Report Q193
in the name of the Brazilian Group
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Divisional, Continuation and Continuation in Part Patent Applications

Questions

I) Analysis of the current law

1) Are divisional, continuation or continuation–in–part applications, respectively, available under your national or regional law?

Divisional applications are available under the Brazilian Industrial Property Law.

The Brazilian Industrial Property Law does not provide for the filing of continuation or continuation–in–part applications.

From this point onwards, our replies will deal with divisional applications only. Should the need arise to comment on continuation or continuation–in–part applications, explicit reference thereto will be made.

Although the Working Guidelines specifically state that consideration should not be given to patents of addition which are defined as separate patents filed during the lifetime of an earlier application that relate to improvements not disclosed in that earlier application, it is considered relevant that the Brazilian Industrial Property Law provides for Certificates of Addition to protect added matter relating to an improvement or development of the original invention. A certificate of addition has certain similarities to a continuation–in–part and is considered as an accessory to the patent. It has the same term as the patent, expiring therewith, and – should the main patent at some stage be considered null (invalid) – a request may be made for the certificate of addition to continue in force if the added matter is considered to be patentable per se.

2) What is the justification behind allowing the filing of divisional, continuation and continuation–in–part applications in your law?

Divisional applications are justifiable essentially on the following grounds:

i) To overcome situations of lack of unity of invention with respect to the claims on file;

ii) To permit the applicant to obtain protection for inventions disclosed in the specification but not previously claimed;

iii) To permit early grant of a patent with claims accepted by the examiner and further discussion, in a divisional application, of matter regarding which patentability is under dispute with the examiner.
3) **Under what circumstances and conditions may divisional, continuation and continuation-in-part applications (or combinations thereof) be filed in your national or regional patent system?**

Divisional applications can be filed in Brazil:

i) In reply to an office action issued by the Examiner questioning unity of invention and therefore demanding the division of the original patent application;

ii) voluntarily, whenever the applicant feels that part(s) of the invention will be positively and faster examined if detached from the parent application and claimed under a newly filed divisional application.

Divisional applications can be filed at any time prior to the end of examination of the parent application, provided that no new matter is added. Apart from the fact that a divisional must make specific reference to the parent, there are no other legal limitations as to how or when a divisional may be filed.

4) **Are cascades of divisional, continuation and continuation-in-part applications allowed, i.e. is it possible to file a divisional, continuation or continuation-in-part application on the basis of another divisional, continuation or continuation-in-part application?**

The Brazilian Industrial Property Law does not limit the possibility of filing a divisional from another divisional and, in practice, this procedure has been admitted by the Patent Office.

5) **At what time during the prosecution of the parent application may divisional, continuation or continuation-in-part applications be filed?**

According to the Brazilian Industrial Property Law, divisional applications can be filed at any stage of the prosecution of the original application, until the end of its examination. The BPO interprets the “end of examination” as being the date of the conclusive opinion report regarding patentability of the invention as claimed in the original application, or the thirtieth day prior to the publication of the decision of acceptance, rejection or definitive shelving, whichever of these is the last to occur.

6) **Is it a requirement for filing an application that is a divisional, continuation or continuation-in-part of an original application (or of another divisional, continuation or continuation-in-part thereof) that the original application (or the direct parent application, or both) is still pending at the time of filing of the divisional, continuation or continuation-in-part application?**

Yes.

7) **Is it a requirement that the original application (or the direct parent application, or both) is still pending throughout the prosecution of a divisional, continuation or continuation-in-part application derived therefrom?**

No.

8) **Are there any restrictions as to what may be included in a divisional, continuation or continuation-in-part application?**

The only restriction is that the subject-matter claimed in the divisional application may not exceed the subject-matter disclosed in the original patent application. In other words, no new matter may be added.

9) **In particular, may the description and/or claims contain or claim matter that was not contained or claimed in the original application, or other application from which the divisional, continuation or continuation-in-part application derives?**

No, as explained in 8), above.
10) Is it possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation–in–part applications, including divisional, continuation or continuation–in–part applications containing added matter, to the extent the addition of new matter is allowed?

No, it is not possible to extend the patent term. No addition of new matter is allowed.

11) Is double–patenting permitted or must the matter claimed in divisional, continuation or continuation–in–part applications be deleted from the claims of the original application, or other application from which the divisional, continuation or continuation–in–part application derives?

The Brazilian Industrial Property Law is silent regarding double–patenting. However, in practice, the Brazilian Examiners have the tendency not to allow double–patenting.

12) Does it matter in this respect whether the divisional, continuation or continuation–in–part application was filed in response to a restriction requirement issued by the patent granting authority?

No.

II) Proposals for adoption of uniform rules

1) In the opinion of your National or Regional Group, what are the advantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation–in–part patent applications?

Allowing the filing of divisional, continuation or continuation–in–part patent applications benefit mostly applicants.

The main advantage of allowing the filling continuation or continuation–in–part applications lies in the fact that such applications enable the addition of new matter such as new developments and improvements to the invention.

Additionally, such applications may enable the prolongation of patent protection for inventions.

The advantages of allowing the filing of divisional applications are twofold:

i) enables applicants of patent applications in which an issue on unity of invention may arise to further pursue patent protection for part(s) of the invention which would otherwise have to be deleted from the original application;

ii) enables applicants to voluntarily detach part(s) of the original application (which are readily admissible as patentable by the Examiner) from the original application in the form of a divisional application, therefore permitting a swifter granting decision of said detached portion(s) of the original application.

