

# Kluwer Patent Blog

## Complete response to EP search opinion?

Derk Visser (EIP) · Saturday, May 29th, 2010

Since 01.04.2010 an applicant of a European patent application must respond to the search opinion drawn up by the search division as if it was a communication of the examining division (see new Rule 70a EPC). The applicant is requested to correct any deficiencies of the patent application noted in the search opinion. However, in some circumstances, the applicant had better not correct all deficiencies.

Suppose the application is a divisional application and the search opinion gives a non-unity objection. The applicant agrees with the examiner and wants to file a further divisional for the non-unity subject-matter. However, new Rule 36(1) restricts the filing of divisionals to 24 months from the first communication of the examining division issued in the sequence of parent-divisional applications or within 24 months from the communication of the examining division raising a non-unity objection for the first time. The 24 months from the first communication will have expired in our case, because this communication will probably have been issued quite some time ago for the parent application. Hence, our applicant has to file his further divisional within 24 months from the communication raising the non-unity objection.

The applicant now provides a complete response to the search opinion by deleting the non-unitary claims and meeting any other objection, following the EPO instructions. The examiner subsequently writes his first communication for the divisional and states any remaining objection. This communication will not mention a non-unity objection, because this objection has already been met by the applicant. The applicant notices to his surprise that the 24 month period for filing his divisional has not been triggered and his non-unitary subject-matter cannot be protected anymore in a divisional.

The loss of rights is caused by just following the instructions of the EPO. The applicant should have realised that the 24-month period for filing a divisional in response to a non-unity objection is only triggered by a communication from an examining division and not by a search opinion from a search division. The non-unity objection in the search opinion does not trigger the 24 month period. By solving the non-unity issue in response to the search opinion, the following communication from the examining division does not state the non-unity objection anymore and does not trigger the 24 month period.

The applicant can avoid this loss of rights by using a different strategy. When responding to the search opinion, he should not remove the non-unitary subject matter from the divisional, but instead argue that the claims are unitary. In his communication the examiner may accept the

argument and drop the non-unity objection or he may maintain it. In the latter case his communication raises the non-unity objection for the first time and triggers the 24-month period, allowing the applicant to file a divisional application.

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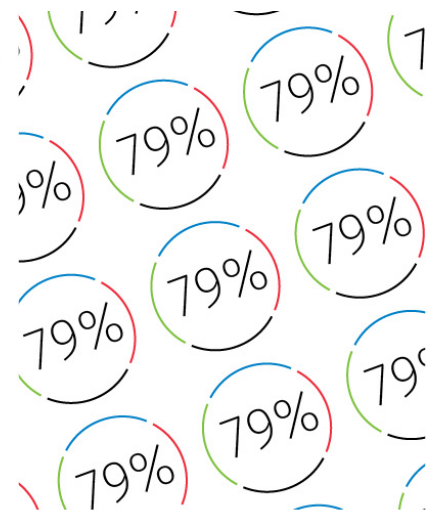
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