

**CA/145/08**

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SUBJECT: Divisional applications

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: 1. Committee on Patent Law (for opinion)  
2. Administrative Council (for decision)

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#### SUMMARY

This document contains proposals for amendments to Rules 36, 57 and 135 EPC as adopted by decision of the Administrative Council of 7 December 2006 (CA/D 10/06) as well as a draft decision amending the Implementing Regulations to be taken by the Administrative Council.

The proposed amendments are indicated by grey hatching.

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## PART I

### I. **ABUSE OF DIVISIONAL APPLICATIONS**

#### A. **THE TERM "DIVISIONAL APPLICATION"**

The EPC does not define the term "divisional application". The situation most often giving rise to a divisional application is where the examining division raises an objection of lack of unity under Article 82 EPC. In such cases the applicant is informed that he is required to restrict the application to a single invention, and that if he wishes to obtain protection for any of the other inventions, then he can do so only by filing one or more divisional applications. This is consonant with Article 4 G(1) of the Paris Convention.

The applicant has also the option of filing a divisional application even if an objection of lack of unity has not been raised. For economic, procedural or other reasons, he may wish to have a particular part of the application removed so that he can obtain a separate patent for that part. This corresponds to Article 4 G(2) of the Paris Convention, which provides for voluntary filing of divisional applications.

Finally, Article 76(1), second sentence, EPC states that a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the parent application as filed. Applicants have understood this provision as meaning that a divisional application may be identical to the parent application. This view has not been objected to by the Enlarged Board of Appeal in decisions G 1/05 and G 1/06 of 28 June 2007 (OJ EPO 2008, 271, 307). The considerations of the Enlarged Board although based on Article 76 and Rule 25 EPC 1973 remain valid, as both provisions have remained unchanged in substance in the EPC 2000 (now Article 76 and Rule 36 EPC).

Thus in the European patent system the term "divisional application" encompasses both mandatory and voluntary division, and also both applications claiming subject-matter unclaimed (but disclosed) in the parent application and those directed to the same subject-matter as the earlier application.

#### B. **SEQUENCES OF DIVISIONAL APPLICATIONS**

In decisions G 1/05 and G 1/06 the Enlarged Board has further accepted sequences of divisional applications, pointing out that while Article 76(1) EPC

1973 is not explicitly worded to cover divisional applications stemming from divisional applications, it cannot be said to forbid them. Indeed, its provisions apply naturally to such applications on the principle that, in the absence of specific provisions to the contrary, a divisional is to be treated like any other application. This means that a divisional application (of whatever generation) may also be the "earlier application" within the meaning of Article 76(1) EPC 1973 for the purposes of a further divisional application. Rule 25 EPC 1973 reflects and supports this view by referring, without qualification, to the possibility of filing a divisional application from any pending earlier European application (Reasons point 10.2).

### **C. EVOLUTION OF THE IMPLEMENTING REGULATIONS CONCERNING DIVISIONAL APPLICATIONS**

This flexibility is the result of a series of amendments made to the implementing regulations to help the applicant obtain the maximum protection for his invention, within the boundaries of the disclosure of the initial application.

- The original version of Rule 25(1) EPC 1973 (now Rule 36 EPC) was worded as follows:

*A European divisional application may be filed:*

*(a) at any time after the date of receipt of the earlier European patent application by the European Patent Office, provided that after receipt of the first communication from the Examining Division, the divisional application is filed within the period prescribed in that communication or that after that period the Examining Division considers the filing of a divisional application to be justified;*

*(b) within two months following the limitation at the invitation of the Examining Division of the earlier European patent application if the latter did not meet the requirements of Article 82.*

EPO practice on voluntary division was that the examining division normally gave its consent unless the communication under Rule 51(4) EPC 1973 had already been sent. Therefore, the division's approval was seen as a mere formality, which caused complications in view of the different locations of the Receiving Section (The Hague) and the examining divisions (Munich). Furthermore, at that time it was considered that the fees payable for divisional applications prevented their

misuse (see CA/29/88). Therefore, with the aim of increasing the efficiency of the Office and improving the protection of the applicant's rights, this restriction was removed by decision of the Administrative Council of 10 June 1988 which entered into force on 1 October 1988 (OJ EPO 1988, 290).

