

Udine, August 27, 2009

RE: new rules for filing divisional european patent applications

By decision of 25 March 2009, the European Patent Office amended Rule 36 (1) and (2) of the European Patent Convention.

Under (1) and (2) this rules stated that:

“(1) The applicant may file a divisional application relating to any pending earlier European patent application.

“(2) A divisional application shall be in the language of the proceedings for the earlier application and shall be filed with the European Patent Office in Munich, The Hague or Berlin”.



Therefore, no time limit was set for filing a divisional patent application. The only limit was that the earlier patent application were still pending, i.e. before the grant publication date.

The amendment to Rule 36 maintains this limit and introduces time limits to the divisional application, that may be either voluntary or mandatory.

- a) “voluntary” division;
- b) “mandatory” division.

“Voluntary” division

Rule 36 (1)(a) EPC provides that a divisional application may be filed, on the basis of an earlier application, before the expiry of 24 months from the Examining Division’s first communication in respect of such earlier application.

If the earlier application on which the divisional application is based is cancelled or withdrawn during this 24 month period, the divisional can no longer be filed.

In the case of a sequence of divisional applications, the 24 month period is to be calculated from the date on which the Examining Division's first communication was issued for the earliest application in the sequence.

The term “Examining Division’s first communication” shall be intended to indicate a communication under Art. 94 (3) and Rule 71 (1), (2) or, where appropriate, Rule 71 (3).

The notification of the Search Opinion does not cause this 24 month period to start.

“Mandatory” division

Rule 36 (1)(b) EPC provides that a divisional application may be filed, on the basis of an earlier patent application, before the expiry of 24 months from any communication in which the Examining Division raises a non-unity objection for the first time on such application, according to Art 82 EPC.

A non-unity objection is typically raised in the Examining Division’s first communication pursuant to Article 94 (3) and Rule 71 (1), (2) or, if already raised at the search state, maintained therein. The confirmation of a finding of lack of unity in a subsequent communication from the Examining Division does not cause the 24 month period to start again. A new 24 month time limit can only be triggered by a communication subsequent to the Examining Division’s first communication, in which a new, different non-unity objection is raised for reasons other than those previously observed.



The notification of the Search Opinion does not cause this 24 month period to start.

Transitional provisions

The amendment to Rule 36 described herein will apply to divisional applications filed after its entry into force, i.e. on or after 1 April 2010. For pending applications for which the 24 month period has expired or is still running, divisional applications may be filed within 1 October 2010.

The text of the amended Rule 36 (1) and (2) is as follows:

“(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:

(a) the divisional application is filed before the expiry of the time limit of twenty-four months from the Examining Division’s first communication in respect of the earliest application for which a communication has been issued, or

(b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has object that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

(2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed

within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin”.

At your disposal for any further clarification required, we remain,

Yours faithfully,

GLP Srl

