

Recent EPC rule changes restrict filing of Divisional Applications

1. Background

On 25th March 2009, the Administrative Council of the European Patent Organisation issued decision **CA/D 2/09** which introduces stricter requirements regarding the filing of divisional applications. These stricter requirements have apparently been introduced because the EPO considers that some Applicants have abused the divisional system.

2. The Rules

2.1 Under current EPC Regulations¹, a divisional application may be filed at any time as long as the application on which it is based is pending. However, under the new regulations, which come into force on 1st April 2010², the opportunities for filing divisional applications will be limited.

2.2 As of 1st April 2010, in addition to the requirement that the application on which the divisional is based needs to be pending, a 24 month period calculated from the first examination report of the *earliest application*, will be set for filing a voluntary divisional. However, if the divisional is based on an application which is itself a divisional, then the 24-month period will be calculated from the date of the first examination report of the *earliest application* in the sequence, e.g. the grandparent application.

2.3 Further, and irrespective of the above, if an examiner raises a non-unity objection on the *earlier application*³ for the first time, an alternative 24 month time period from the date of the examination report raising the non-unity objection will be set for filing a mandatory⁴ divisional.

¹ Rule 36(1) EPC

² The date on which amended Rule 36(1) EPC enters into force.

³ i.e. the immediate parent application from which the divisional is filed

⁴ The term "mandatory" is used by the EPO to differentiate a divisional filed within the 24 month period from the non-unity objection as opposed to the

2.4 Please note that the alternative 24 month period for filing a mandatory divisional starts from the date of the first examination report of the Examining Division in which the non-unity objection is raised, and not the date of the Extended European Search Report (EESR) even if the non-unity objection is first raised in the EESR⁵. Also, repetition of the same non-unity objection in a subsequent examination report would not set a new 24 month period. However, if a subsequent examination report raises a new and different non-unity objection, then a new 24 month period would be triggered.

2.5 If any of the 24 month periods for a pending application have expired before 1st April 2010, i.e. the date on which these rules come into effect, or are still running on 1st April 2010 but due to expire before 1st October 2010, then the EPO's transitional regulations will allow for divisional applications to be filed up to 1st October 2010.

2.6 Importantly, please note that further processing cannot be used if a "24 month period" has been missed. The (more onerous) remedy of Reestablishment may however still be possible.

2.7 Finally, the EPC Regulations have also been amended⁶ to allow that, where an earlier application was filed in a language which is not an official language of the EPO⁷, a divisional application may be filed in the same unofficial language of the earlier application⁸.

"voluntary" divisional which must be filed 24 months from the first examination report. The use of the term "mandatory" does not mean that the Applicant has to file a divisional.

⁵ Where the applicant has waived his right to receive the communication according to Rule 70(2) EPC, no search opinion is issued. Instead, the first Communication is an examination report from the Examining Division.

⁶ Rule 36(2) EPC has been amended.

⁷ English, French and German

⁸ A translation, into whichever official language became the language of proceedings in respect of the earlier application, must then be filed within two months of the filing of the divisional application. The

