

Intellectual Property Alert: Reduced Time Limits for Filing Divisional Applications at the European Patent Office

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Currently, divisional applications can be filed at any time whilst the parent case is pending. Earlier this year, however, the Administrative Council of the European Patent Office (EPO) approved amendment of Rule 36(1) EPC to introduce the additional requirement that any divisional application must be filed by the later of:

1. before the expiry of 24 months from the Examining Division's first communication in respect of the earliest application (where there is a sequence of applications) for which a communication has been issued; or
2. before the expiry of 24 months from an Examining Division objection that the earlier application lacks unity of invention, providing it was raising that specific objection for the first time.

The amendment to Rule 36 arises from a perception by the EPO and other official bodies in Europe that applicants are abusing the current divisional application procedure by filing divisional applications to achieve a "duplication" of proceedings, and to prolong the pendency of subject matter before the EPO. They say this creates uncertainty for third parties and increases the EPO's workload. The EPO hopes that the new rule changes will prevent the filing of "abusive" divisionals without affecting what it views as legitimate divisional applications, such as those filed in response to a lack of unity objection.

Amended Rule 36 will, in many instances, significantly reduce the period available for the filing of divisional applications. Thus, under the new Rule, any divisional application will generally need to be filed within 24 months of the first communication of the Examining Division or, where there is a sequence of cases (*i.e.*, where one or more divisional applications have been filed), within 24 months of the Examining Division's first communication in respect of the earliest application for which a communication has been issued. Accordingly, if an applicant wishes to file a divisional of a divisional application, then the deadline for doing so will generally be within 24 months of the first communication of the Examining Division issued on the initial parent application. Note that it is the first communication from the Examining Division which triggers the 24-month time limit, and not, for instance, a Written Opinion accompanying the International Search Report, an International Preliminary Examination Report, or a "Search Opinion" accompanying a Search Report.

Unfortunately, there are some uncertainties about how new Rule 36 will be interpreted and applied. For instance, whilst Rule 36(1)(b) may, in a limited number of circumstances, extend the period available for filing a divisional application, its precise interpretation is unclear. It has been suggested that Rule 36(1)(b) could be interpreted so that the extended time limit would only be triggered by the very first lack of unity objection. However, in the light of the reference to "that

specific objection,” it seems probable that the alternative interpretation of Rule 36(1)(b) will be adopted, *i.e.*, that each new lack of unity objection will trigger the extended time limit.

However, the latter interpretation does not mean that claims can be amended at any time to specify a further invention with the aim of prompting a new lack of unity objection, and extending the deadline available under Rule 36(1)(b). This is because Rule 137(4) EPC provides that claims cannot be amended after filing to include unsearched subject matter, unless there is unity of invention with the originally searched subject matter. Thus, any such attempt to prompt a new lack of unity objection will almost certainly be met by a Rule 137(4) EPC objection. Also, Rule 137(2) EPC and Rule 137(3) EPC provide that an applicant can only amend the claims at his or her own volition after receipt of the European Search Report, or at the same time as responding to the first communication from the Examining Division. Further, on 1 April 2010, amendments to Rule 137 EPC are due to come into force and these amendments place further restrictions on the making of voluntary amendments.

In light of the new provisions, applicants may wish to request accelerated examination and reply promptly to all communications from the EPO. The aim would be to increase the likelihood of the Examining Division coming to its final decision on the allowability of the claims within the 24-month period, so that the applicant knows the claim scope that will result from its application. The applicant will then be in a better position to decide if a divisional or further divisional application should be filed. This strategy may be particularly useful in light of the fact that it is not unusual for significant periods of time to pass between examination reports.

The new rules are also likely to encourage applicants to file “precautionary” divisional applications at the 24-month stage, because applicants will be wanting to safeguard against unexpected developments that may occur late in examination proceedings. For instance, newly cited prior art, fresh objections, third-party observations, and the unpredictability of Oral Proceedings can all result in narrower claims than might otherwise have been expected or desired.

Where an application contains multiple inventions that do not comply with the EPO’s unity of invention requirement, applicants may wish to file corresponding divisional applications in parallel, with each being directed to one of the inventions. This contrasts with practice under the current rules, where the filing of divisional applications is typically staggered, because the decision on the number of divisionals to file (and the associated costs) can be easily deferred by filing successive divisionals of divisionals on an as-needed basis.

The proposed amendments will apply to both direct European applications and to ex-Patent Cooperation Treaty applications. The new rule is proposed to come into force on 1 April 2010, and will apply to all divisional applications filed on or after that date.

Transitional provisions are as follows:

- If the Rule 36(1) EPC time limits have expired before the date on which the new rule enters into force, a divisional application may still be filed within six months as from that date.

- If the Rule 36(1) EPC time limits are still running on the date on which the new rule enters into force, they will continue to do so for not less than six months.

Further processing cannot be used for the late filing of divisional applications.

In light of the above changes, we will shortly be contacting our clients who have pending European filings handled by our London office with a proposal to review their European patent portfolios and to identify the relevant time limits under the new rules.

If you would like more information or have any specific concerns about any of your European patent applications, please contact:

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