



New official terms for filing European divisional patent applications

In the past, European divisional patent applications could be filed as long as the parent application was pending, i.e. up to the grant of a patent or the rejection of the patent application. Therefore, the decision about the filing of a divisional patent application could be postponed up to the end of the examination procedure of the parent application.

For the future, it is still necessary that the parent application is pending. Additionally, the European Patent Office (EPO) introduces official terms for filing divisional patent applications so that the decision about the filing of divisional patent applications must be made earlier.

The EPO draws a distinction between a voluntary division and a mandatory division as follows.

I. Official term for voluntary division

A division of a patent application is voluntary if the EPO did not object a lack of unity of invention before. In such a case, the official term for filing a divisional patent application will expire 24 months after the first office action issued by the Examining Division of the EPO.

In case of a sequence of divisional applications, the 24-month term must be calculated from the date on which the Examining Division issued the first office action for the earliest application in the sequence, e.g. the grandparent application.

The following official communications are not considered as office actions in this meaning and therefore do not trigger the afore-mentioned official term for filing a divisional patent application:

- Supplementary European search report
- Extended European search report
- International search report issued by the EPO
- International preliminary examination report issued by the EPO.

II. Official term for mandatory division

A division is mandatory if the Examining Division of the EPO has objected a lack of unity of invention of the parent application. In such a case, the official term for filing a divisional patent application will expire 24 months after the office action in which the Examining Division raised the non-unity objection for the first time.

The official communications mentioned above under I. are not considered as office actions under this rule since they are not issued by the Examining Division of the EPO. For example, a non-unity objection raised in an international search report or in a supplemental European search report does not trigger the official term for filing a divisional patent application.

However, the following official communications trigger the official term for filing a divisional patent application:

- Summons issued by the Examining Division of the EPO if a non-unity objection is raised
- Minutes of a personal or telephone conversation with the Examining Division of EPO, if a non-unity objection is raised.

Therefore, the right to file a divisional patent application can be revived even after the expiration of the 24-months for a voluntary division, if the EPO raises a non-unity objection.

III. Transitional provisions

The above regulation will apply to all European divisional patent applications filed on or after April 1, 2010.

However, any time limits for filing divisional patent applications will be extended until October 1, 2010.

Therefore, for any older European patent applications for which the Examining Division of the EPO has already issued an office action more than 2 years before, the deadline for filing divisional patent applications is October 1, 2010.

IV. Implementation in practice

We suggest to review the entire portfolio of European patent applications to decide whether a divisional patent application shall possibly be filed. If so, we suggest to monitor the above-mentioned official terms to avoid an inadvertent loss of the right to file a divisional patent application. The decision to file a divisional patent application relating to an already existing European patent application should be made in due time before the deadline of October 1, 2010.

Please do not hesitate to contact us if you wish us to review your portfolio of European patent applications to calculate the above-mentioned official terms.

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If you have any questions, please contact:

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