

## Revised Deadline for Filing European Divisional Patent Applications

With effect from 2 January 2002, the European Patent Office (EPO) has extended the deadline for filing European divisional patent applications until the date on which the earlier patent application ceases to be "pending".

- At present, when the EPO intends to allow a patent application, it issues a letter called "Communication under Rule 51(4)", proposing a final form for the granted patent. The communication asks the applicant to approve the final form for the granted patent (n.b. in some cases the applicant approves the final form, but only on condition that the EPO allows some amendments to it). After the applicant approves the final form, the applicant is no longer allowed to file a divisional patent application based on the earlier patent application.
- With effect from 2 January 2002, a divisional application can be filed based on any European patent application which is still "pending", even after the applicant has approved the final form of the earlier patent application. The EPO have told us informally that they presently consider that a patent application is "pending" until (i) the application has been refused or withdrawn, or (ii) the date on which the patent is actually granted (i.e. the date that the grant of the patent is mentioned in the official bulletin of the EPO). However, note that this view is not yet firmly established by case law, and there is old case law indicating that an application stops pending on the date that the EPO issues a decision to grant the patent, which is about 6 weeks before the actual grant date.
- We therefore recommend that any divisional application should be filed before the EPO issues the decision to grant the patent. The date on which they issue this decision is unpredictable, but it cannot be before the applicant takes the steps necessary for the grant of the earlier patent application to occur (paying the grant and printing fees, filing the translation of the final claims into French and German, and filing a translation into English of any priority document which was not in English). Therefore, for safety, we recommend filing the divisional application no later than taking the steps necessary for grant of the earlier application.
- The new rule applies even to European patent applications for which the applicant approved the final form before 2 January 2002, provided that the patent application is still pending on that date. For example, it is presently impossible to file a divisional patent application based on a European patent application for which the applicant has already approved the final form, **BUT** there will be an extra chance to file a divisional application: between 2 January 2002 and the date on which the earlier application stops pending.
- If any of your cases are in this situation, and you are contemplating filing a divisional patent application, please let us know at once. We may be able to take action to ensure that the present patent application is still pending on 2 January 2002.
- The EPO's motivation for changing the deadline for filing divisional applications is bound up with changes to the EPO grant procedure due to come into force on 1 July 2002. These changes only apply to European patent applications for which the Communication Under Rule 51(4) is issued on or after 1 July 2002. We will send you information explaining the changes to the grant procedure separately.

Please contact us if you require any further information relating to filing European divisional patent applications.