

## THE EFFECT OF RULE 36



Marianne Holme  
*Holme Patent*

In *WIPR* Issue 6 2010, we discussed the new divisional system under Rule 36 EPC, which stipulates a 24-month deadline triggered by the examining division's first communication in respect of the earliest application for which a communication pursuant to Article 94(3) EPC has been issued, or any other communication from the European Office Patent (EPO) in which the examining division raises a specific non-unity objection under Article 82 EPC for the first time.

In that article we predicted that the number of divisional applications would increase substantially. We have looked at the number of EP filings since the entry into force of new Rule 36 EPC.

The EPO received 235,000 European patent filings in 2010, 11 percent more than in 2009, which at that time was the highest number ever in the EPO's history. In 2011, the EPO received 243,000 applications, 3 percent more than in 2010. In a press release of January 2013, the EPO announced that in 2012, it received 258,000 patent applications, a 5.7 percent increase over 2011.

The press release cited a passage from a speech made by the president of the EPO: "This new peak in European patent filings for the third year in a row shows that companies from Europe and around the world are continuing to seek protection for their inventions, and that Europe remains an attractive market for new technologies." But these numbers included divisional EP applications, so was the increase the consequence of new Rule 36 that entered into force on April 1, 2010?

The new rule has caused concern among applicants. The calculation of the time limit is not transparent to non-professional representatives, it is unduly restrictive on applicants, and particularly restrictive in view of the increased restriction on the possibility of changing claim scope in the examination to cover what is deemed unsearched subject matter.

It is also expensive because applicants are forced to file numerous divisional applications to preserve the right for examination of features of the specification, and this increases the workload at the EPO. The applicant may also need to file more than one first filing application.

Another issue is that prior art may turn up from the examination of the patent family after expiry of possibility to take account of it by filing a divisional directed to subject matter disclosed in the specification, which very often has not been searched by the EPO.

Decision G 1/09 of the Enlarged Board of Appeal extended the possibility of filing divisional applications after refusal of the parent application and until expiry of the two-month time limit for appeal. Since examination

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often takes more than two years, however, the deadlines are not normally open any longer and G 1/09 will apply to only a few cases.

In March 2013 EPO opened a consultation for users to comment on the new divisional application system.

The questions included: "How has the introduction of the time limits for filing divisional applications affected you?" and "Are there aspects of the rule you think should be reconsidered? For example, should the time limits be extended from 24 to 48 or 60 months?"

Applicants look for efficient patent prosecution and it is also understandable that EPO wants to avoid problems such as divisional applications filed just to prolong pendency of the application stage. However the period of 24 months for filing a divisional is too short for many cases and this short deadline does not harmonise with divisional filing systems outside EPO.

It has been announced that the EPO proposes to amend Rules 36 and 135 EPIC to allow the filing of divisional applications as long as the earlier application is pending. It also proposes to establish an additional fee as part of the filing fee in the case of divisional applications filed in respect of an earlier application which is itself a divisional application, by amending Rule 38 EPC.

The proposals take into account the results of the online consultation on divisional applications, as well as the discussions held at the 8th meeting of the Standing Advisory Committee before the EPO (SACEPO) Working Party on Rules, on May 17, 2013, and at the 45th meeting of SACEPO, on June 19, 2013. ■

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*Marianne Holme is a European patent attorney and partner at Holme Patent A/S. She can be contacted at: mh@holmepatent.dk*