

SUBJECT: Divisional applications

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: Administrative Council (for decision)

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 proposal contains editorial amendments to the proposed text of Rule 36(1)(b) EPC in the light of the discussions in the Committee on Patent Law.

This document replaces CA/145/08 Rev. 1 dated 15.01.2009. The amendments are indicated by grey hatching.

TABLE OF CONTENTS

Subject	Page
PART I	1
I. STRATEGIC/OPERATIONAL	1
II. RECOMMENDATION	1
III. MAJORITY NEEDED	1
IV. CONTEXT	1
V. ABUSE OF DIVISIONAL APPLICATIONS	2
A. THE TERM "DIVISIONAL APPLICATION"	2
B. CONDITIONS FOR EXERCISING THE RIGHT TO DIVIDE OUT	2
C. SEQUENCES OF DIVISIONAL APPLICATIONS	3
D. EVOLUTION OF THE IMPLEMENTING REGULATIONS CONCERNING DIVISIONAL APPLICATIONS	3
E. ABUSE OF DIVISIONAL APPLICATIONS	5
F. DOCUMENTS CA/PL 9/08 AND CA/PL 5/08	6
G. PROPOSAL	7
H. TRANSITIONAL ARRANGEMENTS	9
VI. LANGUAGE OF DIVISIONAL APPLICATIONS	9
VII. ALTERNATIVES	10
VIII. LEGAL BASIS	11
IX. DOCUMENTS CITED	11
X. PROPOSED AMENDMENTS	12
PART II	16

PART I

I. **STRATEGIC/OPERATIONAL**

Operational

II. **RECOMMENDATION**

The Administrative Council is requested:

- to decide on the draft decision in Part II of this document.

III. **MAJORITY NEEDED**

3/4

IV. **CONTEXT**

The revised proposal (CA/145/08), which also included a proposal for amending Rule 36(2) EPC, was discussed at the PLC meeting on 27-28.10.2008. Regarding Rule 36(1) EPC the objection was raised that the proposed time limits did not cover every case in which the filing of a divisional could be justified. For instance, when new state of the art was cited late in the proceedings, the applicant might wish to file a divisional application for part of the application in order to avoid any delay in the granting of a patent.

The general opinion was that more flexibility was needed in order to allow "legitimate" divisional applications to be filed even after the proposed time limits had expired. To this end, it was proposed that the possibility of filing a divisional application at the Office's discretion should be (re-)introduced.

Taking into account both the arguments presented in the meeting and the considerations set out below (point VII), the EPO concluded that the 24-month time limits proposed in CA/145/08 gave applicants enough flexibility. It therefore decided not to amend its proposal further. CA/145/08 Rev. 1, substantially the same as CA/145/08, was discussed at the last PLC meeting, where similar objections were raised once again. The concerns voiced were thoroughly discussed, and the principle of the EPO initiative was unanimously welcomed and broadly supported. The EPO remains convinced that its proposal offers an adequate and appropriate solution for the issues at hand, improving overall quality and increasing legal certainty while also fully preserving legitimate rights and expectations.

V. ABUSE OF DIVISIONAL APPLICATIONS

A. THE TERM "DIVISIONAL APPLICATION"

The EPC does not define the term "divisional application". The typical situation 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, 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.

Thus in the European patent system the term "divisional application" encompasses both mandatory and voluntary division.

B. **CONDITIONS FOR EXERCISING THE RIGHT TO DIVIDE OUT**

Mandatory division found its way into the Paris Convention in 1925, and has never been controversial. It has always been linked to the issue of unity, which had to be verified and, if necessary, objected to by the examiner.

The possibility of voluntary division was first introduced at the 1958 Lisbon Revision Conference. The "Guide to the application of the Paris Convention" (Prof. G.H.C. Bodenhausen, Director of BIRPI, originally published by BIRPI in 1969) has the following to say (on p. 57) about voluntary division and Article 4 G(2): "The possibility of dividing patent applications on the initiative of the applicant having been accepted by the Convention, the conditions of the exercise of such right - **for example, a term within which it must be exercised** (emphasis added) - are left to be determined by national legislation."

Article 76(1), second sentence, EPC specifies a single substantive condition, namely 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 remain valid, although based on Article 76 and Rule 25 EPC 1973, as both provisions are substantively unchanged in the EPC 2000 (now Article 76 and Rule 36 EPC). It follows that the notion of "divisional application" under the EPC covers not only applications claiming subject-matter unclaimed (but disclosed) in the parent application but also those directed to the same subject-matter as the earlier application.

As far as the formal requirements for exercising the right to divide out are concerned, Rule 36(1) EPC currently requires merely that the earlier (parent) application be pending at the time the divisional is filed.

C. 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).

D. 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 however caused (mainly practical) complications because 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).

E. 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 divisional applications 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 1.5%. Although the percentage appears low, when translated into absolute numbers it represents a significant volume of work. 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 (re-)filing 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).

