

European Patent Office Introduces Time Limits for Filing Divisional Applications

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On 26 March 2009 the Administrative Council of the European Patent Office (EPO) voted to introduce a time limit to restrict the filing of divisional European patent applications. The restriction takes effect on 1 October 2010 and applicants are recommended to complete a review of their pending European patent applications before then.

Currently, an applicant for a European patent may file a divisional application up until the grant of a parent application. Cascading divisional applications may be filed indefinitely, potentially allowing an applicant to maintain a series of pending divisional applications until 20 years from the filing date.

However, the EPO has now decided to introduce a time limit restricting the filing of divisional applications. The time limit, defined by an amended Rule 36 EPC, runs from (a) the issuance of a first communication from the Examining Division in respect of the earliest application for which a communication has been issued, or (b) any communication from the Examining Division in which an objection of lack of unity is raised, provided that the communication was raising that specific objection for the first time. These two deadlines are presented as independent of each other.

The first part of Rule 36 sets a time limit on the voluntary filing of divisional applications i.e. where no disunity objection has been raised. The time limit of two years is determined by a first application in a sequence of divisional applications and applies to all applications in the sequence. For example, where a divisional application is filed from a parent application and subsequently a 2nd generation (grandchild) divisional application is filed from the divisional, the two year time limit is determined from the issuance of an Examination Report on the parent application. Concerns have been raised by some that the expression "first communication from the Examining Division" could include the written opinion which is included in extended search reports; in our opinion this is unlikely and it is not suggested in the commentary which the EPO submitted to the Administrative Council.

The second part of Rule 36 sets a time limit of the mandatory filing of divisional applications necessitated by the raising of a lack of unity objection. The time limit is determined from the date a lack of unity objection is raised for the first time. For example, if new prior art is cited late in the examination procedure which causes a posteriori lack of unity objection, then the objection sets a new two year time limit for the filing of a divisional application. It is hypothesised that in cases where the two year limit set by the issuance of a first communication has passed then applicants wishing to file a divisional application may attempt to provoke the EPO into raising a new lack of unity objection, for example by filing an amendment containing multiple independent claims relating to different inventions. However, Examiners may rely on Rule 137 EPC which allows an Examiner to exercise discretion in accepting amendments filed later than in response to the first Examination Report.

There is no express prohibition against creating cascading divisional applications by including in a divisional application new claims which will create a fresh disunity objection. Equally, in the case of mandatory divisional applications, there is no express requirement that the divisional be limited to the subject matter identified in the examination report against the parent. The EPO will doubtless wish to prevent applicants adopting such practices and it remains to be seen how the law will develop.

The new Rule 36 will be introduced from 1 April 2010 and will have a six month transitional period until 1 October 2010 during which the filing of divisional applications will be permitted in respect of applications where the new time limits would have already expired and in respect of applications where the new time limits expire during that period.

HGF is considering what systematic action to take in response to the impending rule change. In the meantime, it is recommended that applicants and their representatives should consider whether any divisional applications are likely to be required in respect of already pending applications and ensure that these are filed by 1 October 2010. If you have any questions or wish to obtain advice in relation to the implementation of new Rule 36 then please discuss this with your usual contact at HGF.

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