
- Due consideration should be given to filing parallel applications in Europe with claims of differing scope at the outset (or at least within the 24 month time limit for division), to minimise the impact of these procedural restrictions.
- For some applications, it may be appropriate to be more proactive during prosecution to maximise chances of obtaining the Examining Division's view on an application before the time limit for filing divisionals has expired. Thus, for example, active engagement with the Examiner, early responses to Examination Reports and accelerated examination may be useful to expedite prosecution.

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