

EFFECTS OF THE NEW RULES NOW IN FORCE AT THE EPO - DIVISIONAL APPLICATIONS

New rules at the EPO entered into force on 1 April 2010. As we have reported previously, these new rules place restrictions on the filing of divisional applications by introducing time limits which are set by particular events in prosecution. In addition, search restrictions imposed by the new rules are applicable to the European search carried out for divisional applications (please see our separate information sheet on the new rules for direct EP applications).

Here we set out the changes relating to divisional applications at the EPO and the practical consequences of these changes for filing divisional applications. Of particular note, for many existing pending EP applications, the time limit for filing any divisional application is **1 October 2010**.

We recommend early review of existing pending EP applications and portfolios to allow appropriate preparation and action to be taken in time, which will be key to preserving the ability to pursue important subject matter at the EPO under the new rules.

What are the new time limit restrictions on filing divisional applications?

Under the new rules, a divisional application may be filed at any time from a European patent application while that application is pending (up until the day before grant, refusal, withdrawal or abandonment), **provided that at least one** of the following **two time limits** has not yet expired in relation to that patent application:

- (a) the time limit for filing a “voluntary” divisional application, which can be thought of as the ‘standard time limit’;
- and
- (b) the time limit for filing a “mandatory” divisional application, where the EPO has found a lack of unity of invention under Article 82 EPC.

Recent comments from the EPO indicate that the terms “voluntary” and “mandatory” used by the EPO in describing the time limits do **not restrict** the subject matter of divisional applications filed under the time limits. The time limit for filing a “mandatory” divisional application may be used to file a divisional application for **any** subject matter in the application, not just for subject matter identified in the relevant non-unity objection.

In most cases, the time limits run from the notification of a communication from the EPO. According to EPO rules, the date of deemed notification of a mailed communication is 10 days from the date of the communication, or the actual date of receipt, whichever is later.

- **Time limit for filing a “voluntary” divisional application**

24 months from the Examining Division’s first communication in respect of the earliest application for which a communication has been issued (new Rule 36(1)(a) EPC)

The EPO has clarified that the “Examining Division’s first communication” is the **first examination report** (“Communication under Article 94(3) EPC”), or the notice of allowance (“Communication under Rule 71(3) EPC”) if that is issued without an earlier examination report, **in the European examination stage**.

The 24 month time limit is **not** set by PCT-stage events, search reports, search opinions or preliminary amendment invitations (“Communication under Rule 161/162”), since at that stage the Examining Division is not yet responsible for the application.

According to the EPO, “the earliest application for which a communication has been issued” in the situation where there is a sequence of applications in a family, consisting of a normal European application and one or more divisional applications, may be any application in the sequence, depending on the timing of issue of communications on each of the applications in the sequence.

However, the meaning of “the earliest application for which a communication has been issued” may be different depending on

whether a family of applications is a linear family or a branched family. The details of how linear and branched families are treated differently in this respect are set out in **Annex I**.

- **Time limit for filing a “mandatory” divisional application**

24 months from any communication of the Examining Division raising an objection that the earlier application lacks unity under Art. 82 EPC, provided it was raising that specific objection for the first time (new Rule 36(1) (b) EPC)

According to the EPO, the meaning of “any communication of the Examining Division raising an objection that the earlier application lacks unity” is **a communication with a non-unity objection in the European examination stage** for the application from which a divisional application might be filed. This is irrespective of whether there is a sequence of divisional applications.

The 24 month time limit is **not** set by non-unity objections raised in PCT-stage events, search reports or search opinions, since at that stage the Examining Division is not yet responsible for the application.

The meaning of “raising that specific objection for the first time” is still not completely clear. According to the EPO, the intention is that raising of the **same** non-unity objection by the ED should not reset the time limit, whereas the raising of a **different or new** non-unity objection should do so.

For a family of applications, the earlier application and also other applications in the family are taken into account for determining whether the Examining Division is raising a non-unity objection for the first time. In other words, to set a time limit for filing a “mandatory” divisional application from a particular application, a non-unity objection must have been raised for that particular application and it must not be the same as any non-unity objection previously raised on an application in the family.

