

Client Advisory | April 2009

European Patent Office to introduce severe restrictions on the filing of divisional patent applications - a fundamental change in European patent practice

On 26 March 2009 the Administrative Council of the European Patent Office (EPO) voted in favour of changes to amend at least one of the rules governing the filing of divisional applications.¹ A 2 year time limit within which a divisional application can be issued is being introduced.



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This time limit will be triggered from either: (1) the date that the first examination report is issued on the first parent application; or (2) the date of the Examining Division's lack of unity objection in the earlier application. This is a severe restriction and will have fundamental and far-reaching consequences on European patent practice. Applicants should identify their requirements for divisional applications now in preparation for this change.

Background

Whilst decisions G1/05 and G1/06 from the Enlarged Board of Appeal (the highest authority at the EPO) back in 2007 largely confirmed the liberal divisional practice in Europe², the issue of the abuse of divisional applications was raised.³ The Enlarged Board found it unsatisfactory that, for example, sequences of divisional applications, each containing the same broad disclosures of the original patent application, could be pending for up to twenty years. Administrative measures were not considered to be able to prevent the filing of abusive divisionals. Additional legislative restrictions are therefore being introduced.

The rule change

At present, Rule 36(1) EPC states that:

1. *The applicant may file a divisional application relating to any pending earlier European patent application.*

Amended Rule 36(1) EPC will read:

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 24 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 24 months from a communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC.*

Thus, according to amended Rule 36(1) EPC, there will be:

- (a) time limit of 2 years from the first examination report in the first parent application to file a divisional application; or
- (b) a time limit of 2 years from a communication in which the Examining Division has objected that an application lacks unity of invention to file a divisional application.

Implementation of the rule change

The EPO has not yet announced when or how this rule change will be implemented.

The Administrative Council document on the proposed changes (CA/145/08Rev1)⁴ which was published in January 2009, mentions an implementation date of 1st April 2010.

Possible Transitional arrangements

The final transitional arrangements have not yet been announced. However, in document CA/145/08Rev1 it is proposed that:



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- the amended Rule 36(1) EPC will apply only to divisional applications filed after its entry into force;
- if the time limits have expired before the date on which the amended rule enters into force, a divisional application may still be filed within six months as from that date;
- if the time limits are still running on the date on which the amended rule enters into force, they will continue to do so for not less than six months.

Recommendations

1. On important cases for which divisional applications are going to be filed, due consideration should be given to filing these divisionals now. We expect that many divisional applications will be filed around April 2010, resulting in extensive processing delays.

2. If benefit from the expected delays is desired, we would recommend considering filing divisional applications just before 1st October 2010, or six months after implementation.
3. Applicants should consider routinely filing a response to the 'extended European Search Report' issued by the EPO. This will stop the EPO from issuing a first Examination Report after a few months which simply refers to the content of the extended European Search Report. Filing a substantive response at this stage will mean that the issuance of the first Examination Report and the trigger for the start of the two year time limit will be delayed.

Further updates on this important change will be issued as we find out further information. In the meantime, if you have any specific questions or require advice then please let us know.

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¹ A divisional patent application is based on an earlier (parent) application and takes on the effective priority/filing date of that earlier application. The earlier application may itself be a divisional application. A divisional is treated as new European patent application and its procedure is in principle independent from the parent application. Under current practice a divisional application can be validly filed up until the day before the mention of grant of the parent is published.

² These decisions can be downloaded from: <http://www.epo.org/patents/appeals/eba-decisions/referrals/date.html>

³ Divisional applications have formed an important and flexible tool in European IP strategy. For example, they can be used to respond to a lack of unity objection during examination or to capture subject matter which was not claimed in the earlier application. They can also be filed: (i) as a precautionary measure in case of refusal at oral proceedings before the Examining Division; and (ii) to maintain the pendency of an application for the full patent term. It is these latter ('abusive') uses of divisional applications that have prompted this significant shift in EPO practice.

⁴ Available from: <http://www.sipf.se/admin/photo/big/hearinginbjudan/CA14508Rev.1.pdf>

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