

### New Rules at the EPO - Divisional Applications

New rules have recently been announced by the EPO. These are discussed in our accompanying information sheet "New Rules at the EPO". Some of the new rules relate to divisional applications and their overall effect is to impose restrictions on the filing of divisional applications by introducing time limits. The time limits are set by particular events in prosecution. The new rules will enter into force on 1 April 2010.

Under the current rules, a divisional application may be filed at any time from an earlier "parent" application while that parent application is pending. The new rules add two provisos to this: (a) relating to the filing of a "voluntary" divisional

application, and (b) relating to the filing of a "non-unity" divisional application where the EPO has found a lack of unity of invention under Article 82 EPC.

#### Voluntary divisional applications

New Rule 36(1)(a) sets a time limit of **24 months** from the **Examining Division's ("ED's") first communication** in respect of **the earliest application** for which a communication has been issued for an applicant to file a divisional application of his own initiative.

According to the EPO, the meaning of "the earliest application for which a communication has been issued" is the earlier parent application if that is all that exists; where there is a sequence of divisional applications, it may be the parent, or grandparent, or an even earlier application.

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.

Search reports and search opinions do not trigger the 24 month time limit, since at that stage the Examining Division is not yet responsible for the application.

#### *Effect of the restrictions and practical considerations*

A time limit of 24 months may not adversely affect the filing of a first divisional application compared to current practice; in general, an applicant should have a reasonable idea of the ED's view of an application before expiry of the time limit to make a decision on filing a first divisional application.

However, we expect that the filing of further divisional applications (either from the original application or the first divisional application) will be adversely affected compared to current practice. The period remaining within the time limit

following filing of the first divisional application is likely to be short, almost certainly too short to have an idea of the ED's view of the first divisional application. Further, it is unlikely that any points of contention on the parent application will have been resolved within the time limit, particularly where there is an appeal. Thus there is likely to be limited information available to make a decision regarding further divisional applications.

Proactive prosecution of applications, for example, active engagement with the examiner, responding quickly, requesting accelerated examination, is advisable to maximise chances of having the ED's view within the time limit.

Without active management, it may no longer be possible to take narrow claims on a first application and file a divisional application to pursue broader subject matter. Applicants may therefore wish to consider filing parallel applications in Europe with claims of differing scope at the outset to allow them to pursue their preferred strategy and minimise the impact of procedural restrictions.

The EPO has stated that the 24 month time limit runs in its entirety in the European examination phase so that it applies in the same way both to direct EP and Euro-PCT applications. However, the time available before the start of the time limit relative to the start of prosecution of the application in Europe is reduced, for a Euro-PCT application which is searched by the EPO in the international phase compared with one that is not searched by the EPO in the international phase, or a direct EP application.

Applicants may wish to consider which type of application is most suitable on a case by case basis.

### Non-unity divisional applications

New Rule 36(1)(b) sets a time limit of **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**, for an applicant to file a divisional application to pursue any of the other inventions identified.

According to the EPO, the meaning of “the earlier application” is the immediate parent application, irrespective of whether there is a sequence of divisional applications.

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 re-start the time limit, whereas the raising of a different or new non-unity objection should do so.

#### *Effect of the restrictions and practical considerations*

The current ability to file a sequence of divisional applications in respect of multiple inventions in an application should be preserved, provided each immediately preceding (parent) application is subject to a different or new non-unity objection by the ED. It is not yet clear what the EPO will take to be a ‘different or new’ non-unity objection, though it is expected that this will be assessed substantively.

The new rules (Rule 62a) also place formal restrictions on the number of independent claims that will be searched, limiting the search to one independent claim in each category (except under certain limited circumstances). This is independent of consideration of unity under Art. 82 EPC. It is not possible to pay further search fees in order to have other independent claims searched.

If the EPO refuses to search multiple independent claims where in fact it would be proper to raise an objection of lack of unity, the time limit for filing a non-unity divisional application is lost. A divisional application to pursue the unsearched independent claims must instead be filed within the time limit for filing a voluntary divisional application running from the earliest application. This time limit may have expired before a conclusion is reached on arguments with the EPO that the objection to multiple independent claims was not justified.

### Entry into force

The new rules will enter into force on 1 April 2010. The effect on existing pending applications will be that a divisional application (voluntary or non-unity) may still be filed up to at least 1 October 2010.

We recommend an early review of existing portfolios.

In view of the different effects these rule changes have on the filing of divisional applications depending on the type of application, advice on how best to deal with these effects and consequences will similarly differ. 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.

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