There has been no guidance from the EPO so far regarding any different treatment of linear families and branched families of applications in this respect. Until there is clarification from the EPO on this point, for safety, it should be assumed that a non-unity objection must not be the same as a non-unity objection previously raised on **any** application in a family.

- **Time limits for existing pending EP applications**

The new rules apply to existing EP applications, so time limits may already be running from earlier examination reports. However, the new rules have a transitional provision which specifies that no divisional time limits will expire before **1 October 2010**, although there is still the requirement that an application is pending in order for a divisional application to be filed from it.

Example calculations of time limits for filing divisional applications are set out in **Annex II**.

What other new restrictions affect the filing of divisional applications?

The new rules also place restrictions on the subject matter that will be searched by the EPO. The search restrictions are applicable to the European search carried out for divisional applications. There are three ways in which the EPO will try to restrict its search:

- **1 Only a single independent claim in each category**

The EPO allows only a single independent claim in each category (product, process, apparatus or use), except under certain limited circumstances. Where the EPO considers that this requirement is not met, it will invite the Applicant to indicate which single independent claim for each category should be searched and will limit the search to that subject matter.

If the Applicant does not reply, the EPO will search only the first independent claim in each category. It is possible to challenge such an objection, either in reply to the invitation or during examination. If the challenge is successful, the EPO will not limit the search.

- **2 Incomplete search – claims too broad or unclear**

Where the EPO considers that claims are too broad or unclear for a meaningful search to be carried out, it will invite the Applicant to file a statement indicating the subject matter to be searched.

If a statement is not filed or is not deemed sufficient, the EPO will either not carry out a search or will search only part of the claimed subject matter. It is possible to challenge such an objection, either in reply to the invitation or during examination. If the challenge is successful, the EPO will carry out a complete search.

- **3 Independent consideration of unity of invention**

The formal review of the claims at 1 and 2 above is independent of consideration of unity of invention. Where the EPO finds that the claims lack unity, it will carry out a partial search on the basis of the invention appearing first in the claims. It will also invite the Applicant to pay a further search fee for each further invention that is to be covered by the search.

The European search report will be drawn up only for the subject matter in respect of which search fees have been paid.

What are the overall effects in practice?

- **Possible loss of the right to pursue subject matter in a divisional application**
- **Consideration of whether one or more divisional applications are needed to pursue important subject matter of an application is required at an earlier stage in prosecution of the application than Applicants are used to**
- **Consideration of the scope of the claims for a divisional application is required at an earlier stage than Applicants are used to**

Before the new rules, it was possible to file a divisional application for any pending application, even if it was itself a

divisional application. Under the new rules, this will no longer always be possible because the time limits for filing a divisional application may have already expired.

Importantly, for a sequence of applications in a family, the 'standard time limit' is set by the Examining Division's first communication (usually an examination report) on the earliest application in the sequence for which a communication has issued. **All** divisional applications in the family, whether based on the earliest application or on a divisional thereof in the sequence, must be filed within this **single 'standard time limit'**.

Equally importantly, there is **an exception**: a particular application **may** have another time limit which expires later than the 'standard time limit' if the Examining Division raises a non-unity objection in a later examination report for that application, but only **provided that** it was the first time that the particular non-unity objection had been raised in the family. Therefore there may be extra time to file a divisional application from that particular application, apparently for **any** subject matter in the application, not just a divisional application which addresses the relevant non-unity objection.

Where the EPO refuses to search certain claims in a divisional application under the new search restrictions, the subject matter of those unsearched claims will not be examined in the divisional application. It may not be possible to file a further divisional application to cover that subject matter because the time limits for filing a divisional application may have already expired, such that the possibility of obtaining European patent protection for that subject matter is lost.

There is therefore a risk that, without careful management of applications and families of applications, the ability to pursue important subject matter will be lost for an application or a family.

In particular:

- It is therefore no longer possible to file a single divisional application and rely on being able to divide that application again later (and then divide yet again still later) as Applicants have been used to. Decisions in respect of all divisional applications that may ever be wanted in a family must be made at a much earlier stage.

