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1. How has the introduction of the time limits for filing divisional applications affected you?: **The Association of Danish Intellectual Property Attorneys (ADIPA) is a Danish association of intellectual property attorneys working in private practice. Among the members of ADIPA there are a large number of European and Danish patent attorneys. The following comments are made on behalf of ADIPA: In the experience of many members of ADIPA, the handling of time limits for filing divisional applications has become more complex since the introduction of the new Rule 36 EPC. This is even more so as there has been considerable uncertainty as regards the actual practice concerning R. 36 EPC: Firstly, calculating the time limits for filing divisional applications can be complicated, even for professional representatives, and practically impossible for non-professional users of the system. Secondly, it also appears that the EPO has had difficulties in arriving at the correct practice under R. 36: for instance it has been necessary to clarify which particular communications by the Examining Division trigger the time limit for filing divisional applications (e.g. which communication is to be considered the Examining Division's "first communication"). It is also the experience of ADIPA members that many clients, including foreign applicants (the EPC being rather unique in this area), have difficulties in understanding R.36 EPC and are often not able to make an informed decision about whether or not to file a divisional before the filing window closes.**

2. What is your overall assessment of current Rule 36 EPC?: **There is a general desire to promote innovation and investments in innovative businesses in Europe. A shortened time limit for filing divisional applications, as that provided in R. 36 EPC, does not necessarily support such policy and may in fact do the opposite: In many technical fields, product development is complicated, and there may be a considerable delay between an invention was made and the actual introduction of a product on the market. Consequently, under the current rules, the time limit for filing divisional applications may have been passed once an applicant arrives at the final product and the full understanding of what aspects of the invention require protection. In particular, this is often the case for pharmaceuticals: Once a biotechnology company has completed pre-clinical and clinical trials and has handed off its project and IP to a pharmaceutical company, there are very limited possibilities for amending the patent claims so as to improve the IP position. Amendments of the claims at a late stage in prosecution are often refused under R. 137(3) and then filing a divisional application may not be possible under R. 36. Some applicants may choose to file one or more divisional applications before expiry of the 24 month time limit just to be on the safe side and without having decided about the actual need for any divisional application. This creates unnecessary costs for the applicant and additional work for the EPO without increasing legal certainty for third parties. Generally, the increased complexity of the decision making process and of the management of time limits has most likely increased the costs for applicants.**

3. What are, in your opinion, the most positive aspects of the current regime? Would it be possible to reinforce them? How?: **In principle, it may be easier for third parties to assess, at an earlier stage, the scope of protection obtainable from a European patent application. However, the burden put on applicants by current R. 36 EPC seems disproportionate to the potential advantages gained by third parties. Expedited examination of divisional applications would be an alternative way of protecting the interests of third parties to gain early certainty as regards the scope of protection.**

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?: **Reverting to the EPC provisions regarding divisional applications before 2010 would be preferable, as this would result in a considerably less complicated rule set. Nevertheless, extension of the time limit would also be an improvement, in particular since examination often takes a long time, even after issuance of a first communication, thus potentially leaving the applicant in doubt about the fate of the application. Another possible improvement would be an extension of the circumstances under which a new period for filing a divisional application is available under R. 36(1)(b). In particular, such a new period could also be triggered by a new objection under R. 43(2) EPC or Rule 137(5) EPC. Despite these alternatives, reverting to the EPC provisions before 2010 is still considered the preferred solution.**

5. Do you think that further amendment of the Rule would help to optimise it? If so, could you please outline your preferred option?: **A dispensation allowing late filing of divisional applications under the discretion of the Examining Division may reduce the harsh effects of the current rules. Elements to be considered by the Examining Division when exercising such discretion may include an analysis as to whether the subject-matter of the divisional application is substantially the same as the subject-matter of the claims already examined, and whether the claims filed in the divisional application are a legitimate reaction to an earlier unity objection or an objection under R. 43(2) EPC or R. 137(5) EPC. Another possible amendment of the rules could postpone the start of the search and examination of divisional applications until after issuance of a communication pursuant to R. 71(3) EPC in the earlier application. The applicant could then be given one opportunity to amend the claims of the divisional application prior to the search. This would provide the applicant with an opportunity to select the subject-matter of the divisional application in view of the examination of the parent application, including non-unity objections or objections under R. 43(2) EPC that were raised late during the examination. Once started, the examination of the divisional application should be expedited.**

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?: **Fast examination of divisional applications after acceptance/refusal of the parent application would lessen any incitement for applicants to file divisional applications only with the purpose of prolonging pendency. As mentioned above, this measure would also be in the interest of third parties.**

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