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## New Rules of the European Patent Office which may Significantly Affect Prosecution of European Patent Applications

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**The European Patent Office (EPO) recently announced new rules that will come into force on April, 1 2010. These rules concern newly introduced time limits for filing divisional applications and some other changes that will affect prosecution of European patent applications.**

Under the new rules, a non-extendible 2-year time limit will be introduced for filing a divisional application, which will be calculated from the later to occur of a first Examination Report or an objection to unity<sup>1</sup>. In other words, once a first Examination Report is issued in a patent application, all divisional applications derived directly or indirectly from that application<sup>2</sup> will have to be filed within 2 years of the date of that first Examination Report. In the event that the Examiner later raises a unity objection, the 2-year clock will be reset and a new 2-year time limit will apply.

The 2-year time limit will apply to all pending applications existing on April 1, 2010; even to those applications where examination has already begun before that date. However, for cases where the 2-year time limit would fall before or soon after April, 1 2010, a 6-month grace period will be provided, expiring on October 1, 2010, for filing a divisional application.

The new rules also include provisions that will affect prosecution of European National Phase applications that are derived from a PCT application, where the EPO acted either as the International Searching Authority (ISA) and/or International Preliminary Examining Authority (IPEA).

Upon entry into the European national phase, the EPO will issue a communication inviting the applicant to comment on the Written Opinion, issued by the EPO in its capacity as ISA or IPEA. Applicant will be required to respond within one month of the invitation.

Failure to file the response within this relatively short period of time may cause the application to become abandoned. A further processing remedy is available in respect of this deadline but it should not be relied upon, as a matter of course.

A third important change in the new rules relates to the ability to make voluntary amendments. Under the existing rules, applicants are allowed to make a voluntary amendment in reply to a first office action, even when such an amendment is not within the context of a response to a specific objection raised in the Office Action. Under the new rules, voluntary amendment will only be permitted with the Examiner's consent. Voluntary amendment will be acceptable as a matter of right only in response to the European search report; or in the case of European applications derived from a PCT application, in reply to the EP communication inviting the applicant to comment on the Written Opinion upon entry into the European national phase.

We are currently studying these new rules and will implement changes in our practice to accommodate said new rules. We will revert to this matter closer to the time when the new rules will come into force.

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■ See footnotes on Page #2



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## FOOTNOTES

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<sup>1</sup> As a rule, an issued patent can include claims directed to a single invention only. Where the examiner finds that a patent application contains claims directed to more than one invention, he will require applicant to divide the application, i.e. the claims will have to be restricted so as to be directed to a single invention only; and all other claims will have to be deleted. Subsequently, applicant may file one or more divisional applications directed to the deleted claims. The divisional application is entitled to enjoy the same priority and filing date as its parent application, from which it was divided out.

<sup>2</sup> A divisional application may be derived from a parent application, in which case it is directly derived there from; or may also be derived out of a divisional application, in which case it is indirectly derived and is sometimes referred to as a granddaughter divisional application. Note that under the new rules, the 2-year time limit from receipt of a first Office Action in the parent application will also apply to such granddaughter application.

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