For example, generally it is no longer possible to file a sequence of multiple divisional applications in respect of multiple inventions. In some cases it may be possible to file divisional applications with claims designed to draw "new" non-unity objections and so start new 24 month time limits for filing further divisional applications. However, these are likely to be exceptional, and we have no guidance from the EPO on how it will deal with attempts to draw "new" non-unity objections in this way.

- It may also no longer always be possible to wait to decide about divisional applications at appropriate stages during prosecution of an application (e.g. notice of allowance) as Applicants have been used to. A divisional application

may therefore have to be filed as a precaution because the Examining Division's view of an application, or the outcome of any points of contention, may not be known before expiry of the time limit.

For example, without proactive management of applications (e.g. active engagement with the examiner, responding quickly, requesting accelerated examination) it may no longer be possible to take claims of narrower scope than those filed on a first application and file a divisional application to pursue broader subject matter.

- It is therefore no longer advisable to file a divisional application without considering the subject matter to be claimed before filing.

For example, where a divisional application is filed simply with the claims of the parent application as filed with the intention of amending to the desired claims later, a search limited to only certain of the claims may prevent later amendment to the important subject matter and filing a divisional application for that important subject matter may then no longer be possible.

What action should Applicants now take?

- **Early review of existing pending EP applications to decide whether one or more divisional applications are required, particularly where the transitional time limit of 1 October 2010 applies, or for complex applications and families**
- **Having identified those cases where divisional applications are required, consider carefully and in detail the scope of the claims for those divisional applications before filing**

For EP applications that we are handling, having reported a time limit for filing a divisional application, we intend to send a reminder about 3 months before expiry of the time limit, in the absence of any earlier instructions for divisional applications or any explicit request not to send reminders.

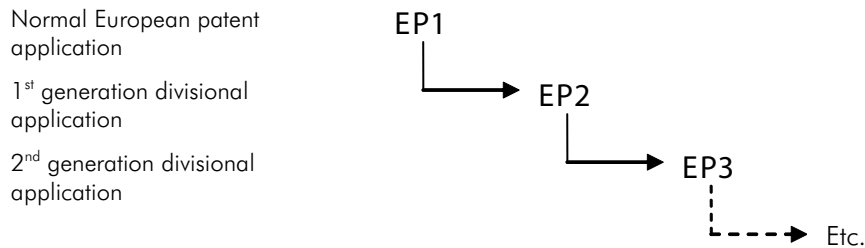
However, the importance of reviewing existing pending EP applications as early as possible really cannot be stressed enough, particularly where the time limit is 1 October 2010 or shortly thereafter, or for complex families.

If you would like further advice about the new rules relating to divisional applications, or have specific questions about how the new rules may affect you, please ask your usual contact at Mewburn Ellis.

ANNEX I: TIME LIMIT FOR FILING A “VOLUNTARY” DIVISIONAL APPLICATION FOR LINEAR AND BRANCHED FAMILIES OF APPLICATIONS

How is “the earliest application for which a communication has been issued” determined differently depending on whether a family of applications is a linear family or a branched family?

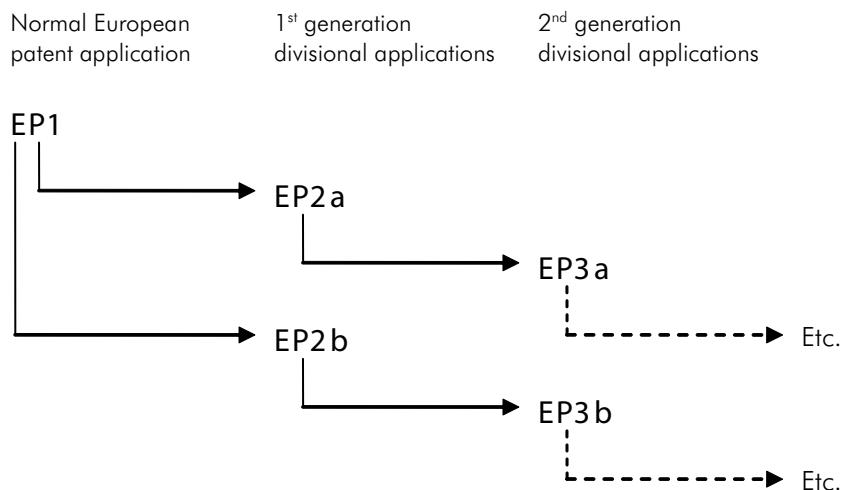
1 Linear sequence of divisional applications filed in a direct line



