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SUBJECT: Divisional applications

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I. THE TERM "DIVISIONAL APPLICATION"

The EPC does not define "divisional application". The situation most often giving rise to a divisional application is where the examining division raises an objection of lack of unity under Article 82 EPC. In such cases the applicant is informed that he is required to restrict the application to a single invention, and that if he wishes to obtain protection for any of the other inventions, then he can do so only by filing one or more divisional applications. This is consonant with Article 4 G(1) of the Paris Convention.

However, the applicant also has the option of filing a divisional application even if an objection of lack of unity has not been raised. For economic, procedural or other reasons, he may wish to have a particular part of the application removed from the rest so that he can obtain a separate patent for that part. This corresponds to Article 4 G(2) of the Paris Convention, which provides for voluntary filing of divisional applications.

Furthermore, Article 76(1), second sentence, EPC states that a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the parent application as filed. Applicants have understood this provision as meaning that a divisional application may be identical to the parent application. This view has not been objected to by the Enlarged Board of Appeal in decisions G 1/05 and G 1/06 of 28 June 2007 (OJ EPO 2008, 271, 307). The interpretation of the Enlarged Board based on Article 76 and Rule 25 EPC 1973 remains valid, as the provisions relating to divisional applications have remained unchanged in substance in the EPC 2000 (now Article 76 and Rule 36 EPC).

Thus in the European patent system the term "divisional application" encompasses both mandatory and voluntary division, and also both applications claiming subject-matter unclaimed (but disclosed) in the parent application and those directed to the same subject-matter as the earlier application.

II. SEQUENCES OF DIVISIONAL APPLICATIONS

In decisions G 1/05 and G 1/06 the Enlarged Board has further accepted sequences of divisional applications, pointing out that while Article 76(1) EPC 1973 is not explicitly worded to cover divisional applications stemming from divisional applications, it cannot be said to forbid them. Indeed, its provisions apply naturally to such applications on the principle that, in the absence of specific provisions to the contrary, a divisional is to be treated like any other application.

This means that a divisional application (of whatever generation) may also be the "earlier application" within the meaning of Article 76(1) EPC 1973 for the purposes of a further divisional application. Rule 25 EPC 1973 reflects and supports this view by referring, without qualification, to the possibility of filing a divisional application from any pending earlier European application (Reasons point 10.2).

III. EVOLUTION OF THE IMPLEMENTING REGULATIONS CONCERNING DIVISIONAL APPLICATIONS

This flexibility is the result of a series of amendments made to the implementing regulations to help the applicant obtain maximum possible protection for his invention, within the boundaries of the disclosure of the initial application.

The original version of Rule 25(1) EPC 1973 (now Rule 36 EPC) was worded as follows:

"A European divisional application may be filed:

(a) at any time after the date of receipt of the earlier European patent application by the European Patent Office, provided that after receipt of the first communication from the Examining Division, the divisional application is filed within the period prescribed in that communication or that after that period the Examining Division considers the filing of a divisional application to be justified;

(b) within two months following the limitation at the invitation of the Examining Division of the earlier European patent application if the latter did not meet the requirements of Article 82."

EPO practice on voluntary division was that the examining division normally gave its consent unless the communication under Rule 51(4) EPC 1973 had already been sent. Therefore, the division's approval was seen as a mere formality, which caused complications in view of the different locations of the Receiving Section (The Hague) and the examining divisions (Munich). Furthermore, at that time it was considered that the fees payable for divisional applications prevented their misuse (see CA/29/88). Therefore, with the aim of increasing the efficiency of the Office and improving the protection of the applicant's rights, these restrictions were removed by decision of the Administrative Council of 10 June 1988 which entered into force on 1 October 1988 (OJ EPO 1988, 290).

The amendment of Rule 25 EPC 1973 by decision of the Administrative Council of 7 December 1990, which entered into force on 1 June 1991, deleted the requirement that the description and drawings of the earlier patent application or

any European divisional application could relate only to the matter for which protection was sought by that application (OJ EPO 1991, 4).

Rule 25 EPC 1973 was amended a final time by the Administrative Council's decision of 18 October 2001, which entered into force on 2 January 2002, to state that a divisional application could be filed from any pending earlier European application, thus clarifying that the parent application could itself be a divisional (OJ EPO 2001, 488).

IV. ABUSE OF DIVISIONAL APPLICATIONS

There is a trend for applicants to abuse these procedural possibilities by using the divisional application procedure to achieve a "duplication" of the proceedings. For example, the applicant files a(n identical) divisional application the day before the oral proceedings, i.e. before any refusal might occur and thus while the earlier parent application is still pending. If refusal ensues in the oral proceedings, instead of appealing against the negative decision of the examining division, the applicant simply pursues the divisional. Moreover, even if an appeal is filed and the refusal is confirmed by the board of appeal, this procedure allows him to have the same technical content discussed again. The applicant can repeat this tactic over and over again.

This is detrimental both to legal certainty for third parties and to patent office workloads.

In G 1/05 and G 1/06 the Enlarged Board of Appeal has also addressed the issue of the abuse of sequences of divisional applications. It has ruled that it sees no adequate basis in Article 76(1) and Rule 25 EPC 1973 for defining any additional requirements to be imposed on divisional applications beyond the requirements to be fulfilled by all applications. It notes that what some applicants consider a legitimate exploitation of the procedural possibilities afforded by the EPC, others consider an abuse in relation to the law as they think it ought to be rather than as it is. It finds it unsatisfactory that sequences of divisional applications, each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years. If administrative measures, such as giving priority to the examination of divisional applications and bundling and speedily deciding co-pending divisional applications so as to minimise the possibility for applicants to keep alive subject-matter on which the examining division had already given a negative opinion in one application by means of refiling the same subject-matter again and again, are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be (Reasons point 13.5).

