

DEADLINE DAY FOR DIVISIONAL APPLICATIONS

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In recent months, European patent attorneys in European Patent Convention contracting states have been preoccupied with the deadline for filing divisional applications under amended Rule 36(1) and (2) EPC, as set out in the European Patent Office notice dated August 20, 2009.

For many older European patent (EP) applications, the amended due date for filing divisionals is October 1, 2010.

Newer applications benefit from a 24-month deadline, triggered by the Examining Division's first communication in respect of the earliest application for which a communication under Article 94(3) EPC was issued. It can also be triggered by any other communication from the EPO in which the Examining Division raises a specific non-unity objection under Article 82 EPC for the first time.

In the case of a sequence of European divisional applications, the 24-month time limit is calculated from the date on which the Examining Division's first communication under Article 94(3) EPC was issued for the earliest application in the sequence.

The new rules emerged while many EP applicants were struggling due to global and national financial crises. Many EP applicants have yet to fully recover and may find it difficult to afford the number of divisional EP applications that might be required to obtain full patent protection for their inventive business assets. This may mean abandoning many patentable inventions.

The legal consequence of non-compliance with the 24-month time limit is that an application cannot be treated as a European divisional application. Further processing under Article 121 EPC is excluded; however, it remains possible to re-establish rights under Article 122 EPC. Also, the 10-day 'mail delivery' rule is applicable when calculating the 24-month time limit for filing divisional applications.

Even a notification of a summons to oral proceedings, or of the minutes of a telephone call or a personal interview, may trigger a last date for filing a mandatory divisional application, if an objection on lack of unity grounds arises. Communications from the EPO are currently not expected to include information about the deadline for filing divisionals. The applicant or professional representative must monitor and establish the deadline for filing EP divisional applications themselves.

Various misinterpretations and misunderstandings of amended Rule 36(1) and (2) EPC are expected to establish important new case law, making it easier to comply with these rules in the future. But until such case law defines the limits and possibilities of the amended rules for filing divisional applications, the rules are a cause for concern.

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Substantive examination takes considerable time at the EPO and some applicants may find themselves trapped by the new rules.

For example, in some pending EP applications, a lack of unity objection is raised in a communication under Article 94(3) EPC. In the reply to this communication, the applicant disagrees with the Examining Division, but has not received any feedback from the EPO for several years. If no reply is obtained from the EPO prior to expiry of the 24-month deadline or before October 1, 2010, the applicant has no option but to file a precautionary divisional application to ensure no loss of patent protection.

The EPO aims to raise the bar when granting patents and also to cut down the time required for substantive examination. The new divisional system should encourage applicants to file shorter and more specific patent applications that are easier and faster to study and examine.

Another measure to expedite EP patent prosecution was recently notified in the European Patent Office on July 28, 2010, concerning amended Rule 141 EPC, which puts a new obligation on applicants claiming priority from other applications to provide a copy of the official national search report. This will have been issued by the national patent authority where the priority application was filed. Amended Rule 141 EPC enters into force next year, and will apply to all European patent applications and international applications filed on or after that date.

Although EP examiners may benefit from seeing the search and examination results of the parent application as well as the search results from national patent offices, it will be interesting to see what happens if the expected flood of divisional applications and new EP filings materialises, and how this would affect the workload of the EPO.

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