

## Practice Note - January 2010

### New Procedure for Division of European Patent Applications

Applicants are advised that, with effect from 1<sup>st</sup> April 2010, the filing of European Divisional Applications at the EPO will be significantly restricted in relation to past and present practice.

#### 1. Two year time limit for filing divisionals

From 1<sup>st</sup> April 2010 onward, applicants will have the right to file divisional applications relating to a pending European application only during a time window extending up to two years (24 months) from notification of a first communication in substantive examination issued on the original parent application.

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**\*\*ACTION REQUIRED\*\***

*Applicants are strongly advised to take careful note of this significant change in EPO practice.*

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In other words, once an examination communication has been notified in respect of an original or first parent application, then applicants will have up to two years to file any divisionals or further divisionals, provided an application to be divided is still pending at the time of filing its divisionals. The filing of a divisional application will not in itself give rise to a new 24 month time period for filing further divisionals.

#### 2. Exemption from the two year time limit, after lack of unity is raised

As an exception to the two-year time limit, applicants will be permitted to file divisional applications in relation to a pending application for a period of up to two years (24 months) following a **first** notification of a non-unity objection. In cases where a non-unity objection is raised subsequent to a first communication in substantive examination, this exception will afford an applicant more time for filing a divisional application. Note, this exception applies only where a **new** unity objection (i.e. new in its substance) is made which has not previously been raised. The restatement in an official communication, of a previously raised unity objection does not give rise to this exception. A first objection as to lack of unity which is made at an oral hearing or by telephone may give rise to this exemption.

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### 3. Transitional provisions

The new rules will be applied to pending applications at 1<sup>st</sup> April 2010, provided additionally that a minimum of six months will be permitted for the filing of divisional applications in respect of pending applications. Therefore, on pending applications for which the relevant two year time limit has expired or will expire before 1<sup>st</sup> October 2010, divisional applications may still be validly filed until **1<sup>st</sup> October 2010**.

### 4. Very limited legal remedy

For those cases where the two year time limit has not been observed, there is no possibility of obtaining further processing in respect of the missed deadline. The only remedy available will be restitution, for which a high level of proof must be provided as to how and why the time limit was not observed and as to due care having been exercised in respect of its observance.

#### Action

##### Pending cases

For pending applications in respect of which it is envisaged or expected that the filing of divisional applications at the EPO will be required, it will be necessary to take appropriate action in good time. Applicants are advised to review their pending patent applications in good time with regard to the need to file divisional applications and to issue appropriate instructions well before the final deadline of 1<sup>st</sup> October 2010.

##### Future practice

Applicants should become accustomed to taking strategic decisions concerning the filing of divisional applications at an early stage during the examination proceedings. It will become advisable to consider the possible need for divisional applications following receipt of the first substantive examination communication.

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#### Contact your attorney for more information on divisionals

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#### Further note

Under certain unusual circumstances, the applicable time limit for filing divisional applications can vary in ways not discussed above. This note does not present a fully exhaustive set of rules for all such circumstances. Applicants are advised to consult with their representative on a case by case basis, especially where it appears that unusual circumstances prevail.

##### References:

*Official Journal of the EPO 10/2009, page 481-485*

*Official Journal of the EPO 5/2009, page 296-304*

*Notice from the EPO dated 15<sup>th</sup> October 2009*

*Amended Rules 36(1) and (2) EPC, and Rule 135(2) EPC*