- The amendment of Rule 25 EPC 1973 by decision of the Administrative Council of 7 December 1990, which entered into force on 1 June 1991, deleted the requirement that the description and drawings of the earlier patent application or any European divisional application could relate only to the matter for which protection was sought by that application (OJ EPO 1991, 4).

- Rule 25(1) EPC 1973 was amended a further time by the Administrative Council's decision of 18 October 2001, which entered into force on 2 January 2002, to state that a divisional application could be filed from any pending earlier European application, thus clarifying that the parent application could itself be a divisional (OJ EPO 2001, 488).

#### **D. ABUSE OF DIVISIONAL APPLICATIONS**

There is a trend for applicants to abuse these procedural possibilities by using the divisional application procedure to achieve a "duplication" of the proceedings. For example, the applicant files a(n identical) divisional application the day before the oral proceedings, i.e. before any refusal might occur and thus while the earlier parent application is still pending. If refusal ensues in the oral proceedings, instead of appealing against the negative decision of the examining division, the applicant simply pursues the divisional. Moreover, even if an appeal is filed and the refusal is confirmed by the board of appeal, this procedure allows him to have the same technical content discussed again. The applicant can repeat this tactic over and over again.

This is detrimental both to legal certainty for third parties and to patent office workloads. It should be borne in mind that divisionals currently make up around 5% of all European applications. Divisional applications of the second generation represent less than 7% of all divisionals, later generations less than 1%. Moreover, it cannot be excluded that the number of divisional applications may increase considerably as a consequence of the new claims fee policy.

In G 1/05 and G 1/06 the Enlarged Board of Appeal has also addressed the issue of the abuse of sequences of divisional applications. It has ruled that it sees no adequate basis in Article 76(1) and Rule 25 EPC 1973 for defining any additional requirements to be imposed on divisional applications beyond the requirements to be fulfilled by all applications. It notes that what some applicants consider a legitimate exploitation of the procedural possibilities afforded by the EPC, others consider an abuse in relation to the law as they think it ought to be rather than as it is. It finds it unsatisfactory that sequences of divisional applications, each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years. If administrative measures, such as giving priority to the examination of divisional applications and bundling and speedily deciding co-pending divisional applications so as to minimise the possibility for applicants to keep alive subject-matter on which the examining division had already given a negative opinion in one application by means of refiling the same subject-matter again and again, are not adequate, it would be for the legislator to consider where there are abuses and what the remedy could be (Reasons point 13.5).

However, while administrative measures may suffice to expedite the proceedings on pending divisional applications, they cannot prevent the filing of abusive divisionals. Therefore, to enable the Office to combat this, additional legislative restrictions seem necessary.

In the aforementioned decisions the Enlarged Board has further accepted the established practice of the EPO that claims of a divisional application are objected to and refused when the divisional application claims the same subject-matter as a pending parent application or a granted parent patent. However, this principle could not be relied on to prevent the filing of identical applications as this would run counter to the prevailing principle that conformity of applications with the EPC is to be assessed on the final version put forward ("prohibition of double patenting", point 13.4 of the respective Reasons; see also Guidelines for Examination in the EPO, C-IV, 7.4 and C-VI, 9.1.6). Moreover, it is pointed out that no objection of double patenting can be raised when the parent application has been refused, withdrawn or is deemed to be withdrawn as in the case presented above.

For these reasons the EPO had prepared a proposal for amendment of Rule 36(1) EPC (CA/PL 8/08), which was discussed at the last SACEPO and PLC meetings

and has been revised, taking into account both the observations made by the members of these groups at the respective meetings and the relevant documents submitted by the *epi* (CA/PL 9/08) and the Netherlands delegation (CA/PL 5/08) in this matter.

## **E. DOCUMENTS CA/PL 9/08 AND CA/PL 5/08**

In its position paper CA/PL 9/08, the *epi* proposed that Rules 36 and 70 EPC be amended in order to require that the applicant requests examination on filing the divisional application and pays the examination fee within one month of the filing.

