

Divisional patent applications in the EPO

Restricted timeframe of 24 months for filing European divisional patent applications from 1st April 2010.

Background

Influenced by recent developments, the Administrative Council of the EPO decided on 25th March 2009 to amend the Implementing Regulations of the EPC to apply restrictive time limits on the filing of divisional patent applications. At present, the sole restriction on the time of filing of a divisional is that the parent application must be pending. There has been criticism, from some quarters, of the current practice which permits the filing of a divisional towards the end of the prosecution cycle of a pending application and has led to "chaining" of successive divisionals, said by some critics to lead to legal uncertainty.

New Rules

The new rules only affect the time of *filing* of a divisional application, not its substantive content. At the time of filing the divisional, it will remain a requirement that the parent application is pending.

There will be two alternative trigger points which will set running a 24 month period in which a divisional application can be filed:

- the first communication from the Examining Division, or
- a specific lack of unity objection raised for the first time.

It is important to note that, in the first case, where the parent application is already a divisional, the first communication from the Examining Division in the earliest ancestor application sets the 24 month period running.

Alternatively, the trigger point may be a communication from an Examining Division raising a new specific objection of lack of unity of invention for the first time. The amended rule does not require that any divisional relates to one of the non-unified inventions identified in such a communication.

Since an International Search Report (ISR) or International Preliminary Examination Report (IPER) drawn up by the EPO is not considered a communication from the Examining Division, these events are not, we understand, triggers for the 24 month period.

Further processing will **not** be available in relation to the 24 month period.

It will now be important, if it is possible that a divisional might be needed, to record carefully the due date for filing any such divisional.

Applications Affected

The new rule will apply to all European applications pending at the time the rule enters force. The 24 month period will effectively apply to those applications where a first communication from the Examining Division or a new specific lack of unity of invention objection was issued after **1st October 2008**, either on that application or on any ancestor application, in the case of a "chain" of applications.

In relation to applications where a first communication from the Examining Division or a new specific lack of unity of invention objection was issued before 1st October 2008, transitional provisions will apply and any new divisionals must be filed by 1st October 2010 at the latest.

We would therefore strongly suggest that you consider reviewing your pending European patent applications to establish whether a divisional might be required and recording the deadline for filing any such divisional. We will, of course, be pleased to assist you with that process, if required.

We are also anxious that our clients take account of the rule change in a measured fashion to prevent the need for large filing volumes in the weeks and days leading up to 1st October 2010.

Need advice?

Please do not hesitate to contact us for more detailed advice at: email@carpmaels.com.

Carpmaels & Ransford is a leading firm of European patent attorneys based in London. For more information about our firm and our practice, please visit our website.

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