

Europe

New rules for divisional patent applications: patent strategy will need to change

On April 1 2010 the European Patent Convention will be amended in a manner that will have a fundamental impact on IP business and strategy. The implementing regulations of the convention will be amended in regard to the possibility of filing divisional applications. Similarly, the rules on the European search report will also be changed.

Divisional patent applications and current practice

A basic rule of patent law is the principle of unity of invention: the examination of a patent application may lead to the grant of a patent for a single invention or a group of inventions so linked as to form a single general inventive concept (eg, see Article 82 of the European Patent Convention).

If a patent application contains several inventions not linked in this way, there is a lack of unity. An applicant must decide which invention in the application may be prosecuted in examination. To prevent any loss of rights by the applicant, European patent law allows the filing of divisional patent applications (in short: divisionals) to claim any further inventions. The applicant may divide the application into a certain number of divisional applications and maintain as the date of each the filing date of the initial application and the benefits of the right of priority, if any (Article 4G of the Paris Convention). In this way, the full content of the parent application remains available to the applicant as claimable subject matter.

The European Patent Convention currently implements the filing of divisionals in a rather simple manner: "The applicant may file a divisional application relating to any pending earlier European patent application." (Article 76, Rule 36(1) of the European Patent Convention.) In practice, the convention allows a divisional to be filed at any time while its parent application is still pending. In addition, the convention does not prevent a divisional for a given invention being filed as a duplicate when the parent application contains only a single invention.

On several occasions in the past couple of years the European Patent Office (EPO) has stated that the divisional applications practice was too broad and could result in abuse of the European patent system, and should therefore be limited.

New rules for divisional patent applications

As of April 1 2010 the rules for filing a divisional will be amended (Rules 36(1)(a) and 36(1)(b)). Under the amended rules, filing of a divisional is restricted. Two different scenarios are allowed under the amended European Patent Convention: a voluntary division and a mandatory division.

Voluntary division

Under Rule 36(1)(a), an applicant has the freedom to file a divisional application. A 24-month term is set for filing a voluntary divisional, calculated from the first Examination Office action of the earliest application. According to this rule, the Examination Office action relates to the first office action of the Examining Division and not to the (extended) European search report.

The 24-month time limit, starting from the first Examination Office action, applies to all the divisionals that the applicant may wish to file. No divisionals can be filed after expiry of the time limit.

This rule applies to cases where an application may contain several unlinked inventions and the claims relate to only one of these inventions. The first Examination Office action need not identify any lack of unity.

Mandatory division

Under Rule 36(1)(b), during examination of the application the examiner may issue an objection of non-unity. This may occur when the main claim cannot provide a basic single inventive concept for the dependent claims. In that case, the first official communication raising the non-unity objection triggers a 24-month time limit in respect of the patent

application under examination. Again, this allows the applicant to file any divisional within the time limit. Of course, the divisional is restricted to any subject matter of the patent application under examination.

Under this rule, the official communication that triggers the time limit is the first Examination Office action identifying the lack of unity. Again, after the time limit has expired no divisional can be filed.

Time for change

New Rules 36(1)(a) and (b) will effectively limit the current practice for filing divisionals. As a result, the freedom of applicants to file divisionals will be restricted. The practice of filing a divisional at any time during the period when the parent application is still pending is no longer possible.

Therefore, it may be necessary for interested parties to rethink how they deal with European patent applications.

Prepare to observe a new time limit

The new rules for divisionals limit the timeframe in which the applicant must decide how to proceed. In that sense, the new rules establish new time limits that must be observed.

Applicants (and their patent attorneys) should adapt their IP workflows to the new rules for each European patent application. In addition, applicants should be aware that since the amended rules relate to the filing of divisionals, the time limits may also affect patent applications that are filed before April 1 2010. For applications where the 24-month term has expired, a transitional period is available until October 1 2010.

Reconsider the contents of the application

Irrespective of the new regulations, the applicant still has the freedom to determine the content of the patent application. The applicant decides what subject matter is claimed and how many inventions are included in a single patent application.

However, to avoid any hassle with the voluntary division rule, it may be worth considering carefully which inventions are to be included in a patent application.

Even during the drafting process the applicant (and its patent attorney) should consider whether more than one invention should be included in the application.

In addition, consideration should be given to the unity of an invention and the embodiments of that invention being described. Embodiments should be consistent with each other to avoid different interpretations of the disclosed invention.

Further, examination of an application with claims for two or more non-linked inventions will obviously

result in an objection of non-unity in the first Examination Office action.

