

Online open consultation regarding divisional applications (Rule 36 EPC)

Introduction

The Federation represents the views of a wide range of industries operating in the UK, Europe and internationally in intellectual property (IP) matters, both policy and practice, including patents. A list of members is attached.

The consultation

On 5 March 2013, the European Patent Office (EPO) launched a “transparent, inclusive and participative process” to collect as much information as possible on the impact and effectiveness of amended [Rule 36 EPC](#).

The introduction of the 24-month time limits for the filing of divisional applications responded to the need to avoid divisionals being used as a tool to prolong the pendency of subject-matter before the EPO. The precautionary filing of identical divisional applications, to escape the effects of a possible adverse decision, had become common practice to the detriment of legal certainty and procedural efficiency. The amendment sought to achieve an optimum balance between the legitimate interest of applicants in obtaining full protection for their inventions and the need to establish a clear cut-off point providing third parties with the necessary legal certainty.

Since the entry into force of the amended Rule, the overall number of divisional applications received has increased. This is due to remarkable growth in first-generation divisional applications. Subsequent generations of divisionals have, however, notably decreased.

The EPO notes that the amendment has raised concerns and criticism in the user community, and that the calculation and triggering of the time limits has given rise to some issues of implementation, despite the clarification introduced in the Rule and the general information provided.

Furthermore, decision [G 1/09](#) of the Enlarged Board of Appeal has changed at least some of the circumstances which gave rise to the amendment, by extending the possibility of filing divisional applications after refusal of the parent application and until expiry of time limit for appeal.

The deadline for submissions is **5 April 2013**.

IP Federation response

The IP Federation has responded as follows:

1. How has the introduction of the time limits for filing divisional applications affected you? (It would be useful to learn about your background and / or your professional activity, as well as to get some insights into the extent to which your comments are the result of direct experience)

The IP Federation represents IP intensive companies in the United Kingdom. Our member companies range from large multi-national companies to smaller SMEs, and are extensively involved with in intellectual property matters, including patents, in Europe and internationally. Not only do our companies own considerable numbers of IP rights, both in Europe and elsewhere, but they are affected by the activities and IP rights of competitors. They may be either plaintiffs or defendants in IP related court actions.

Generally it is felt across UK industry that the time limit imposed on the filing of divisional applications is unduly restrictive on Applicants, particularly in view of the increased restriction on changing claim scope in examination to cover what is deemed unsearched subject matter. Applicants in some sectors feel forced to file precautionary divisional applications to allow flexibility in future examination because at the expiry of the term under Rule 36 EPC, the examination of the parent application is still ongoing and often not progressed beyond the first Communication under Article 94(3) EPC and the response thereto.

2. What is your overall assessment of current Rule 36 EPC?

A divisional application is normally filed to protect an additional invention disclosed in the parent application. This can be necessary for example when subsequently found prior art eliminates the possibility to continue with the claims of the parent application in the form in which they were first filed.

The time limit imposed in current Rule 36 EPC comes at too early a time to allow the Applicant a just possibility to file a divisional application in both circumstances above.

The time limit expires prior to the start of the examination by virtually all major Patent Offices worldwide and often expires prior to the reaction from the European Examining Division to the response filed to the first Communication pursuant to Article 94(3) EPC.

This means that at the time a different Patent Office uncovers more relevant prior art *or* when the EPO Examining Division issues a second Communication, there remains no possibility in the European system to file a divisional application to seek appropriate protection for the invention.

3. What are, in your opinion, the most positive aspects of the current regime? Would it be possible to reinforce them? How?

The most positive aspect is the increased certainty as to the scope of protection sought for a European patent application by a third party, because a time limit is imposed by Rule 36 EPC.

4. Are there aspects of the Rule you think should be reconsidered? For example, should the time limits be extended from 24 to 48 or 60 months?

A set term should remain in the Rule so that legal certainty remains for third parties but that term should be longer than the current time and should be at least 48 months.

Alongside we would like to see a clear requirement on EPO Examining Divisions to continue and conclude examination promptly once started, i.e. following the issue of the first Communication pursuant to Article 94(3) EPC. Ideally a time limit should also be set on the Examining Divisions which is commensurate with the time limit imposed under a revised Rule 36 EPC.

5. Do you think that further amendment of the Rule would help to optimise it? If so, could you please outline your preferred option?

It would be useful for the Rule to be clarified to conform with the legal guidance issued in the [Notice](#) of 3 December 2012 (published in [EPOJ 1/2013](#)), viz. to clarify that the start of the time limit runs from the *notification* of the Examining Division's first Communication as well as to clarify the type of first Communication intended.

6. What kind of action other than legal measures (e.g. administrative or financial ones) do you think the EPO could take that would effectively address the issue of divisionals filed merely in order to prolong pendency?

A more expeditious examination procedure which provides an obligation on both the Applicant and the EPO Examining Divisions to bring examination to a close within a set, reasonable term from the date of requesting examination or from the date of the first Article 94(3) EPC Communication.

In some jurisdictions this is achieved by the requirement of an 'acceptance due' or 'compliance' period.

Final comment

It is hoped that this response will help enable the EPO to decide whether to make a proposal for a further amendment of Rule 36 EPC.

IP Federation
5 April 2013

IP Federation members 2013

The IP Federation represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. Its Council also includes representatives of the CBI, and its meetings are attended by IP specialists from three leading law firms. It is listed on the joint Transparency Register of the European Parliament and the Commission with identity No. 83549331760-12.

AGCO Ltd
ARM Ltd
AstraZeneca plc
Babcock International Ltd
BAE Systems plc
BP p.l.c.
British Telecommunications plc
British-American Tobacco Co Ltd
BTG plc
Caterpillar U.K. Ltd
Delphi Corp.
Dyson Technology Ltd
Element Six Ltd
Eli Lilly & Co Ltd
ExxonMobil Chemical Europe Inc
Ford of Europe
Fujitsu Services Ltd
GE Healthcare
GKN plc
GlaxoSmithKline plc
Hewlett-Packard Ltd
IBM UK Ltd
Infineum UK Ltd
Merck Sharp & Dohme Ltd
Microsoft Limited
Nokia UK Ltd
Nucletron Ltd
Pfizer Ltd
Philips Electronics UK Ltd
Pilkington Group Ltd
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