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?

The Spanish Patents Act 11/1986, dated 20 March (SPA) provides for the filing of divisional applications in the following circumstances:

- Lack of unity of invention in an application (Article 24 SPA).
- At the request of the applicant (Article 34 PR).

Continuation or continuation-in-part applications are not available under the SPA. On the other hand, the SPA provides for the filing of patents of addition (Arts 108–111 SPA).

Spain forms part of the European Patent Convention (EPC), and therefore the European regulations on divisional applications also apply to it. The EPC provides for the filing of divisional applications (Article 76 EPC), but it does not contemplate the possibility of filing continuation or continuation-in-part applications.

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

The Preamble of the SPA provides no justification for the existence of divisional applications. However, the following reasons for this do need to be highlighted:

a) For the purposes of consistency with the EPC. The EPC provides much of the inspiration behind the SPA, not only in terms of the content of the Preamble of the SPA but also because the SPA contains many of the substantive concepts enshrined in the EPC.

b) There are also a number of historical reasons as the previous patent legislation, the Industrial Property Statute of 1929 (IPS), also envisaged the possibility of filing divisional applications.

c) One subjective reason is that patent applications are required to demonstrate unity of invention. Without the possibility of filing divisional patent applications, applicants have their rights restricted with regard to applications that, in the opinion of the Spanish Patent and Trademark Office (SPTO), include more than one invention.
d) Finally, the possibility of filing voluntary divisional applications allows applicants to file various patents to protect inventions which, after being applied for in a single patent and although presenting unity of invention, ought to be separated for reasons of a strategic nature, such as: the initial grant or licensing of part of the application or the fast-tracking of the grant of the part of the application about which the SPTO has raised no objections.

On the other hand, the EPC provides no explanation for the existence of divisional applications. That said, the two main reasons for this are the last two referred to in the analysis of Spanish legislation: the requirement of unity of invention and the possibility that the applicant has an interest in dividing an application.

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?

There are two circumstances in which divisional applications can be filed:

- Lack of unity of invention (Article 24 SPA).
- At the request of the applicant (Article 34 PR).

In both cases, the patent application must still be pending, ie, such divisional applications cannot be filed if the patent has already been granted, withdrawn or refused. In both cases the object of the divisional applications must be contained in the original patent application (Art. 24.3 SPA, Art. 34.4 PR).

Filing of a divisional application due to the lack of unity of invention (Article 24 SPA):

If, during the formal examination of a patent application (Art. 17 PR), the SPTO deems that said application does not meet the requirements pertaining to unity of invention (Art. 17. 2 c) PR), it shall inform the applicant so that they may make the corresponding supporting arguments within a period of two months. Should the SPTO reject these supporting arguments, it shall give the applicant another month in which to divide the application (Art. 18.2 PR). To comply with all the requirements of Arts. 4 to 13 PR, divisional applications must be filed within a period of three months starting from the date on which the period granted for division of the application began (Art. 18.3 PR), this being the date on which the official SPTO notification rejecting the application due to the lack of unity of invention is received.

If the patent application is not divided, only the parts of the application relating to the invention or group of inventions mentioned in the first place in the claims will be granted (Art. 23 PR). In the event that there is no unity of invention, therefore, it is not a question of the applicant being given the option of filing divisional applications, the applicant is under the obligation to do so if they wish to protect the other inventions or groups of inventions.

The applicant may appeal against the decision of the SPTO with regard to the lack of unity of invention.

Filing of an application at the initiative of the applicant (Art. 34 PR):

Insofar as the application has been admitted and a decision has yet to be made, the applicant may divide it at any moment up until the date the patent is granted (Art. 34.1 PR).

In the European system, as in the SPA, a divisional application can only be filed when the application from which said divisional application derives, in other words the application from which it has been divided, is pending (Art. 76 EPC, R. 25 EPC). The divisional application may be filed either because the requirement of unity of invention has not been complied with (as required in Art. 82 EPC), or because the applicant wishes to do so. In both cases the applicant may file the corresponding divisional application at any point of the prosecution of the application. The only requirement in such circumstances is that the application from which it has been divided is still pending (R. 25 EPC).
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?

