



EPO Proposals concerning Divisional Applications: EPO paper CA145/08 Rev 1

Ref:PP03/09

Comments

1. We are opposed to these proposals. They are a disproportionate reaction to the perceived problem of divisional applications filed at a late stage and unfair to applicants.
2. Rather than seeking to restrict the legitimate right of an applicant to file a divisional application, serious attention should be given to the proposals made by CIPA and EPI, under which a divisional of an earlier divisional application would only be allowable where fees on the earlier application have been paid. These proposals should deal with any potential alleged abuse.
3. The EPO should improve its present procedures. The lengthy delays in responding to comments from, and entering a meaningful dialogue with, applicants contribute to the need for divisional applications to be filed at a late stage.
4. An overall absolute deadline under draft rule 36(1)(b) of two years from the first communication from the examining division objecting under Article 82 (unity) is completely unreasonable. This might be the main objection in the communication and it might be wrong. The applicant may wish to challenge it. Until this has been resolved, and substantive communications have been issued on the resulting application or applications, it cannot be determined how the application or applications will develop and whether it will be necessary to file divisional applications on them for other reasons (see e.g., paragraph 8 below).
5. Under draft rule 36(1)(a), which will apply if there is no immediate objection as regards unity, the applicant will have two years from the examining division's first communication to file a divisional application. The first communication can often be terse and unhelpful. It may not address all the basic issues of patentability and sufficiency. It can often be a long time after this communication, sometimes considerably more than two years, before the applicant can get a response that leads to a constructive, meaningful dialogue with the examiner. To require a divisional application to be filed within two years of the first communication, before the form of the application to be granted becomes clear, is most unreasonable and will prevent applicants from obtaining the protection to which they are entitled (again, see e.g., paragraph 8 below). Moreover, a two year limit will rule out completely the possibility of filing a divisional on a divisional, because the chance of the EPO producing a reasoned communication on the first divisional within two years of the communication on the parent is remote.
6. Furthermore, if action is taken by the EPO at the search stage under the proposed new rule 62a (to restrict the search to one independent claim in a given category) with no opportunity under rule 64 to pay additional search fees in respect of other independent claims in the category, then it is possible, indeed likely, that applicants will argue under rule 62a(2) that several independent claims in one category are justified. It is unlikely that this issue will be resolved until well into the examination process, long after two years from the first examiner communication. If the examiner does not accept the argument, it may well become

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necessary to file a divisional application at that stage. The two year limit will not allow this.

7. The EPO appears in this and other recent proposals to be concerned about delays caused by applicants. Most undue delays result from EPO inaction, not from applicants.
8. There are a number of legitimate reasons for filing a divisional application other than those concerning unity of invention, and the need to file a divisional may not become clear until well into the examination process. For example, fresh prior art might be cited during the course of examination. There may be patentability issues in relation to part of the invention which can be pursued in a divisional, there may be an objection to plurality of claims in a category which can be resolved by filing a divisional, it may be desirable to divide out a narrow scope example from a broad scope invention.
9. It is not an abuse to file a divisional application shortly before an oral hearing, bearing in mind the ways in which oral hearings may be conducted and the potential for perverse decisions. It is not unknown for unexpected new argument to be introduced at hearings by the examining division, which might then proceed to refuse the application without allowing an opportunity for reconsideration and amendment.
10. The EPO's figures indicate that there are relatively few late filed divisional applications. As pointed out above, most of these will be filed with good reason. There should be prompt and meaningful communication between applicant and the EPO and the EPO should ensure that divisional applications are handled by the same examiner as handled the parent.