

Draft EPO Guidelines - Amended Rule 36(1) EPC – Restricted Time Periods for Filing Divisionals

The EPO has recently issued draft guidelines relating to amended Rule 36(1) EPC, which comes into force on 1 April 2010 and introduces restricted time periods within which European divisional applications can be filed. The draft guidelines and other information provided by the EPO have clarified some issues. However, some questions are still unanswered, particularly in relation to sequences of divisional applications.

The draft guidelines are available at:

<http://www.epo.org/patents/law/legal-texts/guidelines-2010.html> (see Part A, Chapter IV)

Amended Rule 36 EPC can be seen at:

<http://www.epo.org/patents/law/legal-texts/decisions/archive/20090325.html>

A related notice can be found at:

<http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090820.html>

Transitional provisions mean that no restricted time period for filing divisional applications will expire – provided the immediate parent application is still pending - before 1 October 2010

An important consideration relating to applications for which first examination reports were issued in the past is to ensure that any required divisionals are filed in a timely manner. This will involve identifying the relevant divisional deadlines and/or ensuring that divisionals are filed by 1 October 2010. An important consideration for the future is to ensure that deadlines for filing divisionals are correctly noted. In particular, where a sequence of divisional applications is involved, deadlines for filing divisionals of one application in the sequence may be started by EPO action in relation to another application in the sequence. Procedures are now needed to ensure that deadlines are correctly noted for all applications to which they apply. If we can help you with a review of your applications to try to ensure that any divisionals needed – and relevant deadlines – are identified in a timely manner, please do not hesitate to contact us.

Amended Rule 36(1) EPC maintains the requirement that a **divisional can only be filed at a time when the application on which the divisional is based (the “parent” application) is still pending**. The draft guidelines confirm that if the parent application is itself a divisional in a sequence of applications it is not necessary for any other application in the sequence also to be pending.

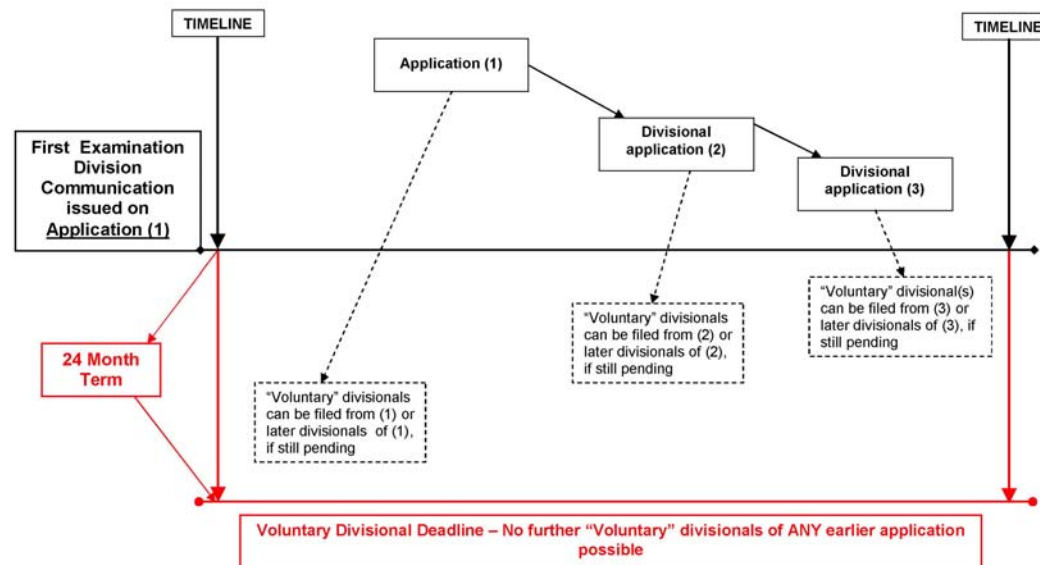
The draft guidelines confirm that **the restricted time periods for filing divisionals can be initiated only by EPO Examining Divisions**. In normal circumstances, pre-search objections, objections in partial or full search reports or in search opinions, issued before an Examining Division has formal responsibility, cannot start the periods. (There are special situations in which the applicant can allow an Examining Division to assume formal responsibility pre-search. If you need more information about these rather unusual situations please contact us.)

The basic restricted time periods for filing divisionals are:-

(1) **a period of 24 months for filing “Voluntary” divisionals** of the parent application. If the parent is not a divisional in a sequence of applications, this period **starts when the first communication of the EPO Examining Division is issued** in respect of the parent and is notified to the applicant. If the parent is itself a divisional in a sequence of applications, the start of this period will normally occur when the applicant is notified of the first communication of the EPO Examining Division issued in respect of the earliest application in the sequence, e.g. the grandparent application.