An internal review of the issue led to the conclusion that, 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 are 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 upon 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 to the examining division ("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 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 was revised (CA 145/08), 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. Following discussions at the PLC meeting on 27 and 28.10.2008 the issue was discussed again internally in the light of the concerns raised during the meeting (e.g. the German delegation's point about new prior art cited so late in the proceedings that there was no longer time to file a divisional as would otherwise have been done). The ensuing CA/145/08 Rev. 1 was in turn discussed in depth in the SACEPO Working Party Rules on 18.12.2008, although the actual proposal was substantially the same as that in CA/145/08.

F. 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.

G. PROPOSAL

As underlined at the previous 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.

To give the applicant the opportunity to discuss his application with the examining division, he should be allowed to file a divisional application on his own initiative up to 24 months after the first examining division communication for the earliest

application (in a sequence of divisional applications) for which a communication is actually issued, which may be the parent or grandparent or an even earlier application. This should establish a cut-off date 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 still 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. This implies that, each time a different/new non-unity objection is raised, a new time limit of 24 months will begin. In the light of comments made at the very last PLC meeting, particularly by the Hungarian delegation, the provision's wording has been amended slightly to make it more precise and more thoroughly in keeping with the present explanations.

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 further divisionals stemming from it, until such time as it is refused.

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.

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. It is noted that, for reasons of procedural economy, the currently proposed draft also contains the amendments to this provision resulting from the proposals contained in CA/29/09.

H. 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.

VI. 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.

VII. ALTERNATIVES

The alternatives are:

- To decide that the draft decision be amended to (re-)introduce the possibility of filing a divisional application at the Office's discretion. From the point of view of procedural efficiency, it has to be underlined that the (re-) introduction of the discretion would cause considerable delays in the proceedings (communications, appealable decision, appeal procedure). Arguably, such a system would allow better account to be taken of the specific circumstances of each case. Still, it would be difficult for applicants to foresee whether the filing of the divisional is justified or not, and they would not necessarily agree with the EPO's decisions in the matter either. It would, however, take years before relevant case law developed, so that for a long time there would be no reliable guidance on this. Further, if the board of appeal considers the filing justified in the case in point, the application would have to be treated as a

European divisional application. However, this may happen a long time after the filing of the application, thereby undermining any notion of legal certainty. After all, the timing of the filing is especially relevant both for the public, which would suddenly be confronted with the divisional application, and for the applicants, since the Office's "discretion" would only apply to applications filed quite late (after expiry of the proposed time limits) but still subject to the 20-year term from the filing date of the original application.

- To decide that the draft decision be amended to allow the applicant to file a divisional application within the time limit provided for in Rule 36(1)(b) if a patentability objection is raised on the basis of new state of the art introduced late in the proceedings. However, an applicant who wanted to file a divisional application might simply modify the claims to include a feature requiring a new document to be cited. Hence, this possibility could be used to circumvent any limitation on the filing of divisional applications.
- To decide that the draft decision be amended to provide for a longer time limit. The EPO is however convinced that the proposed duration is perfectly adequate to ensure the fair treatment of applicants in this matter while respecting the public's entitlement to legal certainty.

VIII. LEGAL BASIS

Article 33(1)(c) EPC

IX. DOCUMENTS CITED

CA/PL 5/08, CA/PL 9/08, CA/145/08, CA/145/08 Rev. 1

X. PROPOSED AMENDMENTS

<p style="text-align: center;"><u>Present wording</u></p> <p style="text-align: center;">Rule 36</p> <p style="text-align: center;">European divisional applications</p>	<p style="text-align: center;"><u>Proposed wording</u></p> <p style="text-align: center;">Rule 36</p> <p style="text-align: center;">European divisional applications</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, provided that:</p> <p>(a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or</p> <p>(b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.</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 filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may 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.</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;">Rule 57</p> <p style="text-align: center;">Examination as to formal requirements</p>	<p style="text-align: center;"><u>Proposed wording</u></p> <p style="text-align: center;">Rule 57</p> <p style="text-align: center;">Examination as to formal requirements</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, under Rule 36, paragraph 2, second sentence, 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> Rule 135 Further processing	<u>Proposed wording</u> Rule 135 Further processing
(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, Rule 36, paragraphs 1(a), 1(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,]¹ 64 and Rule 112, paragraph 2.</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>

¹ These changes are a consequence of the proposals for amendment of the implementing regulations made in CA/29/09 (q.v.). They are mentioned here for the sake of completeness and to enable a consolidated amended version of Rule 136 EPC to enter into force.

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
amending the Implementing Regulations to the
European Patent Convention

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 European Patent Convention (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 twenty-four 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 twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

(2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may 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), 1(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 and Rule 112, paragraph 2."

Article 2

1. This decision shall enter into force on 1 April 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 April 2010, a divisional application may still be filed within six months of that date. If they are still running on 1 April 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

Benoît BATTISTELLI