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Changes at the EPO I – Divisional Applications

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1. Introduction

From April 1, 2010, the opportunities for filing a divisional European patent application under the European Patent Convention (EPC) will be limited. Applicants will no longer have the opportunity to file a divisional at any time during pendency of an application. This major change in the proceedings is part of the project “Raising the bar” of the European Patent Office (EPO) for improving overall quality and enhancing legal certainty while ensuring that the legitimate rights and expectations of the applicants are fully served.

Divisionals are used to claim non-unitary subject-matter of a parent application. However, divisionals may also be filed just before grant of a parent application as a precautionary measure in the case an opposition against the parent patent is expected. Further, divisionals may be filed during examination shortly before oral proceedings. When oral proceedings fail, instead of appealing the negative decision, the divisional can be prosecuted and the examination starts all over again. Divisionals may also be filed to keep an application pending while the claims of the divisional can still be tailored to an infringing product or process. Divisional applications may themselves be divided into further divisional applications.

By decision of March 25, 2009, the Administrative Council of the European Patent Organisation amended Rules 36(1) and (2) EPC as to the requirements for filing European divisional applications. In addition to the present requirement of the pendency of the parent application, the Administrative Council now has set time limits within which voluntary or mandatory divisionals can be filed.

2. Voluntary Division

Amended Rule 36(1)(a) EPC provides that a divisional application may be filed on the basis of a pending earlier application before the expiry of a time limit of 24 months from the Examining Division's first official Communication, i.e. the first examination report under Art. 94(3) EPC or, where appropriate, the “notice of acceptance” under Rule 71(3) EPC. After the expiry of the 24-month period, the applicant, of his own volition, may not file a divisional application anymore.

In the case of a sequence of European divisional applications, the 24-month time limit is to be calculated from the date on which the Examining Division's first Communication was issued for the earliest application in the sequence, e.g. the (grand) parent application.

3. Mandatory Division

Under new Rule 36(1)(b) EPC, a divisional application may be filed on the basis of a pending earlier application before the expiry of a time limit of 24 months from any Communication in which the Examining Division raises a unity objection, with the provision that this finding of lack of unity is raised for the **first time** in said Communication. A non-unity objection is usually raised in the Examining Division's first official Communication. The confirmation of a finding of lack of unity in a subsequent Communication from the Examining Division does not cause the period for filing a mandatory division to start again.

Thus, if in an Examination report a non-unity objection is raised, one needs to check whether this non-unity objection has been raised for the first time (and triggers the 24-month limit of Rule 36(1)(b) EPC), or whether this objection has already been raised in an earlier Communication (and the 24-month limit of Rule 36(1)(b) EPC is already running or has expired).

However, a new non-unity objection (i.e. a non-unity objection concerning different subject-matter) raised in a later Communication starts a new 24-month limit for filing a corresponding mandatory divisional application under Rule 36(1)(b) EPC.

By deliberately filing non-unitary claims a new non-unity objection may be provoked, causing subject-matter to be pending longer. Consider, for example, a case where within the 24-month limit of Rule 36(1)(a) a voluntary divisional application with non-unitary claims which are different from the claims of the parent application is filed. These claims should provoke a new non-unity objection, from which a new 24-month term for filing a mandatory divisional application under Rule 36(1)(b) EPC begins. Since this action may be considered to undermine the EPO's intention of limiting opportunities for filing a divisional application, we do not advise that applicants count on this option of extending the 24-month time limit.

The summons to oral proceedings or a telephone call or a personal interview can also 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 respective occasion.

4. Exemplary Examination Procedure under new Regulations

The implications of new Rule 36(1) EPC are discussed on the basis of an exemplary examination procedure as depicted in Figure 1. A patent application (parent) apparently describing and claiming three inventions (I1, I2 and I3) is filed. In the first official Communication a