(2) **a period of 24 months for filing “Mandatory” divisionals** of the parent application **starts when a specific “non-unity” objection is first raised by the EPO Examining Division**.

“Voluntary” Divisionals



“Voluntary” Divisionals

In normal circumstances, in a sequence of applications – e.g. (1), (2), (3) in the above diagram – the (earliest) first communication of the Examining Division will be issued on the earliest (original parent) application in the sequence – Application (1) in the above diagram. This first communication on Application (1) will start the 24-month term by the end of which any desired “voluntary” divisionals must be filed not only for Application (1) but also for later Applications (2) and (3) - and any other later divisionals derived from Applications (1), (2) or (3).

However, it may be possible - although we believe that this will arise rarely, if ever, in practice - that the (earliest) first communication of the Examining Division might be issued on a later application in the sequence (e.g. Application (2) in the above diagram), before a first communication has issued on the earliest application (Application (1) in the above diagram). The draft guidelines do not make clear how amended Rule 36(1) will be applied by the EPO in such a situation.

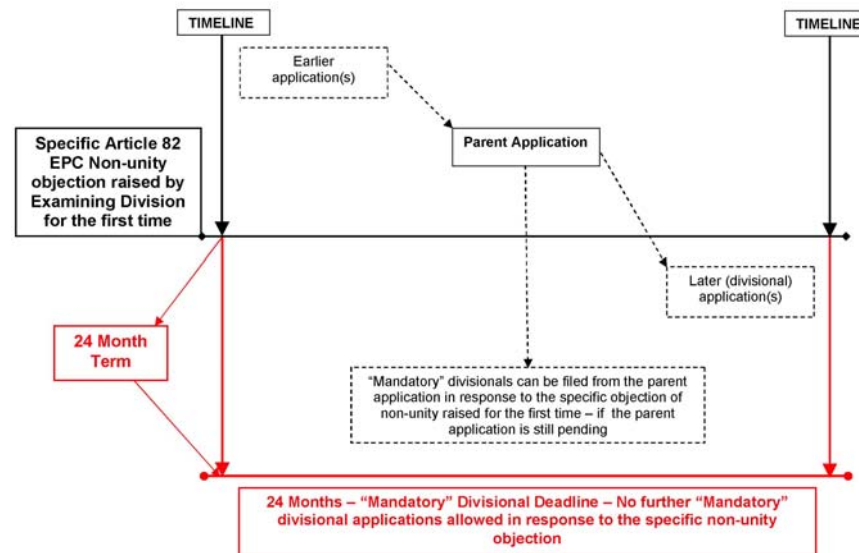
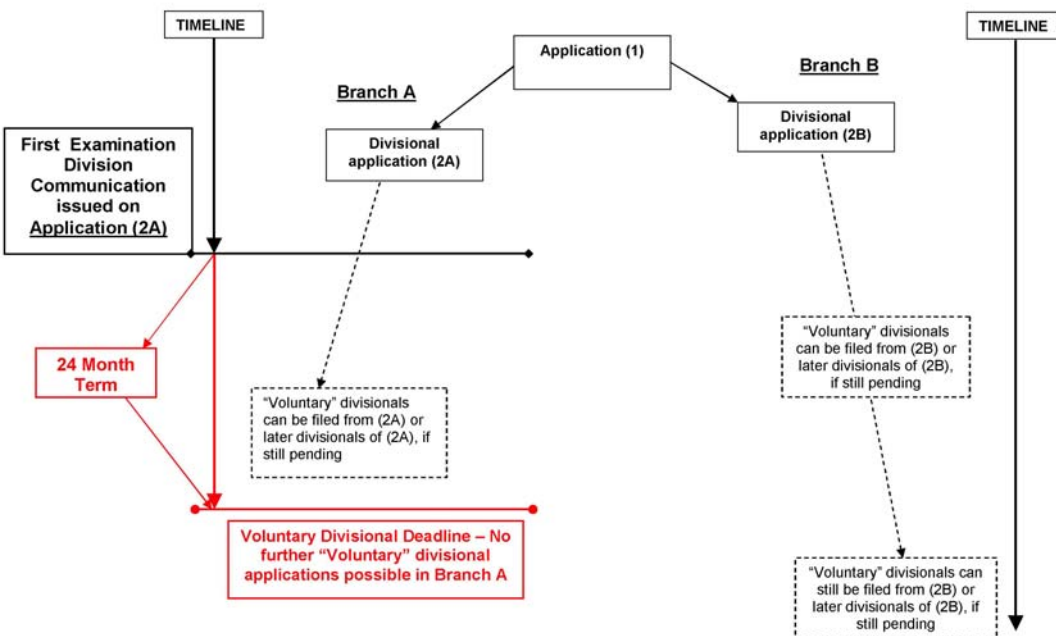
Until the position is clarified, **for safety we recommend that the issue of the earliest first communication of the EPO Examining Division on any application in a direct sequence of applications should be considered to start a 24-month term within which all further desired “voluntary” divisionals – of any applications in the direct sequence - should be filed.** (See below concerning “branched” sequences of “voluntary” divisional applications)