2) In the opinion of your National or Regional Group, what are the disadvantages, for applicants and third parties, of allowing the filing of divisional, continuation or continuation–in–part patent applications?

Disadvantages of allowing the filing of divisional, continuation or continuation–in–part patent applications affect mostly third parties.

The main disadvantage of allowing such applications lies in the fact that reasonable uncertainty is created for third parties wishing to know whether or not a given invention described in a given application/patent is further protected under such kind of applications. The level of uncertainty tends to increase from simple amendments in the parent application to divisional applications to continuation–in–part applications and to continuation applications.
3) In the opinion of your National or Regional Group, should the filing of divisional, continuation or continuation–in–part patent applications, respectively, be permissible?

In the opinion of our National Group the filing of divisional, continuation and continuation–in–part patent applications should be permissible.

4) If international harmonisation were to be achieved in respect of the rules governing divisional or continuation patent applications, what should be the common rules in respect of the circumstances and conditions in which divisional, continuation or continuation–in–part applications may be filed?

The common rules for allowing the filing of divisional applications should be:

i) the matter claimed in the divisional patent application should be deleted from the claims of the original application, thus not allowing double–patenting;

ii) the filing of divisional applications should be permissible during pendency of the original application, here being including the appeal stage following the eventual rejection of the original application; and

iii) cascades of divisional filings should be permissible, provided rules i) and ii) as above were to be observed.

The common rules for allowing the filing of divisional, continuation and continuation–in–part patent applications should be:

iv) the filing of divisional, continuation and continuation–in–part patent applications should not permit the extension of patent life;

v) the filing of divisional applications should be permissible before the granting of the application, here being including the appeal stage following the eventual rejection of the original application; and

vi) cascades of divisional, continuation and continuation–in–part patent applications should be permissible, provided rules i) and ii) above are observed.

Additionally, in the case of divisional applications, it should be possible to voluntarily file such applications, provided rules i) and ii) above are observed.

5) In particular, should a harmonised system permit the addition in a divisional, continuation or continuation–in–part application of matter that was not contained in the original application as filed?

The addition of matter that was not contained in the original application as filed should NOT be permissible in a divisional application.

However, the addition of matter that was not contained in the original application as filed should be permissible in continuation and continuation–in–part applications.

6) Should it be permitted to use a divisional, continuation or continuation–in–part patent application to obtain new examination and decision of an application that contains claims that are identical or essentially identical with claims finally rejected in the course of the prosecution of the parent application? Should there be an exception where case–law on the substantive conditions for patent grant of the patent granting authority has changed since the parent application was rejected? Would this possibility adequately take into account the interests of third parties in legal certainty?
This question is directed only to US practice and is therefore without a clear answer. In Brazil, for example, a divisional can only be filed up to the end of examination. In the opinion of the Brazilian National Group the filing of divisional and continuation-type applications should be permitted as long as examination has not terminated with a definitive rejection (in this respect, a US Final Rejection is not a definitive decision).

If the substantive conditions of patentability change during pendency of a divisional or continuation-type application, it is the opinion of the Brazilian National Group that such change should be applied in the manner that it is to be applied to any other application pending at that time. This could be detrimental or beneficial to the applicant as indeed it could be detrimental or beneficial to the interests of third parties.

7) Should it be possible to extend the patent term in respect of matter contained in the original application by filing divisional, continuation or continuation-in-part applications, including divisional, continuation or continuation-in-part applications containing added matter?

Extending the patent term should NOT be permitted even when new matter is added to the application.

8) In the opinion of your Group, would it be justified to limit the access to filing divisional, continuation or continuation-in-part applications primarily with the object of limiting the backlog of patent granting authorities?

No.

9) In the opinion of your Group, would it be desirable, in the interest of legal certainty of third parties, if databases of patent granting authorities ensured that a clear link was always indicated between original patent applications and all divisional, continuation or continuation-in-part applications derived therefrom?

Yes.

National and Regional Groups are invited to make any additional comment concerning divisional, continuation and continuation-in-part applications which they find relevant.

Summary

Whilst the Brazilian Industrial Property Law allows the filing of divisional applications, it does not provide for the filing of continuation or continuation-in-part applications. Divisional applications can be filed prior to the end of the examination of the parent patent application either on a voluntary manner or complying with an office action in which the Examiner has questioned unity of invention. No new matter can be added upon filing a divisional application and cascades of divisionals are not prohibited by our law. The Brazilian group is of the opinion that the filing, not only of divisional applications, but also, of continuation and continuation-in-part applications should be permissible provided this does not imply in extending the life of the patents.

Résumé

Alors que la Loi de la Propriété Industrielle brésilienne autorise le dépôt de demandes de division, elle ne prévoit pas le dépôt de demandes de continuation ou continuation partielle. Les demandes de division peuvent être déposées avant la fin de l’examen de la demande de brevet mère ou en une manière volontaire ou en accomplissant une exigence dans laquelle l’Examinateur a questionné l’unité d’invention. Aucune nouvelle matière ne peut être ajoutée lors du dépôt de une demande de
division et cascades de demandes de division ne sont pas interdites par notre loi. Le Groupe bresilienne est de l’opinion qui le dépôt, non seulement de demandes de division, mais aussi, des demandes de continuation ou continuation partielle devraient être admissibles à condition que cela n’implique pas en autoriser l’extension de vie du brevet.

Zusammenfassung
