

EPO RESTRICTS THE FILING OF DIVISIONAL APPLICATIONS

The European Patent Office (EPO) has announced that the time limit for filing a divisional application from a European patent application is to be restricted. This change is likely to have a significant impact on prosecution strategies in Europe for many applicants.

Currently a divisional application can be filed from any pending European patent application. In other words, any divisional application must be filed before the existing ("parent") application is granted, refused or withdrawn. This typically means that the applicant can retain the option of pursuing protection for any invention disclosed in the parent application for many years after the initial filing date.

However when the new rule enters into force, any divisional application will normally need to be filed within 2 years from the first communication from the Examining Division on the parent application. The first communication from the Examining Division is usually the first substantive examination report, which sets out detailed objections raised against the application. The "Search Opinion", which may include possible substantive objections but is issued earlier together with the Search Report, does not appear to start the 2 years time limit.

The only exception to this is where the Examining Division issues an examination report which contains an objection of lack of unity. An objection of lack of unity is raised where the Examiner considers that the claims relate to multiple inventions which are not linked by a single inventive concept. In this case, the applicant is allowed to file a divisional application within 2 years from the first communication raising that lack of unity objection. So this provision can only extend the period for filing a divisional application

where a lack of unity objection is raised for the first time after the first communication from the Examining Division on the parent case.

It is important to note that the 2 years time limit for filing divisional applications starts from the first communication from the Examining Division on the earliest related application. Therefore in the case of a series of divisional applications, where later divisional applications are divided from earlier divisional applications, all divisional applications must still be filed within 2 years from the first communication on the original parent case.

In addition to these new time limits, the previous requirement that the parent application must be pending at the time of filing the divisional application still stands. So any divisional applications must be filed before the parent application is granted, refused or withdrawn, even if this is less than 2 years from the first communication from the Examining Division on the parent. The new rules apply to divisional applications filed on or after 1 April 2010. However the EPO has adopted transitional provisions which mean that a divisional application can still be filed on any pending European patent application until 1 October 2010. After that date, it will no longer be possible to file a divisional application on any application where more than 2 years have elapsed since both the first communication from the Examining Division and any later non-unity objection.

This means that applicants will need to review their portfolios to identify currently pending European applications where one or more divisional applications may be required at some stage. For many currently pending cases, any divisional applications will need to be filed by 1

October 2010, because the 2 year time limit will have already expired by this date.

In future decisions concerning the filing of divisional applications will need to be taken at a much earlier stage in prosecution. The rule change is also expected to severely limit the opportunity to file a divisional application in order to maintain prosecution options in advance of a possible refusal or withdrawal of the parent application. This may lead to an increase in the number of applicants choosing to take refusals of an application to appeal.

For further information please contact your usual D Young & Co adviser.

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