A divisional application follows the same grant procedure as any other application, which means that:

- If during the formal examination (Art. 17 PR) of a divisional application it is deemed that the requirement of unity of invention has not been fulfilled, the same rules governing any patent application will be applied here, i.e., said divisional application can be divided.
- Insofar as a divisional application is simply another application, it can also be divided at the initiative of the applicant.

There have been several cases of cascades of divisional applications at the SPTO. Although they are not expressly mentioned in the EPC, “cascades” of divisional applications are also allowed in the European system.

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

**Filing of a divisional application due to lack of unity of invention (Art. 24 SPA):**

Divisional applications must be filed within a period of three months starting from the date on which the period allowed for dividing the application began (Art. 18.3 PR), which is the date on which the official SPTO notification of the lack of unity of invention is received.

On receiving the SPTO notification that the application does not meet the requirement of unity of invention, the applicant may, within a period of two months starting from its receipt, present the relevant supporting arguments against lack of unity (Art. 18.2 PR). If these supporting arguments are rejected, the SPTO will give the applicant a new period of one month in which to file the divisional application, which means that the applicant has a total of three months for filing the divisional application (the result of adding together the two months open to the applicant for presenting the supporting arguments, during which time they may also file the divisional application, and the additional period of one month granted specifically for that purpose).

**Filing of a divisional application at the initiative of the applicant (Art. 34 PR):**

At any time from the admission of an application through until the date the patent is granted (Art. 34.1 PR). The final day of the period for filing a divisional application is the date on which the SPTO agrees the grant of the patent, not the date on which notification of grant of the patent is published in the Official Industrial Property Journal (OIPJ).

In the European system, and regardless of whether they are filed due to a lack of unity of invention or otherwise, divisional applications can only be filed while the application is pending (R. 25 EPC), i.e., before the date that the European Patent Bulletin mentions the grant of the European patent or, where appropriate, before the date on which the patent application is refused, withdrawn or deemed withdrawn, although it can also be filed during the appeal procedure if an appeal is filed against said decision (Official Journal EPO 2002, page 112).
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?

It can be deduced from the SPA that the application from which a divisional application is divided must still be pending. This is because either the SPTO has suggested the division following a formal examination (which would mean the application is still pending), or it is the applicant who has decided to divide it, having the possibility of doing so “up until the date of the grant”.

This is also the case in the European System (see answer to the previous question).

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, from the moment the divisional application is filed the procedures are independent to each other, and the divisional application is processed separately to the application it has been divided from.

This is also the case in the European System.

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

Yes, the main restriction is that new subject–matter cannot be added (Art. 24.3 SPA, Art. 34.4 PR). The SPA sets out that a patent must be rejected when it has been granted as a result of a divisional application and its object extends beyond the content of the application from which it has been divided (Art. 112.1. c) SPA).

There is one other restriction. The description and drawings, both in the initial patent application and in any divisional application, must only refer, in principle, to the elements that are to be protected by said application. However, when there is a need to describe, in a certain application, elements for which protection has been applied for in another application, reference must be made to this other application (Art. 34.3 PR).

The EPC also requires that the divisional application only includes matter that does not extend beyond the content of the earlier application as filed (Art. 76 (1) EPC).

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 was stated in the answer to the previous question (Art. 24.3 PA, Art. 34.4 PR).

What can be done, of course, is to claim matter contained but not claimed in the original application. Insofar as the SPA provides for the amendment of the claims provided that they do not involve an extension of the content of the application (Art. 41. 3 SPA), claims containing subject–matter taken from the description of the original application may be included in a divisional application.

Nor does the European system permit the addition of new subject–matter to a divisional application (Art. 76 (1) EPC). Furthermore, the claims contained in a divisional application do not have to be limited to the content already claimed in the original application (C–VI, 9.1.4 of the Guidelines for Examination of the European Patent Office). This is an issue that the Enlarged Board of Appeal is currently in the process of making a decision on (G1/06, consolidated by G1/05 and G3/06, also relating to divisional applications).
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?

Insofar as new matter cannot be added to divisional applications, this question is rendered devoid of meaning when current Spanish legislation and the EPC are analysed.