V. PROPOSAL FOR AMENDMENT OF RULES 36, 135 AND 136 EPC

It should be borne in mind that divisionals currently make up around 5% of all European applications. Divisional applications of the second generation represent less than 7% of all divisionals, later generations less than 1%. However, the number of divisional applications may increase considerably as a consequence of the new claims fee policy.

Also, while administrative measures may suffice to expedite the proceedings on pending divisional applications, they cannot prevent the filing of abusive divisionals. Therefore, to enable the Office to combat this, additional legislative restrictions seem necessary¹.

In its position paper CA/PL 3/08, the *epi* proposes that Rule 70(1) EPC be amended to read as follows:

The applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. *If the application is a divisional application, the time limit is three months from the communication of the search report.* The request may not be withdrawn.

In our view, reducing the time limit for requesting examination to 3 months in the case of divisional applications would reduce their pendency times but would not fully solve the problem, essentially because it would not provide the Office with any instrument to stop the systematic filing of abusive divisional applications.

What is needed, therefore, are additional rules to prevent such abuse without affecting legitimate applications such as non-unity (mandatory) divisionals.

¹ This issue was discussed at the EUROTAB 2006, as can be seen from EUROTAB papers 4/2006 (DE), 5/2006 (SI), 6/2006 (RO), 7/2006 (PT), 8/2006 (HU), 9/2006 (CZ), 13/2006 (EPO), 15/2006 (LV), 23/2006 (TR), 25/2006 (ES), 29/2006 (UK) and 31/2006 (minutes). National laws address it differently, so the same problems are not encountered everywhere. It was however broadly acknowledged that it could become highly problematic. The German delegation invited the EPO to take the lead in proposing adequate measures.

The topic was also debated recently by the AIPPI, which adopted resolution Q193 on divisional, continuation and continuation-in-part applications.

It is therefore proposed to introduce, for the filing of divisional applications, fixed time limits with variable starting points in order to differentiate between voluntary and mandatory division.

In cases of mandatory division, in order to give the applicant adequate opportunity to discuss a non-unity objection with the examining division (or with the board of appeal if the objection is raised for the first time in appeal proceedings), this time limit could be 12 months from the first communication of the division or board inviting the applicant to limit the application.

For voluntary division, in contrast, there could be a (fixed) cut-off date. Thus it would only be allowed within a certain time limit calculated from the filing date or, if priority has been claimed, from the priority date of the earliest application. This time limit should be such as to allow for discussion of the parent application with the examining division. To keep things as simple as possible, there should be a single time limit for both Euro-direct and Euro-PCT applications. The EPO considers a time limit of 55 months as from the date of filing (or priority date) of the earliest application to be adequate and fair.

The reference to the earliest application makes clear that the 55 months are calculated from the earliest priority date of the very first (originating) application, even where the parent application is a divisional application which does not claim the earliest priority date of the grandparent application.

A similar proposal was recently submitted by the Netherlands delegation, which in CA/PL 5/08 proposes inter alia that the applicant be allowed to file a divisional application on his own initiative up to 6 months after the examiner has sent him the written opinion or up to 36 months after the oldest priority date of the application. However, in many cases (especially for Euro-PCT applications), these time limits seem to short to allow for discussion of the parent application with the examining division.

Coming back to the EPO proposal, given the considerable length of the proposed time limits the EPO further believes that they should be excluded at least from further processing. Re-establishment of rights could be allowed, provided the request be filed within two months of expiry of the time limit. This will mean amending Rules 135 and 136 EPC as well.

The legal consequence of non-compliance with the proposed time limits should be that the divisional application cannot be treated as a European divisional application. Otherwise the applicant could keep filing additional divisionals stemming from it until such time as it is refused.

Upon filing, the Receiving Section would check if the divisional application has been filed in time. If this is not the case, it would notify a loss of rights pursuant to Rule 112(1) EPC. The legal means of redress would be to request a decision or re-establishment of rights (Rule 112(2) or Rule 136 EPC). The fees paid for the application would be refunded if the loss of rights becomes final.

In cases of mandatory division, the Receiving Section will need an indication from the examining division or the board of appeal that (and when) the applicant was invited to limit the earlier application. That will mean some changes to the EPO's computer systems. A study on the impact of the proposed amendments should also be prepared.

VI. TRANSITIONAL ARRANGEMENTS

The amended version of Rule 36 EPC would apply only to divisional applications filed after its entry into force. Adequate transitional provisions for pending (potential parent) applications would therefore be needed. For instance, provision could be made that:

- if the time limits have expired before the date on which the new rule enters into force, a divisional application may still be filed within six months as from that date
- if they are still running on that date, they will continue to do so for not less than six months.

VII. PROPOSED AMENDMENTS

Rule 36

European divisional applications

- (1) The applicant may file a divisional application relating to any pending earlier European patent application:
 - (a) where the earlier European patent application does not meet the requirements of Article 82, within twelve months from the first communication by the Examining Division or the Board of Appeal inviting the applicant to limit the application;
 - (b) in any other case, within 55 months from the date of filing of the earliest application, or, if a priority has been claimed, from the priority date of that application.
- (2) - (4) unchanged

Rule 135

Further processing

- (1) unchanged
- (2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraph 1(a) and (b), Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 64 and Rule 112, paragraph 2.
- (3) unchanged

Rule 136

Re-establishment of rights

- (1) Any request for re-establishment of rights under Article 122, paragraph 1, shall be filed in writing within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit. However, a request for re-establishment of rights in respect of any of the periods specified in Article 87, paragraph 1, ~~and~~ in Article 112a, paragraph 4, and in Rule 36, paragraph 1(a) and (b), shall be filed within two months of expiry of that period. The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.
- (2) - (4) unchanged