In this case, usually, the first examination report on EP1 is the first to be issued. Being the “first communication in respect of the earliest application for which a communication has been issued”, this sets the time limit for filing a “voluntary” divisional application in respect of each of the applications in the sequence.

Occasionally, however, the first examination report on EP1 is late and issues only after the first communication has already issued on a divisional application (e.g. EP2) in the sequence. In this situation, the first examination report on EP1 **replaces** the first communication on the divisional application (EP2) as the “first communication in respect of the earliest application for which a communication has been issued”. The time limit for filing a “voluntary” divisional application is therefore **reset**: the time limit which was set by the first communication on the divisional application (EP2) is replaced by a new 24 month time limit from the first examination report on EP1.

2 Branched sequence of divisional applications



In this case, “the earliest application for which a communication has been issued” as set out at 1 above applies in respect of **each branch** of the family considered separately. In other words, each branch of the family is treated as a separate linear sequence of applications filed in a direct line. Therefore “the earliest application for which a communication has been issued” for a branched family may be any application **in the same branch**, ignoring other branches of the family.

In the usual situation, the first examination report on EP1 is the first to be issued. Being the “first communication in respect of the earliest application for which a communication has been issued” for all branches of the family, because it is the application shared by all branches, this sets the time limit for filing a “voluntary” divisional application in respect of each of the applications in the family, irrespective of branch.

Where the first examination report on EP1 is late, however, there may be a different time limit for filing a “voluntary” divisional application in respect of each of the applications for each branch of the family.

ANNEX II: EXAMPLE CALCULATIONS OF TIME LIMITS FOR FILING DIVISIONAL APPLICATIONS

For an application where no non-unity objection has ever been raised by the Examining Division

Any divisional application that is wanted must be filed by the **earlier** of:

- (a) a date which is the **later** of (i) 24 months from notification of the first examination report or the notice of allowance for the earliest application in the family to have received a communication from the Examining Division, and (ii) 1 October 2010;

and

- (b) the day before grant, refusal, withdrawal or abandonment of the application.

If a divisional application is filed, then the date referred to in (a) above is also the ultimate time limit for filing any further divisional application of any generation.

However, if a non-unity objection is raised against a particular application, it may start a new 24 month time limit for filing a divisional application from that particular application, provided that this was the first time this particular non-unity objection has been raised in the family.

For an application where a new non-unity objection is raised against the application by the Examining Division

Any divisional application that is wanted must be filed by the **earlier** of:

- (a) a date which is the **later** of (i) 24 months from notification of a communication from the Examining Division on this application raising a particular non-unity objection for the first time in the family of applications, and (ii) 1 October 2010;

and

- (b) the day before grant, refusal, withdrawal or abandonment of the application.