As regards the maximum term of patents granted as a result of a divisional application, said term is 20 years from the date on which the original application is filed, as divisional applications have the same filing date as said original application (Art. 24.3 PA, Art. 34.4 PR), and the patent has a term of 20 years starting from the date on which the application is filed (Art. 49 PA). Similarly, the maximum term of a European divisional patent is 20 years starting from the date on which the original application is filed (Art. 76 (1), Art. 63 (1) EPC).

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 SPA and PR do not expressly regulate this aspect as it refers to the processing of divisional applications. However, two situations may arise in the practices adopted by the SPTO:

- Filing of a divisional application due to a lack of unity of invention. In this case the subject–matter claimed in the divisional application must be removed from the claims of the original application.

- Filing of a divisional application at the initiative of the applicant. If the divisional application aims to protect part of the matter claimed in the original application, such a situation will probably lead to an objection being raise by the SPTO, particularly in applications processed according to the optional grant procedure and involving a substantive examination of patentability.

In Spanish legislation, the prohibition of double–patenting is only expressly regulated in the case of a European patent that claims the priority of a Spanish patent being validated in Spain (Art. 16 RD 2424), the purpose being to prevent double–patenting. In such circumstances, the legislation sets out that the national patent shall have no effect from the moment at which the period for filing an opposition against the European patent has expired, without an opposition having been filed, or the opposition procedure has terminated, the European patent being maintained.

The Guidelines for Examination of the European Patent Office stipulate that the original application and the divisional application cannot claim the same subject–matter (C–VI, 9.1.6).

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?

If said restriction requirement refers to the lack of unity of invention, in practice the situation could differ in that it depends on whether or not there is unity of invention (see answer to the previous question).

If said restriction requirement refers to another type of objection on the part of the examiner and which results in the filing of a divisional application at the initiative of the applicant, this has no bearing whatsoever on the relationship with any subsequent double–patenting. The requirements that a divisional application must fulfil are the same, irrespective of the reasons for it being filed voluntarily.
**Additional comments on national legislation:**

A) National legislation also provides for utility model protection as another means of protecting inventions (see Arts. 143 to 154 SPA).

A divisional application may involve an application for a utility model instead of a patent application. This can be deduced from the fact that Art. 153.1.c) SPA states as grounds for the rejection of a utility model the fact that it has been granted as a result of a divisional application and includes matter not contained in the initial application. In addition, a utility model application may also give rise to a divisional application (both utility model and divisional application modes can be indicated in the application form).

A patent application may give rise to a divisional application for a utility model and vice versa. There are examples of such cases at the SPTO. In principle there is no obstacle to this, bar the fact that the SPTO may examine whether the correct protection mode has been used, as the distinction between the two is not clearly defined and there are areas where they overlap.

B) There are two patent grant procedures stipulated in national legislation: a general grant procedure and an optional substantive examination procedure (see Arts. 30 to 40 SPA).

Insofar as divisional applications may be filed through either of the two procedures, the original application may be processed according to the general grant procedure and the divisional application processed according to the substantive examination procedure and vice versa.

C) The SPA also provides for the filing of patents of addition (Art. 108 to 111 SPA). Patents of addition are patents protecting inventions that perfect or develop an invention that is the object of a previous patent and which form a single general inventive concept with the object of said previous patent (Art. 108.1 SPA). Patents of addition can also be claimed for a patent application although these patents of addition cannot be granted until the previous patent has been granted (Art. 108.2 SPA). It is not necessary that the object of the patent of addition involves an inventive step in relation to the object of the previous patent (Art. 108.3 SPA). The priority date of the patents of addition is the date on which their respective applications are filed, they have the same term as that given to the previous patent, and they are not subject to the payment of annual fees (Art. 109.1 SPA).

**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?

**Advantages of divisional applications for applicants:**

- In case of lack of unity of invention, they provide protection for all patentable inventions described in the original application.
- In case of a divisional application filed at the initiative of the applicant, subject–matter contained in the description of the original application but not claimed in it can be protected.
- The voluntary division of a patent application allows, for example, the monopoly on some of the claims in the original application to be granted or transferred to a third party.
- They represent a means of avoiding prosecution problems by separating problematic aspects of the patent in question from non–problematic aspects, thus speeding up the grant of the latter. They enable rapid prosecution without complications for part of the invention (so that, for example, the granted patent can be enforced against third parties) as well as the “concentration” in a divisional patent of the other part of the invention, which may be subject to a long and complex prosecution.
− They allow the applicant to reduce initial costs to a single application. A decision can then be made whether to divide the application or not.
− They allow prosecution to be delayed and to thus buy time, thereby maintaining a situation of uncertainty for third parties. They even allow claims to be focused in accordance with the characteristics of a product being marketed by an alleged infringer.

