

The Deadlines for filing European Divisional Patent Applications

A new Rule came into force at the EPO on 1 April 2010 setting strict deadlines for filing divisional patent applications. The new Rule applies to all European divisional applications filed on or after 1 April 2010. This note explains the new deadlines.

The old law

Previously, a divisional application could be filed at any time before grant of the parent application. There was also nothing to prevent an applicant filing a divisional application derived from an earlier application which was itself a divisional application, leading to so-called chains of applications.

The new Rule

Under the new Rule, a divisional application must still be filed whilst the parent application is pending. In addition, it must be filed within 24 months from the first communication by an EPO examining division concerning the parent application or any earlier application in the chain (if the parent application is itself a divisional application), or within 24 months from a communication in which a specific non-unity objection is raised for the first time by an EPO examining division, if that period expires later.

No extension of these time limits will be possible, and further processing will not be available.

The new time limits will not start to run until a communication issues from an EPO examining division. Non-unity objections raised during the search phase or in the international phase will not therefore start the time limit for filing a divisional application running. The EPO has also confirmed that a communication under Rules 161 and 162 does not start the time limit running.

If the first communication from the examining division raises a non-unity objection, then the above deadlines will both expire at the same time. After issue of the first communication, if a later communication from the examining division raises a specific non-unity objection for the first time (i.e. raises a non-unity objection that has not previously been raised in relation to any application in the chain), that will extend the deadline for filing a divisional application. However, an examining division communication which simply repeats a non-unity objection which was raised previously by an examining division in relation to any application in the chain will not re-set the deadline.

The new time limits significantly restrict an applicant's opportunities to file divisional applications, especially chains of divisional applications. Applicants will no longer be able to wait until an application nears grant before deciding whether to file a divisional application, but will have to make such decisions at a much earlier stage during prosecution. In particular, after 24 months from the first communication by an EPO examining division on an application, any divisional application in the same chain can only be filed if a new (i.e. not previously raised) non-unity objection arises.



Transitional provisions

Under the transitional provisions, if the above time limits for filing divisional applications derived from any pending applications had already expired by 1 April 2010, one or more divisional applications may still be filed up until **1 October 2010**. Similarly, any of the above time limits already running on a pending application as of 1 April 2010 continue to run for at least **six months** after this date, i.e. until at least 1 October 2010.

Further information

For advice on the time limit for filing a divisional application in any particular case, please contact Dr Annabel Beacham or any other member of the Dehns Patent Group using the contact details below.

United Kingdom

Dehns
St Bride's House
10 Salisbury Square
London
EC4Y 8JD

T: +44 (0)20 7632 7200
F: +44 (0)20 7353 8895
E: london@dehns.com

Dehns
Aspect House
84-87 Queens Road
Brighton
BN1 3XE

T: +44 (0)1273 244200
F: +44 (0)20 7353 8895
E: brighton@dehns.com

Dehns
59 St Aldates
Oxford
OX1 1ST

T: +44 (0)1865 305100
F: +44 (0)20 7353 8895
E: oxford@dehns.com

Germany

Dehns
Singlspielerhaus
Sendlinger Str. 29
80331 Munich

T: +49 89 2422 8130
F: +49 89 2422 8140
E: munich@dehns.com

www.dehns.com