



NEW EPO RULES REDUCE FLEXIBILITY FOR DIVISIONAL APPLICATIONS

A change to the rules governing filing of divisional applications has been announced by the EPO. The rules are due to come into effect on 1 April 2010 and will have a very significant impact on the options available.

The new rules place much more restrictive time limits on when divisional applications can be filed. Under the present rules, divisional applications can be filed at any time while the parent application (which can itself be a divisional application) is pending (i.e. not granted, refused or lapsed).

Under the new rules, it will only be possible to file divisional applications:

- within two years of an objection from the Examining Division that the claims of the parent application relate to more than one putative invention (a "lack of unity of invention" objection);
- or within two years of the first communication from the EPO examiner if there has been no objection from the Examining Division concerning unity of invention.

Crucially, if the divisional application is to be based on an application which is itself a divisional application, the relevant deadline will be calculated with respect to events occurring on the earliest application in the family, i.e. two years from the relevant non-unity objection or communication on the original parent or even 'grandparent' application.

The new rules apply to all divisionals filed after 1 April 2010. However, there will be a six month transitional period from 1 April 2010 in which it will be possible to file divisional applications on cases where the deadline under the new rules would otherwise have expired. After that it will usually not be possible, for example, to file a divisional application as a precautionary measure shortly before attending oral proceedings on the parent case.

Hence, within the next 12 months it will be necessary to identify all of the subject matter in pending applications (and in those filed between now and 1 April 2010) that might need to be separated out into a divisional application, or that might benefit from being separated out. It is very likely that there will be a rush to file divisional applications by the end of the transitional period on 1 October 2010. Accordingly, please let your usual contact at Potter Clarkson know as soon as possible if you think that you may wish to file any divisional applications under the transitional provisions. Because it is necessary to file a divisional application with the claims that are to be searched, we will need to discuss your requirements with you well in advance of the deadline in order to ensure that the right subject matter is searched and that the claims are appropriate in view of the recent very steep increases in EPO excess claims fees for claims over 15.

Clearly, these changes will have a very significant adverse effect on EPO prosecution practice. Your usual contact will be able to provide you with more detailed advice on how best to proceed in these new circumstances.

13 July 2009

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem. Please note that all our Newsletters can be found on our website: www.potterclarkson.com.

© Potter Clarkson LLP 2009

N:0137



Park View House
58 The Ropewalk
Nottingham NG1 5DD
United Kingdom

T: +44 (0) 115 9552211
F: +44 (0) 115 9552201
E: info@potterclarkson.com
W: www.potterclarkson.com