This proposal would certainly contribute to reducing the pendency time of the divisional but would not solve the problem as defined above, essentially because it does not address the filing itself. It is reminded that, once the divisional application is pending, i.e. even before the examination fee becomes due according to the proposal, the applicant may file a further divisional application. It follows that systematic filing of (abusive) divisional applications could not be prevented.

In CA/PL 5/08 the Netherlands delegation proposed to introduce time limits for the filing of voluntary divisional applications. After this term a divisional application could only be filed after a non-unity decision of the examiner.

In this paper the Netherlands delegation further suggested that after expiry of the proposed time limits, other inventions, described in the application but for which patent protection was not asked in the claims, could not be added as an independent new claim. It pointed out that permitting this would result in a non-unity decision of the examiner and in this way circumvent the limitation of filing divisional applications.

The EPO fully appreciates this concern. However, in view of Rule 137(4) EPC, which already restricts the possible amendments of the claims, the EPO would not propose additional restrictions to the claimed subject-matter. In particular, Rule 137(4) EPC states that amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Moreover this limitation could be extended in the next future according to the proposal to amend Rule 137 EPC (see CA/PL 14/08).

The Netherlands delegation further proposed to create a PACE request for third parties. It is submitted that this subject should not be limited to divisional applications but be discussed in respect of all European applications.

#### **F. REVISED PROPOSAL FOR AMENDMENT OF RULES 36 AND 135 EPC**

As underlined at the last meetings, what is needed are additional rules to prevent the filing of abusive divisionals without affecting legitimate applications such as non-unity divisionals. To this end time limits should be established for the filing of divisional applications. To keep things as simple as possible, the same treatment should be foreseen for both Euro-direct and Euro-PCT applications. In order to give the applicant the opportunity to discuss the application with the examining division, the applicant should be allowed to file a divisional application on his own initiative up to 24 months after the first communication of the examining division issued for the earlier application (parent application) or, where applicable, issued for a still prior application (e.g. grandparent application). Thus, in case of a sequence of divisional applications the 24 months are not to be calculated from the date of the first communication of the examining division issued for the parent application when a first communication has already been issued for the grandparent application but from this latter. By doing this, a cut-off date is established for the filing of voluntary divisionals of whichever generation.

The proposed time limit runs in its entirety in the European examination phase, so that it applies in the same way both to Euro-direct and Euro-PCT applications.

After that date, only the mandatory division shall be allowed. For this purpose, it should be ruled that after expiry of the above mentioned term the filing of a divisional application shall only be admissible, if the divisional application is filed within 24 months from a communication of the Examining Division raising an objection that the earlier application (parent application) did not meet the requirements of Article 82 EPC.

Also in this case, the 24 months should not start again with each communication of the examining division discussing the same non-unity objection but it should be calculated from the communication in which the Examining Division raises the objection for the first time. On the contrary, a new time limit of 24 months will begin when a different non-unity objection is made.

The legal consequence of non-compliance with the proposed time limits will be that the divisional application cannot be treated as a European divisional application. Otherwise the applicant could keep filing additional divisionals stemming from it until such time as it is refused.

Given the considerable length of the proposed time limits the EPO further proposes that they should be excluded from further processing. Re-establishment of rights should however be allowed. This entails amending Rule 135 EPC as well.

Upon filing, the Receiving Section will check if the divisional application has been filed in time. If this is not the case, it will notify a loss of rights pursuant to Rule 112(1) EPC. The legal means of redress will be to request a decision or re-establishment of rights (Rule 112(2) or Rule 136 EPC). The fees paid for the application will be refunded if the loss of rights becomes final.

If a mandatory divisional is filed later than 24 months from the first communication of the Examining Division, the Receiving Section will need an indication that a non-unity objection has been raised. For this purpose the applicant will be invited in the request for grant (Form 1001) to indicate the first communication of the Examining Division in which the relevant objection of non-unity was made. This has an impact on the EPO computer systems, which will be addressed before the entry into force of the amended Rule.

