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We would like to inform you about

**Rule 36 EPC – Abolition of the 24-month deadline**

**Rule 164 EPC – Unity objections on entry to the regional phase**

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## **Two at a single blow**

At its meeting on 16 October 2013, the Administrative Council of the European Patent Office (EPO) not only abolished the 24-month deadline for filing divisional applications (Rule 36 EPC) but also changed the procedures if a unity objection is raised when a PCT-application enters the regional phase (Rule 164 EPC).

### **Rule 36 EPC – Abolition of the 24-month deadline**

As of **1 April 2014**, the EPO will abolish the heavily criticized 24-month deadline following the first substantial communication for filing a divisional application and will return to the old regulation, which allows one or more divisional application(s) to be filed at any time so long as a European patent application is pending. Accordingly, it will again be possible to file divisionals from a European patent application at any time as long as this parent application has not been granted or finally refused. However, it should be noted that the EPO intends to charge an additional fee for any second (or subsequent) generation divisional applications, i.e. divisional applications divided from an application that is itself a divisional application.

If you are interested in filing a divisional application in any application which might proceed to grant before April 1, 2014 and in which the 24-month deadline has already expired, please contact us so that we can propose a strategy which would enable the desired divisional application to be filed.

### **Rule 164 EPC – Unity objections on entry to the regional phase**

Under the present system, if the EP examiner considers the claims to be non-uniform, then only the subject-matter which is considered to constitute the first invention is searched. If the applicant is interested in proceeding with subject-matter which is classified as a second or further invention, he is forced to file a costly divisional application. This rule was particularly criticised by non-EP applicants because in many cases unity was not an issue in the PCT-phase and was contested for the first time when the regional phase was entered before the EPO. Particularly if the unity objection was raised *a posteriori* the applicants were taken by surprise and also often not able to understand why the claims were divided in the manner chosen by the EP examiner.



As of **1 November 2014**, if the EPO did not serve as the International Searching Authority, the examiner will still draw up the supplementary European Search Report for the first invention. However, the applicant will now be given the opportunity to pay one or more additional search fees, so that further inventions can be searched. This will give the applicant the opportunity to direct the application to any invention disclosed in the application as filed and to avoid the filing of divisional applications just because the EP examiner classified the desired subject-matter as a second or further invention rather than as the first invention.

An analogous procedure will apply if the EPO did serve as the International Searching Authority. In this case, the applicant will now have the option to request a search for subject-matter for which he did not pay search fees in the international phase or for non-unitary subject-matter which was, e.g., introduced into the claims from the specification.

The changes to Rule 36 EPC and Rule 164 EPC are certainly steps forward towards a more user friendly system and applicants will definitely benefit from these new regulations.

If you are interested in more information on these rule changes and their implications for your applications, please contact the attorney who is in charge of your cases or Dr. Natalia Berryman ([berryman@vossiusandpartner.com](mailto:berryman@vossiusandpartner.com)).