Recent amendments to the EPC

- European divisional applications -
Notices from the European Patent Office

- **Notice from the European Patent Office dated 20 August 2009** concerning amended Rule 36(1) and (2) EPC *(European divisional applications)* and consequential amendments to Rules 57(a) and 135(2) EPC
  
  OJ EPO 2009, 481

- **Notice from the European Patent Office dated 26 October 2009** on the establishment of the date of the Examining Division's first communication for calculation of the time limit under Rule 36(1)(a) EPC as from 1.4.2010
  
  OJ EPO 2009, 601

- **Notice from the European Patent Office dated 29 June 2010** concerning communications under amended Rule 161 EPC
  
  OJ EPO 2010, 406
European divisional applications

**Amended Rule 36(1) EPC**

Two requirements must be met:

(i) the application to be divided must be **pending**
   (see also G 1/09);

(ii) at least one of the two **time limits** mentioned below must not yet have expired:
   (a) the period for **voluntary division** under Rule 36(1)(a) EPC or
   (b) the period for **mandatory division** under Rule 36(1)(b) EPC, where applicable.
Voluntary division

Time limit:

- **24 months** from the *Examining Division's first communication* under Article 94, paragraph 3, and Rule 71, paragraph 1 and 2, or Rule 71, paragraph 3, **in respect of the earliest application for which a communication has been issued** (see also Decision of the Administrative Council of 26 October 2010, CA/D 16/10, OJ EPO 2010, 568).

- 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 was notified for the **earliest application in the sequence for which a communication has been issued** (see for details Guidelines for Examination A-IV, 1.1.1.4 and slides 7-10 below).

- **Rule 126(2) EPC** ("10-day rule") is applied for calculation of the 24-month time limit (see Guidelines for Examination A-IV, 1.1.1.2).
Rule 36 EPC

European divisional applications

(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 a time limit of twenty-four months from the Examining Division’s first communication under Article 94, paragraph 3, and Rule 71, paragraph 1 and 2, or Rule 71, paragraph 3, in respect of the earliest application for which a communication has been issued, or

(b) .....
The standard situation

Voluntary division

**Acronyms**

**ESOP** = European Search Opinion under Rule 62(1) EPC

**COMM** = Examining Division’s first communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC
Earliest application for which a communication has been issued

**Acronyms**

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**Timeline**

- **EP1**: Grandparent
  - Filing
  - ESOP
  - COMM (24 months)

- **EP2a**: Divisional of EP1
  - Filing
  - ESOP
  - COMM (24 months)

- **EP2b**: Divisional of EP1
  - Filing
  - ESOP
  - COMM (24 months)

- **EP3**: Voluntary division of EP1 possible
  - Voluntary division of EP2a possible
  - Voluntary division of EP2b possible
Standard situation with lapse of the earliest application

Voluntary division

Acronyms

**ADWI** = Application Deemed Withdrawn (e.g. under Art. 94(2) or (4) EPC)

**REFU** = REFUsal of an application (Art. 97(2) EPC; see for details G 1/09)

**GRANT** = Grant of an application (Art. 97(1) and (3) EPC)

**ESOP** = European Search Opinion under Rule 62(1) EPC

**COMM** = Examining Division’s first communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC
Late first communication in the earliest application

Voluntary division

Acronyms

ESOP = European Search Opinion under Rule 62(1) EPC

COMM = Examining Division’s first communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC
Very late first communication in the earliest application with subsequent lapse of this application

Voluntary division

Acronyms

**ADWI** = Application Deemed Withdrawn (e.g. under Art. 94(2) or (4) EPC)

**REFU** = REFUsal of an application (Art. 97(2) EPC; see for details G 1/09)

**ESOP** = European Search OPinion under Rule 62(1) EPC

**COMM** = Examining Division’s first communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC
Mandatory division

Time limit:

- 24 months from any communication 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 divisional applications the period for mandatory division is calculated with reference to the first communication in examination raising a specific objection of lack of unity for the first time (see Guidelines A-IV, 1.1.1.4).

- A new time limit of 24 months can only be triggered by a communication from the Examining Division in which a new, i.e. different non-unity objection under Article 82 EPC is raised.

- The events from which the period for mandatory division is calculated include:
  - notification of a summons to oral proceedings,
  - notification of the minutes of oral proceedings, of a telephone call or of a personal interview,
  where a specific objection of lack of unity is raised for the first time.

- A mandatory divisional application is not limited to the non-unity objection with respect to subject-matter; the only limitation in this regard is imposed by Articles 76(1) sentence 2 and 123(2) EPC.

- An objection under new Rule 137(5) EPC does not trigger the period for mandatory division to start, as it does not qualify as an objection under Article 82 EPC.
Rule 36 EPC

European divisional applications

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

(a) ...

(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 objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

(2) ...
Mandatory division

Regular case

EP1: Grandparent

- Filing
- ESOP
- B10
  etc.

EP2: Parent

- Filing
- ESOP
- B10
  No Art.82 objection
  With Art.82 objection
  etc.

EP3: Current divisional

- Filing
  Time window for mandatory division

Acronyms

- ESOP = European Search OPinion under Rule 62(1) EPC
- B10 = internal code for the 1st communication of the examining division under Article 94(3) EPC
- B20 = internal code for a further communication of the examining division under Article 94(3) EPC

"The Examining Division's first communication under Article 94(3), and Rule 71(1) and (2), or Rule 71(3) EPC in respect of the earliest application for which a communication has been issued"
Mandatory division with lapse of the earliest application without a communication

**Acronyms**

- **ADWI** = Application Deemed Withdrawn (e.g. under Art. 94(2) or (4) EPC)
- **ESOP** = European Search Opinion under Rule 62(1) EPC
- **B10** = internal code for the 1st communication of the examining division under Article 94(3) EPC
- **B20** = internal code for a further communication of the examining division under Article 94(3) EPC
Late division: Legal consequences

- **Non-compliance with the 24-month time limit:**
  → the application cannot be treated as a European divisional application.

- Time limits **excluded** from further processing
  (see R. 135(2) EPC).

- **Re-establishment of rights** available
  (see Art. 122 and R. 136(1) and (2) EPC).
Language requirements

- A divisional application must be filed in the **language of the proceedings of the earlier application**;

- if the latter was not filed in an official language of the EPO, the divisional application may be filed in the **language of the earlier application**.

  - In this case a **translation** into the language of the proceedings for the earlier application must be filed **within two months from the filing of the divisional application**.

  - Due filing of the translation is examined pursuant to **Rule 57(a) EPC**.
Rule 36 EPC

European divisional applications

(1) ... 

(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.
Further information

• Details on amended Rule 36 EPC and the EPO's practice under the amended provision are to be found in the revised Guidelines for Examination, available on the EPO website http://www.epo.org/patents/law/legal-texts/guidelines.html:
  – applicable since 1 April 2010
  – see in particular section A-IV, 1.

• The European Patent Academy offers a comprehensive e-learning module covering inter alia amended Rule 36 EPC, which is available on the EPO's e-learning platform: Amendments to the Implementing Regulations to the European Patent Convention (EPC).