## **G. TRANSITIONAL ARRANGEMENTS**

The amended version of Rule 36(1) EPC will apply only to divisional applications filed after its entry into force. Adequate transitional provisions for pending (potential parent) applications are therefore needed. The EPO proposes that:

- if the time limits have expired before the date on which the new rule enters into force, a divisional application may still be filed within six months as from that date;
- if they are still running on the date on which the new rule enters into force, they will continue to do so for not less than six months.

The amended version of Rule 135 EPC will apply to these transitional periods, i.e. the aforementioned periods will be excluded from further processing but susceptible of re-establishment.

## **II. LANGUAGE OF DIVISIONAL APPLICATIONS**

The text of Rule 36(2) in force since December 2007 says that a divisional application must be written in the language of the proceedings for the earlier application in order to simplify and streamline the procedure. In practice, divisional applications have virtually always been filed in the language of the proceedings for the parent application, even though EPC 1973 allowed them to be filed in the original language of the parent application, for instance Spanish or Dutch.

However, the option of using any language for filing European patent applications could have increased demand for divisional applications in the original language of the parent application, given that Article 14(2), second sentence, EPC allows the translation of an application to be adapted to the original text at any stage of the grant procedure. But Rule 36(2) EPC as currently worded has eliminated the possibility of adapting the divisional application, which has to be filed in the language of the proceedings for the parent application, to the latter's original text, which of course forms the basis for the wording of the divisional application. Moreover in the case of divisional applications filed under Rule 40(2) and (3) EPC with a reference to the earlier European application in a non-EPO language, it is fundamentally unsatisfactory to have to refer not to the original text of the earlier application but to its translation into the language of the proceedings. It is therefore proposed that Rule 36(2) EPC be amended to enable divisional applications to be filed in the language of the proceedings or the original language of the parent application.

Upon filing, the Receiving Section will check if the divisional application has been filed in an admissible language. If this is not the case, it will notify a loss of rights pursuant to Rule 112(1) EPC. The legal means of redress will be to request a decision (Rule 112(2) EPC). The fees paid for the application will be refunded if the loss of rights becomes final.

If the applicant fails to provide the translation required in amended Rule 36(2) EPC, the system of Rules 57(a) and 58 EPC shall apply. For this purpose, Rule 57(a) EPC has to be amended as well. Further processing will be excluded and re-establishment of rights will be allowed.

### III. PROPOSED AMENDMENTS

<p style="text-align: center;"><u>Present wording</u></p> <p style="text-align: center;"><b>Rule 36</b></p> <p style="text-align: center;"><b>European divisional applications</b></p>	<p style="text-align: center;"><u>Proposed wording</u></p> <p style="text-align: center;"><b>Rule 36</b></p> <p style="text-align: center;"><b>European divisional applications</b></p>
<p>(1) The applicant may file a divisional application relating to any pending earlier European patent application.</p>	<p>1) The applicant may file a divisional application relating to any pending earlier European patent application, <b>provided that:</b></p> <p><b>(a) the divisional application is filed before the expiry of a time limit of 24 months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or</b></p> <p><b>(b) the divisional application is filed before the expiry of a time limit of 24 months from a communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC.</b></p>
<p>(2) A divisional application shall be in the language of the proceedings for the earlier application and shall be filed with the European Patent Office in Munich, The Hague or Berlin.</p>	<p>(2) A divisional application shall be <b>filed</b> in the language of the proceedings for the earlier application. <b>If the latter was not in an EPO official language, the divisional application can be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.</b></p>

<p>(3) The filing fee and search fee shall be paid within one month of filing the divisional application. If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn.</p>	<p>(3) unchanged</p>
<p>(4) The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application. Rule 39, paragraphs 2 and 3, shall apply.</p>	<p>(4) unchanged</p>
<p style="text-align: center;"><u>Present wording</u></p> <p style="text-align: center;"><b>Rule 57</b></p> <p><b>Examination as to formal requirements</b></p>	<p style="text-align: center;"><u>Proposed wording</u></p> <p style="text-align: center;"><b>Rule 57</b></p> <p><b>Examination as to formal requirements</b></p>
<p>If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with Article 90, paragraph 3, whether:</p> <p>(a) a translation of the application required under Article 14, paragraph 2, or under Rule 40, paragraph 3, second sentence, has been filed in due time;</p>	<p>unchanged</p> <p>(a) a translation of the application required under Article 14, paragraph 2, <b>under Rule 36, paragraph 2, second sentence</b>, or under Rule 40, paragraph 3, second sentence, has been filed in due time;</p>
<p>(b) the request for grant of a European patent satisfies the requirements of Rule 41;</p>	<p>(b) unchanged</p>
<p>(c) the application contains one or more claims in accordance with Article 78, paragraph 1(c), or a reference to a previously filed application in accordance with Rule 40, paragraphs 1(c), 2 and 3, indicating that it replaces also the claims;</p>	<p>(c) unchanged</p>

