Prinz & Partner. PATENTANWÄLTE RECHTSANWÄLTE

Legal Update
Nov. 2013

IMPORTANT CHANGES OF EPO RULES OF PROCEDURE

reported by Jochen Sties

The European Patent Office has recently decided to change the way two very important issues are administered: the deadline for filing divisional applications and the possibility for paying additional search fees when you enter the European phase of a PCT application.

Divisional Applications

Currently when you file a divisional application there are strict time constraints. In general a divisional application can only be filed within a narrow window namely 24 months from the receipt of the first Office Action (Rule 36 EPC).

However from **1st April 2014** these constraints will be removed.

You will be able to file a divisional application for any European patent application as long as it is still pending – including those for which the traditional 24 month window has already expired.

In essence this means the former status will almost be re-established and applicants will be able to file as many divisional applications as they need to, wherever and whenever necessary.

"If you are facing a situation in which a divisional application needs to be filed from an existing application that has missed the 24-month window, please contact me at j.sties@prinz.eu".

The only catch is that the filing fee for any divisional application based on an earlier divisional application (including both second and subsequent generation divisionals) will be higher than a regular normal filing fee.

We will suggest strategies you can employ to keep your existing application pending until 1 April 2014 at which point you can file your divisional application.

Additional Search Fee

Currently when you enter the European phase of a PCT application, you may find the EPO's supplementary search report identifies some of the subject matter you have claimed does not comply with the requirement of unity of invention.

For further Information:
Jochen Sties - Prinz & Partner, Rundfunkplatz 2, 80335 Munich
Telephone: +49 (0) 89 / 59 98 87-0, Telefax: +49 (0) 89 / 59 98 87-211, E-mail: info@prinz.eu

The Examiner will then conduct a more specific search on the invention first mentioned in your claim (Rule 164 EPC). If the subject matter is identified as being a second (or subsequent) invention, you will have to file a divisional application if you are going to progress. If this is the case, you will have to file a divisional application blind, not knowing whether the subject matter of the alleged second (or subsequent) invention is actually patentable.

However, from the **1st November 2014** the EPO will allow applicants to pay additional search fees to allow the entire subject matter of an application to be searched. The applicant then has the information they need to make an informed decision as to which claims they pursue in the original application.

If subject matter is uncovered that cannot be prosecuted in the original application, you will be able to file a divisional application directed specifically to the subject matter your search report refers to.

This change will allow you to make a much more accurate assessment of the chances you will obtain your patent.

Questions?

If you have any questions regarding the changes, please feel free to contact our team of attorneys via Jochen Sties at J.Sties@prinz.eu.

We will be more than happy to discuss the changes and, more importantly, highlight how they might affect your practice.

For further Information:
Jochen Sties - Prinz & Partner, Rundfunkplatz 2, 80335 Munich
Telephone: +49 (0) 89 / 59 98 87-0, Telefax: +49 (0) 89 / 59 98 87-211, E-mail: info@prinz.eu