

The EPO has introduced significant changes to the rules governing when and under what conditions a divisional application may be filed. The new rules will take effect as of 1 April 2010 and will impact the way patent applicants using the EPO handle their patent portfolio.

The rules have been introduced in a Decision of the Administrative Council (CA/D 2/09), the full text of which can be found here:

<http://www.epo.org/patents/law/legal-texts/decisions/archive/20090325.html>

The EPO has also issued a Notice dated 20 August 2009 to provide further information on these changes. It also advises that Rule 135(2) EPC has been amended to explicitly exclude further processing of the time limits for filing a divisional application. The Notice can be found at:

<http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090820.html>

### **What has changed?**

The current law states that a divisional application may be filed from an earlier European patent application at any time whilst the earlier application is pending before the EPO. However, in addition to this requirement, as of 1<sup>st</sup> April 2010, divisional applications may only be filed if at least one of the following conditions applies:

**R36(1)(a): the divisional application must be 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

**R36(1)(b): the divisional application must be 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 EPC (unity of invention), providing it was raising that specific objection for the first time.**

The Notice clarifies the meaning of “earliest” and “earlier” application, found in new Rule 36.

The “earliest” application is the initial filing in that family (which could be a parent or grandparent) whereas the “earlier” application is the immediate parent from which a divisional has been divided. These could be one and the same application if the divisional application in question is a first generation divisional.

## How will this work in practice?

### 'Voluntary' division

R36(1)(a) means that, in practice, an applicant for a European patent application must decide whether to file any voluntary divisional applications **within 24 months of the date of the issuance of the first examination report under A94(3) in respect of the earliest application**. If the Examining Division has no objections to the patent application such that the first communication issued by the Examining Division on any of the applications is that indicating **the intention to grant a patent**, any voluntary divisional must be filed **within 24 months of the date of the Communication under R71(3) EPC**. In either case, divisional applications must be filed **prior to grant or withdrawal or refusal of the patent application to be divided**.

Note that **the Extended European Search Report (EESR) is not considered to be the first communication from the Examining Division** as this is currently issued by the Search Division and not the Examining Division. However, if the applicant has waived the right to confirm that he wishes to proceed with examination before he is in receipt of the search report, the search opinion will not issue. In this case, the first communication will be from the Examining Division, which will trigger the 24-month time period.

The new rule applies regardless of the content of the examination report.

### 'Mandatory' division

R36(1)(b) is intended to allow the filing of divisional applications in response to the first objection from the Examining Division to a lack of unity in the claims of an application, even if the twenty-four month period provided for in R36(1)(a) above has expired. This may occur, for example, if the objection is raised in a second examination report on the earliest patent application for which a communication has been issued. As with R36(1)(a), if the search opinion of an EESR includes a lack of unity objection, this will not trigger the 24-month period.

Another situation in which this second time limit might take effect is if, having filed a first divisional application, the Examining Division issues an examination report under A94(3) on that divisional application that includes an objection that the claims do not meet the requirements for unity of invention. If that objection of a lack of unity is being raised for the first time (whether on the earliest parent application or on the divisional application) then the issuance of that examination report will trigger a separate period of twenty-four months in which to file a further divisional application (i.e. second generation divisional application) from the disclosure of the first divisional application.

Note that this period will not be triggered unless the Examining Division objects to a specific lack of unity of the claims for the first time. If the same objection has already been raised in a previous communication (other than the EESR, see above), even if it was raised on the parent application of a pending divisional application, then the further time limit will not be triggered.

If either of these time limits for filing divisional applications is missed, further processing under Article 121 EPC will not be available. However, re-establishment of rights under Article 122 EPC remains available as a legal remedy.

## How are the new rules likely to affect my patent strategy?

The most noticeable difference for many applicants is that in most cases it will no longer be possible to file so-called 'placeholder' divisional applications ahead of Oral Proceedings to keep an application pending at the EPO regardless of the outcome of the Oral Proceedings. This is because, in most cases, it is unlikely that Oral Proceedings would be held in respect of a patent application within the twenty four month period under R36(1)(a) EPC.

The cost of filing divisional applications will in many cases be brought forward as applicants will no longer as a matter of course be able to delay the filing and back-renewal fee costs until the parent application is about to grant or be withdrawn or be refused.

## What can I do about it now?

### Review current cases now for possible required divisional applications

The new rules will apply to the filing of all divisional applications on or after 1st April 2010. This includes divisional applications divided from parent applications that are already pending as of 1<sup>st</sup> April 2010. Consequently, come 1st April 2010, some of the triggers for calculating the deadline for filing divisional applications may have already occurred (for example the first communication may have already issued on the parent, hence starting a 24-month time limit as described above).

However, the EPO is providing a 6-month grace period for filing divisional applications divided from parent applications already pending as of 1st April 2010. Therefore, it will still be possible to file a divisional application until 1st October 2010, even if the time limit for filing a divisional has already expired or partially expired. In any case, the parent application must be pending in order to file a divisional application. We therefore recommend that concerned applicants contact their usual Kilburn & Strode advisor for a review of their cases.

If you are unsure about any of the rule changes and how they may affect you, or if you wish to discuss potential strategies for patent prosecution under the new rules, please contact your usual Kilburn & Strode advisor.