(d) the application contains an abstract in accordance with Article 78, paragraph 1(e);	(d) unchanged
(e) the filing fee and the search fee have been paid in accordance with Rule 17, paragraph 2, Rule 36, paragraph 3, or Rule 38;	(e) unchanged
(f) the designation of the inventor has been made in accordance with Rule 19, paragraph 1;	(f) unchanged
(g) where appropriate, the requirements laid down in Rules 52 and 53 concerning the claim to priority have been satisfied;	(g) unchanged
(h) where appropriate, the requirements of Article 133, paragraph 2, have been satisfied;	(h) unchanged
(i) the application meets the requirements laid down in Rule 46 and Rule 49, paragraphs 1 to 9 and 12;	(i) unchanged
(j) the application meets the requirements laid down in Rule 30 or Rule 163, paragraph 3.	(j) unchanged
<u>Present wording</u> <b>Rule 135</b> <b>Further processing</b>	<u>Proposed wording</u> <b>Rule 135</b> <b>Further processing</b>
(1) Further processing under Article 121, paragraph 1, shall be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act shall be completed within the period for making the request.	(1) unchanged

<p>(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 64 and Rule 112, paragraph 2.</p>	<p>(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, <b>Rule 36, paragraphs 1(a),(b) and 2,</b> Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, <u>62a, 63,</u> 64, Rule 112, paragraph 2, <b>and Rule 161, paragraph 2.</b><sup>1</sup></p>
<p>(3) The department competent to decide on the omitted act shall decide on the request for further processing.</p>	<p>(3) unchanged</p>

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<sup>1</sup> The underlined changes are a consequence of the proposals for amendment of the implementing regulations made in CA/PL 14/08.

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL  
of [date of decision]  
amending the Implementing Regulations to the EPC

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THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Considering that amendments to Rules 36, 57 and 135 EPC are necessary and useful in the light of recent developments,

Having regard to the EPC, and in particular Article 33(1)(c) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

HAS DECIDED AS FOLLOWS:

Article 1

The Implementing Regulations to the EPC shall be amended as follows:

**1. Rule 36 (1) and (2) shall be amended to read as follows:**

"(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:

(a) the divisional application is filed before the expiry of a time limit of 24 months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or

(b) the divisional application is filed before the expiry of a time limit of 24 months from a communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC.

(2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an EPO official language, the divisional application can be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin."

**2. Rule 57(a) shall be amended to read as follows:**

"(a) a translation of the application required under Article 14, paragraph 2, under Rule 36, paragraph 2, second sentence, or under Rule 40, paragraph 3, second sentence, has been filed in due time;"

**3. Rule 135(2) shall be amended to read as follows:**

"(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraphs 1(a) and (b) and 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64, Rule 112, paragraph 2, and Rule 161, paragraph 2."

Article 2

1. This decision shall enter into force on 1 January 2010.
2. Rule 36(1) and (2), as amended by this decision, shall apply to divisional applications filed on or after that date.

### Article 3

The following transitional provisions shall apply to the amended provisions. If the time limits provided for in amended Rule 36(1) EPC have expired before 1 January 2010, a divisional application may still be filed within six months of that date. If they are still running on 1 January 2010, they will continue to do so for not less than six months. Amended Rule 135(2) EPC shall apply to these transitional periods.

Done at Munich, [date of decision]

For the Administrative Council  
The Chairman

Roland GROSSENBACHER