Divisional, Continuation and Continuation in Part Patent Applications

The answers to the questions below are attempted on the basis of The Patents Act, 1970 (The Act) as amended by The Patent (Amendment) Act, 2005 along with the Patent Rules, 2003 as amended by The Patents (Amendment) Rules, 2006.

Questions

I) Analysis of the current law

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

Under the provisions The Act, Divisional applications can be filed at the Indian Patent Offices. Sec. 16 of the Act, deals with the Power of the Controller of Patents regarding the Divisional Applications.

Continuation and/or Continuation-in-part applications as such are not dealt with as such under the Act. Hence the answers below, generally would relate to Divisional applications only.

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

It has been the principle of patent jurisprudence in India that an application for a patent should be confined to one invention only. Sec. 7(1) of the Act states the same. It follows then that the Controller has a right to refuse the application relating to more than one invention at any stage before the grant of the patent. However, what constitutes a single invention may be often difficult to decide and the solution depends on the facts of each case.

Therefore, on applicant’s own further application before the grant of the patent, and/or in order to overcome the objection raised by the Controller on the ground that the claims relate to more than one invention, such divisional application can be filed under the law. Allowing such divisional application do not create/affect any substantive rights/obligations of any third parties or public at large, as the application should be confined only to the specification already filed with the Controller and both the applications are then accorded the same filing dates as that of the original application and then dealt with further as two separate applications.

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 under the following circumstances / conditions:
a) The application for patent contains matter related to more than one invention and the applicant makes an application in this regard after filing the first application but before the grant of the patent, to divide his application.

b) The Controller of Patents raises an objection on the ground that the claims of the complete specification relate to more than one invention, and hence not allowable under the Act. Hence a divisional application is filed by the applicant to overcome such objection.

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?**

Upon filing a divisional application, the new application along with the specification will be deemed to have been filed on the same date on which the first mentioned had been filed and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period. It is possible that such application on being examined may show as to have more than one invention in it, and hence to overcome this objection, further division may be required. Hence, in the absence of any statutory ceiling on the number of divisional applications being filed, it is possible to have cascades of divisional applications in order to have one invention per application.

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

Divisional Application can be filed at any stage from filing the first application to the grant of the patent. If in case the granted patent contains more than one invention, the patent shall not be invalidated on this ground.

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?**

In order to file a divisional application, it is necessary that the direct parent application is pending at the time of filing of the divisional application.

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?**

Such requirement is not warranted under the Act as the new divisional application is treated as a separate application and treated accordingly. However, in case the original application gets rejected, upon a letter written to the Controller to that effect, the divisional application can still move ahead as an independent application.

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

Sec. 16(2) of the Act states that the complete specification of the divisional application shall not include any new matter in the complete specification filed in pursuance of its parent application which was not in substance disclosed in the earlier i.e. the disclosure in specification of the divisional application shall be restricted to the disclosure in the first application only.

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. The description of the divisional application cannot contain or claim matter that was not contained or claimed in the original application. However the claims can be different from each other, the subject matter for which the protection is sought, being different. However the claims must relate to different invention in substance and not merely the scope of invention.

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. As addition of new matter is not allowed in the divisional application, the extension of patent term in respect of such matter does not arise. Besides, Sec. 53 of the Act states that the term of every patent under the Act will be twenty years only from the date of filing the application for patent.

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?

Sec. 16(3) of the Act states that the Controller may require such amendment of the complete specification in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other. Hence double patenting, as a rule, is not permitted under the law.

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. It does not matter whether the divisional application was filed in response to a restriction requirement issued by the patent granting authority.

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?

Sometimes the applicant claims more than one invention in his application. In this situation the examiner might raise an objection to require the applicant to choose one invention for prosecution and to remove claims to the other inventions from the application. Here filing a divisional application will serve the purpose of securing the other invention of the inventor, which otherwise would have been required to be removed.

Also ‘One Patent … On Invention’ rule is adhered to (Unity of invention maintained).

This creates uniformity in the nature of patents and availability of the knowledge of the invention to the public at large.

Besides such applications are given the same filing date as that of the earlier application and hence ‘divisional patent applications’ which are nothing but inventions carved out of the earlier disclosed matter only, are advantageous to the applicant and the society at large.

By their inherent nature, Continuation applications are also advantageous when an applicant discovers that a potentially patentable invention that was disclosed in the original application was not claimed. In this case, a later filed continuation application can be filed to protect this invention.
Similarly, it might be advantageous to file a patent application as a Continuation in part application when additional material needs to be added if some of the claims require the new material for support and the others are fully supported by the disclosure of the parent application.

However, the probable abuse of the patent systems with such application tools is possible.

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?

Allowing filing of Divisional Applications might increase the number of applications in the Patent office.

It does increase the applicant’s cost of acquiring and maintaining the patents.

Allowing filing of Continuation or Continuation in part patent application may throw open the patent system to vulnerability.

It could lead to increase in the filing of ‘submarine’ patents, hitting the ‘notice-function’ of published patent claims.

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?

Allowing the filing of divisional application till the parent application is pending 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?

In order to achieve international harmonisation, divisional applications should be allowed to be filed before the grant of the patent by the applicant suo moto or upon an objection raised by the examiner against the multiplicity of inventions in an application. The filing date of all such applications being identical to the original application.

Applications in the nature of continuation applications may be allowed with some restrictions such as the number and date of filing the same.

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?

No addition of matter should be allowed that was not contained in the original application.

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?

No. It should not be allowed to use such applications, 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 prosecution of the parent application.
Substantive changes should be applied only to existing applications. Otherwise uncertainty could be created.

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?
   No.

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. It would not be justifiable 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. Instead to improve the backlog of pending matters, the patent granting authorities should be well equipped with required infrastructure and the personnel trained to handle as many applications efficiently and effectively in accordance with the substantive patent law.

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. In the interest of the legal certainty and transparent public disclosure there should be a way to establish a clear link between the original patent applications and all divisional and other related applications arising out of the original application.

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