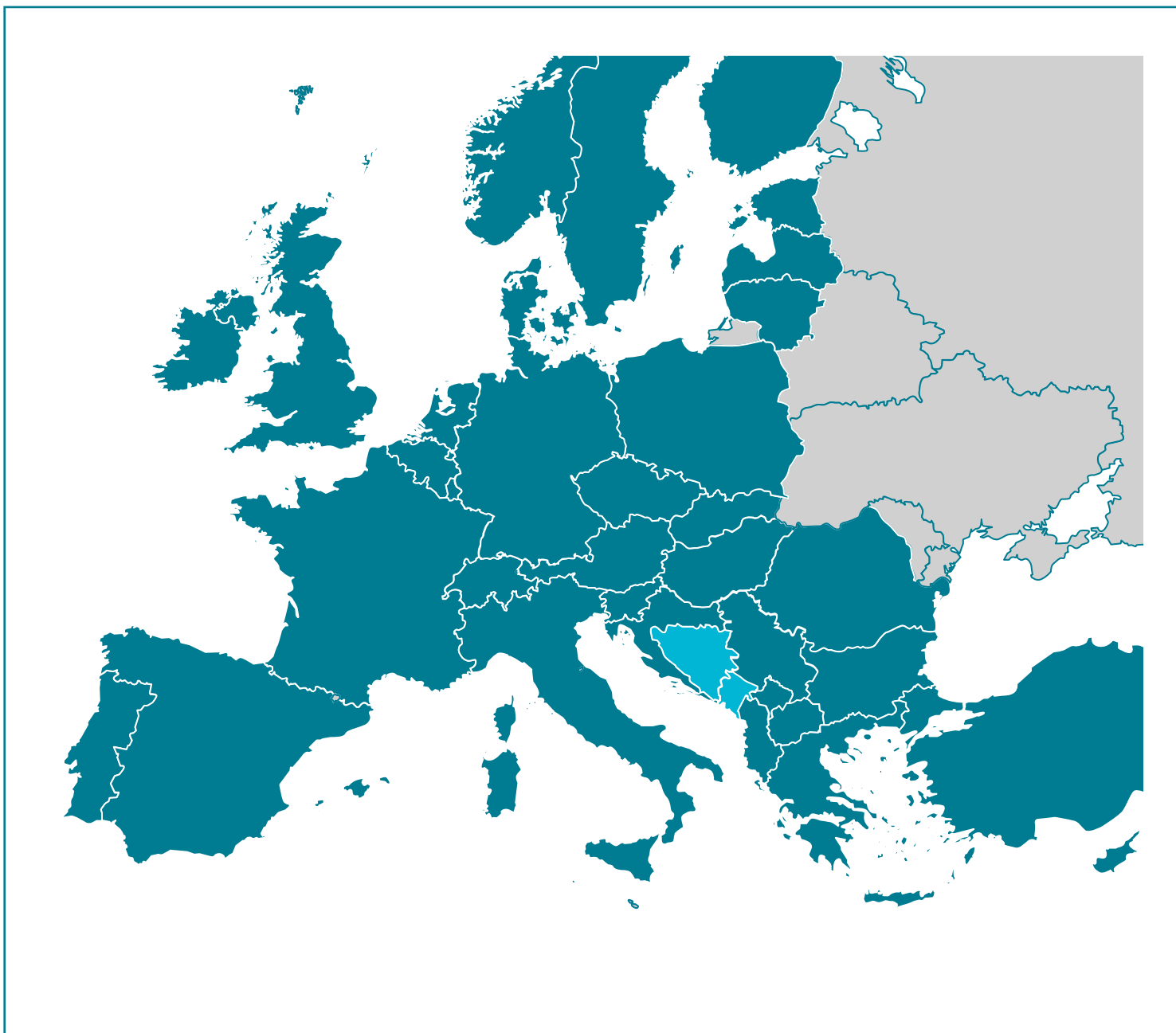




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EUROPEAN PATENTS

Legislative changes at the EPO as of 1 April 2014 - Part I: Divisionals

EUROPEAN PATENTS Legislative changes as of 1 April 2014 - Part I: Divisionals

As of 1 April 2014, the stringent time limits for filing divisional European Patent applications which had been introduced four years ago have been abolished.

Basically the situation thus reverts to that before 1 April 2010, allowing the filing of divisionals until the day before grant, refusal or (deemed) withdrawal.

Former Practice

From 1 April 2010 to 31 March 2014 a divisional could only be filed for an earlier pending application if at least one of the two 24-month time limits of former R.36(1)(a) or (b) EPC had not yet expired.

The declared aim of these changes was to prevent abuse of the system by precluding Applicants from filing divisionals late during prosecution and especially divisionals of application being already divisionals themselves.

These changes by the EPO put a huge burden on the Applicant and their representatives not only because of the monitoring of these particular time limits, but also because of the short time window left to file a divisional.

Changes as of 1 April 2014

The new practice of the European Patent Office (EPO) thus allows the filing of a divisional application as long as the parent application is pending, i.e. up to the day before grant, refusal or (deemed) withdrawal took effect. Furthermore, as it had been confirmed by the Enlarged Board of Appeal of the EPO, cascading of divisionals, i.e. the filing of a divisional of a pending divisional, is allowed under the EPC (decision G1/05).

Amended R. 36(1) EPC as in force from 1 April 2014 now simply reads as follows:

R. 36(1): *The applicant may file a divisional application relating to any pending earlier European patent application.*

Contrary to the situation before 1 April 2010, increasing fees have been introduced for divisionals of divisionals (divisional of a higher generation): new Rule 38(4) and Art. 2(1b) of the Rules relating to fees:

R. 38(4): *The Rules relating to Fees may provide for an additional fee as part of the filing fee in the case of a divisional application filed in respect of any earlier application which is itself a divisional application.*

Art. 2(1b) of the Rules relating to fees

in the case of a divisional application filed in respect of any earlier application which is itself a divisional application (Rule 38, paragraph 4)

- *fee for a divisional application of second generation*
210 €
- *fee for a divisional application of third generation*
420 €
- *fee for a divisional application of fourth generation*
630 €
- *fee for a divisional application of fifth or any subsequent generation*
840 €.

For the sake of completeness, the references to the former time limits of R. 36(1) have been deleted from R. 135 EPC.

Practical implications

The changes entered into force on 1 April 2014 and applied to all applications still pending on that date. Hence from that date, a divisional may be validly filed for any application pending at the time of filing the divisional, even if previous time limits under former R. 36(1) EPC already expired before 1 April 2014.

Finally, a divisional application can be filed in the language of the earlier application even if this application was not in an official language of the EPO, provided that a translation in the language of proceedings of the earlier application is filed within two months.

Do not hesitate to contact **OFFICE FREYLINGER** for additional information or documentation.

Decision of the Administrative Council of 16 October 2013
Legislative changes: Amended R.36(1), R.38(4) and R.135(2) EPC
Entry into force: 1 April 2014.