

Written by
Andrew Schimmoeller

EPC changes on the horizon

Understanding and adjusting to the new rules covering divisional applications is critical – as is the need to track the new deadlines, writes Andrew Schimmoeller, a legal researcher for Thomson IP Management Services at Thomson Reuters

Applicants filing European patent applications should enjoy a shorter examination process in the near future, but also face significant time limits for the filing of divisional applications. Last March in Administrative Council Decisions CA/D 2/09 and 3/09, the European Patent Organisation (EPO) announced substantial changes to the European Patent Convention's (EPC) implementing regulations. Effective 1st April 2010, these changes revolutionise the filing of European divisional patent applications. The EPO hopes the changes will both accelerate the examination process and improve the quality of patent applications. For applicants who submit strong applications up front, this is good news. But for applicants who don't take heed of the new deadlines, the changes will also result in a loss of opportunities. Organisations with an IP management system should ensure that the system is calculating these critical deadline dates properly.

Why file divisional applications?

Divisional patent applications are filed for numerous reasons. You may file a divisional application when the parent application faces a lack of unity of invention objection. A divisional application may be filed shortly before a parent patent grants, if you expect opposition to the parent patent. You may also file a divisional application rather than appeal a negative oral examination decision. Additionally, a divisional application may be filed to adapt claims to combat an infringing good. In the past, divisional applications could be filed up to the day before the parent application granted.

Previous rule favoured applicants

Under the prior Rule 36, you could file divisional applications at any time while

the parent application was pending. EPC Article 76(1) presented the only limitation for filing divisional applications in that the divisional application had to be based on a prior pending application. The EPO Board of Appeals tried in vain to place further constraints on the filing of divisional applications. Some applicants found it advantageous to keep filing divisional applications in an effort to keep at least one application pending at all times. Consequently, the EPO faced a significant examination backlog.

New rule forces divisional decision

The EPO responded to the almost limitless ability of applicants to file divisional applications with significant changes to curb the filing of abusive divisional applications. According to revised Rule 36(1) and Rule 36(2), as of 1st April 2010 all divisional applications must be filed within 24 months from either the issuance of the first communication from the Examining Division or the issuance of a lack of unity objection.

The EPO also amended rules 57, 62A, 63, 70A, 135, 137 and 161. These new rules focus on: examination as to formal requirements; applications containing a plurality of independent claims; incomplete search; response to the extended European search report; further processing; amendment to the European patent application; and amendment of the application. The rule changes should simplify the examination process and reduce the backlog.

Benefits of new rule

By limiting the time period in which you can file divisional applications, the EPO hopes to prevent abusive divisional applications while maintaining your ability to file genuine divisional applications. Under the new Rule 36, you will no longer be able to keep EPO examiners and potential competitors at bay by filing divisional applications only moments before a parent application grants.

The new rules require you to meticulously map the prosecution of European applications from the very

beginning, rather than deferring delicate decisions on divisional applications until the bitter end. As such, you should now completely reconsider how you view European divisional applications – failure to do so could result in missed deadlines and lost opportunities. If you have a broad IP portfolio, it is recommended that you utilise an IP management system with a robust rules algorithm to automatically track current critical dates, allowing relevant parties to collaborate and make the best decisions throughout the application and examination process.

Andrew Schimmoeller is an intellectual property attorney at Thomson IP Management Services, where he tracks rules changes around the world to ensure compliance for Thomson IP Manager and IP Payments clients
andrew.schimmoeller@thomsonreuters.com