Based on the choices made, the applicant can foresee whether filing of a divisional application is needed before the end of the 24-month time limit from the first Examination Office action.

A lack of unity could also result from prior art found in a search report during the prosecution of the application. For example, prior art that seems to disclose at least some embodiments of the invention will lead to a lack of unity. In order to anticipate the formulation of such a lack of unity, potential applicants should carry out a prior art search before drafting an application. The results of this search could influence the way the application will be drafted and could minimise the risks of such a lack of unity.

A lack of unity occurring during the examination phase is less predictable. The search report can provide some insight as to whether the main claim can be maintained or amended without creating non-unity between the claims. In fact, the role of the search report (either the European search report or the Patent Cooperation Treaty (PCT) search report) and the attached written opinion will also change in April 2010, and will become more important in the European patent examination process (see below).

Filing a non-unitary patent application

It is still possible to file a patent application containing several non-unitary inventions and, in some circumstances, it may still be sensible to do so.

For example, the applicant may want to establish a filing date but to postpone a decision regarding which inventions are to be examined. Also, since only one application is filed, this option saves costs until the decision is made. Filing a divisional requires payment of all official fees due from the date of filing of the parent application.

Somewhat unexpectedly, voluntarily filing a divisional within 24 months of the first office action may provide a way to have subject matter pending for longer.

For example, take an earliest application which contains three non-linked inventions, but where only one invention is claimed. Thus, the claimed subject matter of the earliest application fulfils the unity requirement. The first Examination Office action will raise no objection. Next, within the 24-month time limit from the first office action in the earliest application, a divisional is filed in which both the second and third non-unitary inventions are claimed. In principle, for the divisional the examination will lead to a first office action raising a non-unity objection. According to Rule 36(1)(b), this objection establishes a new 24-month time limit.

In preparing amended Rule 36, the EPO considered the possibility to extend the lifetime of non-unitary subject matter. It is likely that the administrative council will amend the European Patent Convention in case of too many divisionals following this route, as this would be considered as an abuse (CA145/08).

Unfortunately, the well-established practice of filing a divisional just before an undesirable decision of the EPO during oral proceedings in examination, or just before grant, will no longer be available, since the 24-month time limit from the first Examination Office action will likely have expired by that time.

International (PCT) and foreign applications

For international applications that enter the European patent system (so-called Euro-PCT applications), the applicant should be aware that the first Examination Office action that may trigger the 24-month time limit is a European patent communication under Article 94(3), irrespective of any role of the EPO during the PCT phase (as either international search authority or international preliminary examination authority).

Of course, upon entry into the European patent system claims may be amended in consideration of the new regulations, in the same way as is currently allowed. For Euro-PCT applications, the applicant receives an invitation under Rule 161.

Restoration of rights

The new rules for divisionals are strict. For both voluntary and mandatory division the 24-month term is a fixed time limit. The restoration of rights by further processing (Article 121 of the European Patent Convention) is excluded (Rule 135(2)). However, re-establishment of rights under Article 122 of the European Patent Convention remains available, although it may be a difficult task for the applicant to prove that in spite of all due care it was unable to observe the time limit.

Mandatory reply to the search report

Although only laterally related to the filing of

divisionals, the search report and the search opinion are likely becoming more important when deciding whether to file a divisional.

From April 1 2010 the rules relating to the European search report and search opinion will be amended.

Under the amended rules, the applicant will be obliged to comment on the search report and search opinion. The comments may include amendments to the claims, description and drawings of the application.

A failure to reply has the consequence that the application is deemed to be withdrawn. These rules affect both European patent applications and Euro-PCT applications.

As mentioned above, it may be useful to anticipate the need for filing divisionals while preparing the mandatory reply, since the search report and opinion may already signal a lack of unity.

The European search report and opinion will not be regarded as the first Examination Office action.

Conclusion

The above-mentioned amendments to the European Patent Convention are part of an invitation by the EPO to improve the quality of the European patent system.

Applicants should realise that filing a divisional is still a right, albeit a restricted one. If an applicant files a patent application containing several non-linked inventions, it should conscientiously plan the course of the parent application and of any divisionals within the available time limits.

The forthcoming requirement to reply to the search report and written opinion may help applicants to work out how best to handle the parent and divisional applications.

Raising the bar for patent applications will reduce some flaws in the European patent system, at least from the viewpoint of the EPO. For applicants, raising the bar will limit the options to exercise the right to obtain a European patent. It remains to be seen how applicants will benefit from these amendments.



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