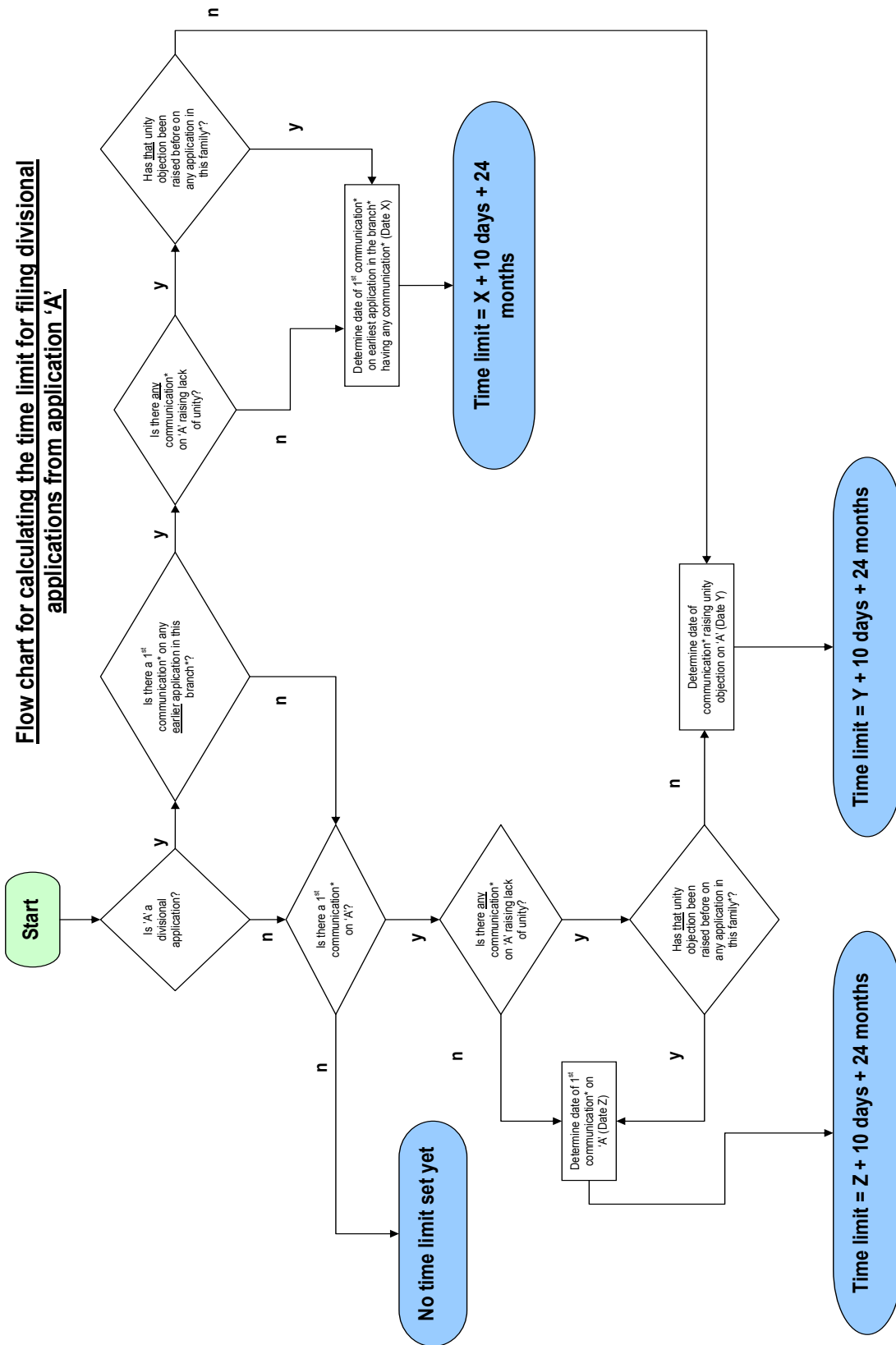
If a divisional application is filed, then the ultimate time limit for filing any further divisional application of any further generation is:

- (c) a date which is the **later** of (i) 24 months from notification of the examination report or the notice of allowance for the earliest application in the family to have received a communication from the Examining Division, and (ii) 1 October 2010.

Note that dates (a) and (c) may be the same where a non-unity objection is raised for the first time in the first examination report for the earliest application in the family to have received a communication from the Examining Division.

However, if a further non-unity objection is raised against a particular application, it may start a new 24 month time limit for filing a divisional application from that particular application, provided that this was the first time this particular non-unity objection has been raised in the family, i.e. the further non-unity objection is not the same as the new non-unity objection already raised.

Flow chart for calculating the time limit for filing divisional applications from application 'A'



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 "Communication" = must be from the Examining Division
 "Branch" = linear sequence of applications filed in a direct line, including 'A', from the earliest application in the sequence to the most recent divisional application in the sequence
 "Family" = the earliest application and all applications related by division to the earliest application

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