

Practice Note for Divisional Applications at the European Patent Office

Introduction

Under current European Patent Office (EPO) practice the legal framework only requires that the parent application is pending at the time the divisional application is filed.

The Administrative Council of the European Patent Organisation has recently agreed to a proposal from the EPO to introduce time limits for the filing of divisional applications.

These new rule changes will have potentially serious implications in filing strategies and obtaining adequate claim protection for Applicants at the EPO.

Rule Changes

As of April 1, 2010, Amended Rules 36 and 135 EPC come into force requiring that a divisional application will have to be filed within 24 months from either:

- the very first communication from the Examining Division (Article 94(3) EPC) in respect of the earliest application in a family or chain; or
- any objection of lack of unity of invention (Article 82 EPC) in respect of any application within the family.

Divisional applications on the Applicant's own initiative (so-called voluntary divisional applications) will thus need to be filed within a period of 24 months from the first communication (or first office action) by the EPO examining division in respect of the parent (i.e. the previous) or an even earlier (in case of a "chain" of applications) application.

Divisional applications filed as a reaction to a lack of unity objection (so-called mandatory divisional applications) will thus also have to be filed within 24 months from the communication in which the relevant objection is raised by the examining division for the first time.

This almost certainly restricts the option of filing a divisional from a divisional application in future, as it is very likely that the first official communication on the original parent application will have issued over 24 months previously. In effect, Applicants will have to decide much sooner whether to file one or more divisional applications during prosecution of the original parent application.

Transitional Provisions

The transitional provisions shall apply to the amended provisions under new Rule 135 EPC.

If the time limits provided for in amended Rule 36(1) EPC have expired before 1 April 2010, a divisional application may still be filed within six months of that date. If they are still running on 1 April 2010, they will continue to do so for not less than six months.

In other words there will be a grace period until **October 1 2010** within which to file any divisional application, irrespective of the new time limits that come into force on April 1, 2010.

Consequences

The consequences of the above Rule changes will restrict Applicant's options greatly, especially where independent protection is sought for different features in the same claim category.

We advise that Applicants review important patent families for applications before the EPO and make a strategic decision whether additional divisional applications are required, well before the **October 1 2010** deadline.

If you require further information on the proposed changes please contact info@purdylucey.com