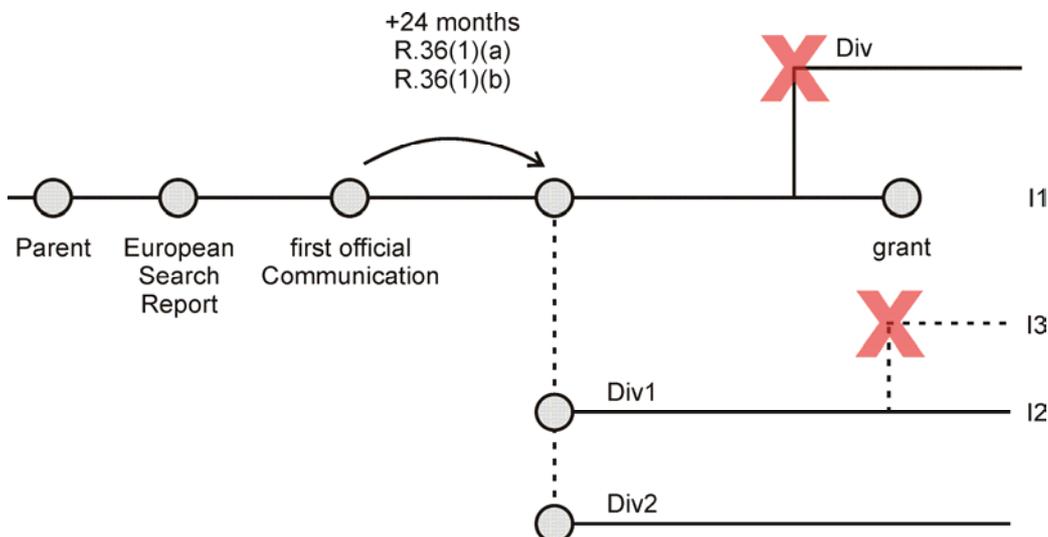


Figure 1 Implications of new Rule 36(1) - Exemplary examining procedure

non-unity objection has been raised. With receipt of this first Communication, the 24-month term for filing a voluntary divisional application under Rule 36(1)(a) EPC as well as the 24-month term for filing a mandatory divisional application under Rule 36(1)(b) EPC is started. Thus, 24 months remain for filing divisionals (Div1 and/or Div2) to the further invention I2 and/or I3.

The option of filing a divisional application just before grant or just before oral proceedings during examination procedure after the 24-month period is not available anymore.

Furthermore, it will not be possible anymore to split off a further divisional application from, for instance, Div1, because the 24-month time limit of Rule 36(1)(a) EPC is calculated from the date on which the Examining Division's first Communication was issued for the earliest application in the sequence, i.e. from the date of the Communication under Art. 94(3) EPC of the parent application.

5. Transitional Provisions

The amended version of Rule 36 EPC will apply only to European divisional applications filed after its entry into force, i.e. on or after April 1, 2010.

If the time limits provided for in amended Rule 36(1) EPC have expired before April 1, 2010, a divisional application may still be filed within 6 months of that date, i.e. until October 1, 2010.

If the relevant time limits are still running on April 1, 2010, they will continue to do so for not less than 6 months.

6. Further Remarks

Language Requirements

According to current Rule 36(2) EPC, the divisional application shall be filed in the language of the proceedings of the parent application. Under amended Rule 36(2)

EPC, if the parent application was not in an official language of the European Patent Office, a divisional application may be filed in the language of the earlier application. A translation into the language of the proceedings for the earlier application must then be filed within two months of the filing of the divisional application.

Means of Redress

The legal consequence of non-compliance with the 24-month time limit is that the application cannot be treated as a European divisional application. It will not be possible to request further processing if the applicant fails to observe this 24-month time limit (Rule 36(1) EPC) or the time limit for filing the necessary translation (Rule 36(2) EPC). However, re-establishment of rights may be possible.

7. Summary

Voluntary divisional applications may only be filed for pending applications within a time limit of 24 months after receipt of the first examination report.

Mandatory divisional applications may be filed within a time limit of 24 months after the receipt of the first non-unity objection, for example in an examination report.

The new Rules apply for all divisional applications filed after April 1, 2010.

If the time limits provided for in amended Rule 36 (1) EPC have expired before April 1, 2010, a divisional may still be filed until October 1, 2010.

If the relevant time limits are still running on April 1, 2010, they will continue to do so until at least October 1, 2010.

Applicants are advised to examine all of their pending applications carefully to assess whether divisional applications should be filed. In any event, for all pending applications the filing of a divisional application will be possible until October 1, 2010.