Amended Rule 36(1) EPC reads:-

- (1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:
 - (a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or
 - (b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

“Voluntary” Divisionals Branched Sequences

“Mandatory” Divisionals Article 82 EPC Non-unity objections



“Voluntary” Divisionals – Branched Sequences

The draft guidelines comment on cases in which different branches of divisionals arise.

In normal circumstances, the (earliest) first communication of the Examining Division will be issued on the earliest (original parent) application – Application (1) in the above diagram. This first communication on Application (1) will start the 24-month term by the end of which “voluntary” divisionals must be filed not only for Application (1) but also for later Applications (2A) and (2B) - and any other later divisionals derived from Application (1), or any other applications in Branch A or Branch B derived from applications (2A) or (2B).

It is possible - although we believe that this will arise rarely, if ever, in practice - that the (earliest) first communication of the Examining Division might be issued on a later application in a branch (e.g. Application (2A) in Branch A, as illustrated in the above diagram) before a first communication of the Examining Division has issued on the earliest (original parent) application (Application (1) in the above diagram).

According to the draft guidelines a first communication of the Examining Division issued on Application (2A) in Branch A will start the 24-month term for filing “voluntary” divisionals of Application (2A) in Branch A. However, according to the draft guidelines, the first communication of the Examining Division issued on Application (2A) will not start the 24-month term for filing “voluntary” divisionals of Application (2B) in Branch B.

It is not clear from the draft guidelines whether the issue of the (earliest) first communication on Application (2A) would start a 24-month term within which “voluntary” divisionals of Application (1) must be filed. It is also not clear whether subsequent issue of a (later) first communication on Application (1) would initiate a “new” 24-month term within which “voluntary” divisionals of Application (1) – or Application (2A) - could be filed.

Until the position is clarified, **for safety we recommend that the issue of the earliest first communication of the Examining Division on any application in a branch should be considered to start a 24-month term within which all further desired “voluntary” divisional applications of any applications in that branch - and of the original parent application - Application (1) - should be filed.**

“Mandatory” Divisionals

A “specific” non-unity objection raised for the first time by the EPO Examining Division starts a period within which divisionals (so-called “mandatory” divisionals) may be filed, whether or not the period for filing “voluntary” divisionals has already expired. Such a non-unity objection will almost always be raised in writing (e.g. in an examination report) but may be raised orally (e.g. at an interview or formal hearing).

The draft guidelines do not clearly indicate how “specific” a non-unity objection must be. However, they indicate that different “specific” non-unity objections can start different periods within which “mandatory” divisionals may be filed, and indicate that repetition of the same “specific” non-unity does not start a new period for filing “mandatory” divisionals. In our view, therefore, the objection must clearly be a “non-unity” objection (relating to Article 82 EPC), must clearly identify the alleged different inventions involved, and be sufficiently reasoned that the applicant can respond specifically to the objection.

A question which has arisen is whether a divisional which is non-responsive to the specific non-unity objection (i.e. may be considered to be a “voluntary” divisional) can be filed within the “mandatory” divisional period, even after the “voluntary” divisional period has expired. **The safe course is to assume that, after the “voluntary” divisional period has expired, only “mandatory” divisionals directly responsive to the specific non-unity objection can still be filed within the relevant “mandatory” divisional period.**

A further question arises if the parent application is itself a divisional in a sequence (see the diagram above), and a specific non-unity objection that applies to the parent application was raised at an earlier time against another application in the sequence. Did the earlier objection start the period for filing “mandatory” divisionals of the parent application? Although our interpretation is that the earlier objection does not start the period for filing “mandatory” divisionals of the parent application, nevertheless, **the safe course is to assume that a “mandatory” divisional period, for filing “mandatory” divisionals of any application in a sequence, begins at the earliest time at which the specific non-unity objection concerned is raised against any application in the sequence.**

Seek Specific Advice!

In this newsletter we have attempted to provide some general advice concerning the new time limits for filing divisionals, based on the draft guidelines issued by the EPO. However, some questions relating to sequences of applications and the effects of the new time limits have still not been answered with certainty. We therefore recommend that, if a situation arises in which you wish to file a new divisional in a sequence, you should seek our specific advice. We can then assess the factual situation at the time when filing of the new divisional is desired and be able better to advise you on the issues relating to that specific situation.