**Advantages of continuation applications for applicants:**
They allow prosecution to be prolonged in relation to the subject–matter contained in the original application, thereby maintaining the situation of uncertainty for third parties as to the nature of the protection granted to the applicant. In the event that the original application is rejected, they can be used to continue the prosecution of a new application featuring a new set of claims. In the event that the original application is finally granted, the continuation application keeps open the possibility of the granting of complementary protection referred to the same subject–matter.

**Advantages of continuation-in–part applications for applicants:**
They enable prosecution to be prolonged in relation to matter contained in the original application, thereby maintaining the situation of uncertainty for third parties, with the additional advantage that it is also possible to add new subject–matter to the continuation-in–part application.

**Advantages of divisional, continuation and continuation-in–part applications for third parties:**
None. These applications only represent disadvantages for third parties, disadvantages that relate in the main to the legal uncertainty they generate (see answer to following question).

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 divisional applications for applicants:**
Delays in the prosecution of divisional applications in those cases where the applicant has a legitimate interest in the patent being granted as quickly as possible.

**Disadvantages of continuation and continuation-in–part applications for applicants:**
In the case of continuation–in–part applications, complex situations can arise with regard to effective priority dates that may affect the validity of claims covering new or mixed subject–matter.

**Disadvantages of divisional applications for third parties:**
− They complicate the analysis and evaluation of the legal situation deriving from the protection of an invention or set of inventions in an application. This means that third parties have to study the pending application to detect any patentable subject–matter that may be based on it, even if it has not been specifically claimed in the parent application and has not, therefore, been the object of a search.
− They delay the confirmation of the patentability of an invention or set of inventions, thereby prolonging uncertainty over time and increasing legal uncertainty.

**Disadvantages of continuation applications for third parties:**
They delay knowledge of the patentability of an invention, thereby prolonging uncertainty over time and increasing legal uncertainty.
Disadvantages of continuation-in-part applications for third parties:

- As well prolonging uncertainty over time, they increase legal uncertainty even more, given that the applicant may add new subject-matter to continuation-in-part applications.
- Complexity in assessing the validity of the claims resulting from the different effective dates for the different matters.

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?

The filing of divisional applications should be permissible, but not the filing of continuation and continuation-in-part applications.

Divisional applications perform a very important function: they enable the applicant to protect inventions that cannot be protected in a single application due to the fact they do not fulfill the requirement of unity of invention. In addition, there are situations in which the division of an application is also useful, even where there is unity of invention.

As regards continuation applications, given that divisional applications can be filed voluntarily even where there is unity of invention, we do not see the need to include this mode of protection.

With regard to continuation-in-part applications, we believe there is justification for a monopoly on an invention in which new subject-matter is added to a previous application, insofar as the resulting invention fulfills the patentability requirements, for which there exists the possibility of filing a new application separate to the previous one. Furthermore, we do not believe that the addition of subject-matter to a continuation-in-part application to address the lack of a sufficiently clear and complete description in the original application is justified. To be deemed valid, an application should include, at the moment it is filed, a sufficiently clear and complete description so that a person skilled in the art may carry out the invention, as required by the SPA and the EPC (Art. 25.1 SPA, Art. 83 EPC).

We are also of the opinion that the indiscriminate filing of patent applications relating to a new product with a view to confusing and misleading third parties goes against the very principles upon which a patent system ought to be based, and we believe that the existence of the continuation-in-part applications may contribute to such a practice.

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?

As regards divisional applications, the basic standard regulations applying to them are, logically, those of the Paris Convention (Art. 4 G(1), Art. 4 G(2) PC). Taking this as the basis, we believe that harmonisation based on the EPC would be appropriate, although any possible amendments of the contents of the EPC should not be made by bending existing regulations but by introducing restrictions. With this in mind we propose the following common regulations:

- A divisional application should be filed directly with a new set of claims, and the applicant should only be allowed to amend the claims of the divisional application by limiting the scope of said new set of claims and without adding matter that has not been the object of a search for the divisional application.
- In the event that an application is rejected, the applicant should be allowed to present a divisional application if they file an appeal (as the European system allows), although the divisional application should only be filed within the period allowed for the filing of the appeal and not at any point during the appeal procedure.
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. Such an option should not be available due to the legal uncertainty it creates for third parties.

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 is good that the law provides for the opinion of an examiner to be reviewed at second instance, but the appeal procedure already provides for this.

Nor would it be fair for any change in the law to be applied retrospectively.

To limit the possibility of any law changes during the prosecution of divisional applications, the grant procedure should be speeded up. The examiner who deals with the original application should examine the divisional application deriving from it and should examine both applications at the same time.

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. The filing of a new application containing added matter should under no circumstances result in the protection of matter claimed in the original application being prolonged beyond the maximum period of 20 years from the date the original application was filed.

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. Any backlogs must be resolved by other means, but never at the expense of the applicant's rights. The decision as to whether the applicant has the right to file divisional applications or, where appropriate, continuation or continuation–in–part applications, must be made for purely objective reasons and not because of any practical backlog–related problems at a particular patent office.

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. We would like to make the following proposals with regard to this:

– There should be a maximum period from the filing date of the divisional application in which the office in question should publish said information and said application.

– Office databases should be updated as quickly as possible.

– Original applications and the divisional applications resulting from them should be clearly grouped together into "families" in the databases of the various offices including, in the event that there are "cascades" of divisional applications, not only direct preceding and succeeding applications, but also all the applications in the "cascade".
National and Regional Groups are invited to make any additional comment concerning divisional, continuation and continuation in part applications which they find relevant.

**Additional comments**

We believe it important that the criteria pertaining to unity of invention are unified as a means of overcoming the current variations between, for example, European criteria and the criteria applied in the United States.

As far as divisional applications are concerned, we propose their harmonisation based on the provisions of the European system, while adding, among others, the following aforementioned rules:

- **Content of the claims of a divisional application:**
  a divisional application should be filed directly with a new set of claims, and the applicant should only amend the claims of divisional application by limiting the scope of said new set of claims and without adding matter that has not been the object of a search for the divisional application.

- **Period for filing a divisional application:**
  in the event that an application is rejected (or declared withdrawn), if said decision was the object of an appeal, the applicant should be able to file a divisional application (as the European system allows). However, it should be filed in the period allowed for the filing of the appeal and not at any point during the appeal procedure.

In addition, the examiner dealing with the original application should also examine the divisional application deriving from it and should examine both applications at the same time. In the event that there are various inventions contained in a single application, the best way in which an applicant can obtain proper protection for said inventions is that they are examined simultaneously, as this allows the examiner to make a joint evaluation of them and to gain a clearer vision of the protection that should be awarded to the applicant. Moreover, this would speed up the prosecution of divisional applications, prevent deliberate delaying tactics on the part of some applicants and also improve the legal certainty for third parties.

**Abbreviations used:**

- EPC: European Patent Convention
- PC: Paris Convention
- IPS: Industrial Property Statute of 1929
- SPTO: Spanish Patent and Trademark Office
- OIPJ: Official Industrial Property Journal
Summary

As with the European Patent Convention (EPC) of which Spain forms part, the Spanish Patents Act 11/1986, dated 20 March (SPA) provides for the filing of divisional applications, but does not contemplate the possibility of filing continuation or continuation–in–part applications. There are two circumstances in which divisional applications can be filed: where there is a lack of unity (Art. 24 LP) and where the applicant wishes to file such an application (Art. 34 RP). In both cases, the patent applications must still be pending, and the object of the divisional applications must be contained in the original patent application (Art. 24.3 LP, Art. 34.4 RP). As regards the harmonisation of international legislation, the Spanish Group of the AIPPI proposes some common rules pertaining to divisional applications, and is of the view that the filing of continuation and continuation–in–part applications should not be permitted.

Résumé


En rapport avec l’harmonisation de la législation internationale, le groupe espagnol de l’AIPPI propose quelques normes communes pour les demandes divisionnaires et estime que la présentation de demandes de “continuation” et de “continuation-in-part” ne devrait pas être permise.

Zusammenfassung