ExCo Singapore

Plenary Session

Question Q193: Divisional, Continuation and Continuation in Part Patent Applications

Sunday, 7 October 2007 (14.00 – 15.30 and 16.00 – 17.30)

The session was opened by the Chairman of the session, Mr. Thierry MOLLET-VIEVILLE (FR), Vice-President of AIPPI. He introduced Mrs. INO (JP) of the Japanese Group of AIPPI, who gave a talk on the solutions relative to the various types of divisional patent applications adopted by the Japanese, American and European Patent Offices. Her very complete talk was followed by cordial applause.

Mr. Thierry MOLLET-VIEVILLE then opened the discussion and asked for the assistance of the Mr. Nicolai LINDGREEN (DK), Assistant Reporter General to present the subject.

Mr. LINDGREEN summarised that the debate was established by AIPPI and the orientations of the work. He set out the advantages and the disadvantages of the existing systems and stressed that the question gave rise to answers from 39 national groups. His talk was followed by applause.

Mr. MOLLET-VIEVILLE gave the word to the President of the Working Committee, Mr. David HILL (US).

Mr. HILL stressed that one of the difficulties which the Working Committee had to face consisted in the fact that, in the various legal systems, the same term, namely in particular the expression "continuation", has a different legal range. It was thus necessary to define in the draft Resolution the meaning of these expressions to give coherence to the position of AIPPI. It is for this reason that the preamble to the draft Resolution contains such definitions. In addition, he recalled that the procedure of "continuation in part" of the American patent system does not have only advantages. Actually, American experts realized that this procedure presents finally more disadvantages than advantages. This is why the American Group does not wish that this procedure be extended abroad within the framework of a possible harmonization. He then pointed to the preamble to the draft Resolution and suggested moving to the debates. His intervention was followed by applause.

The Chairman of the meeting, M. MOLLET-VIEVILLE, pointed out that the Resolution deals with various types of procedures and that divisional applications are the subject of paragraphs 1 to 6 of the draft Resolution. Paragraph 7 deals with continuation applications. Paragraph 9 deals particularly with "continuations in part". Paragraph 10 deals with the whole of the procedures and the titles which result from this.

Mr. William HOYNG (NL), of the Dutch Group, intervened to make a general remark. He considered that the draft Resolution is likely to be perceived as too favourable to patentees and that it does not take sufficient account of the requirements of the protection of third parties. He recalled that the work of AIPPI consists in seeking a legal provision most effective and just, without necessarily favouring a particular group or a corporation.
In answer, Mr. HILL recalled that such a proposal was included in the preliminary draft which was submitted to the Working Committee and to which there was no objection but the Resolution includes such a reminder. However, he added that the Working Committee finally opposed such a standpoint.

Paragraph 1 was subjected to a vote by M.MOLLET VIEVILLE.

Paragraph 1 was accepted with quasi unanimity.

Paragraph 2 was then presented by the Chairman of the Committee, Mr. HILL.

Mr. Stephan NEUMANN of the French group proposed combining paragraph 10 of the draft Resolution, which mentions the data bases accessible to the public, with paragraph 2. Mr. HILL answered by noting that paragraph 6 of the draft Resolution already relates to continuation applications and that, under these conditions, it appears unsuitable to him to refer in paragraph 2 to the data bases accessible to the public.

M. MOLLET-VIEVILLE subjected paragraph 2 to the vote.

Paragraph 2 was accepted by a very large majority.

Paragraph 3 and paragraph 4 were then presented by Mr. HILL. In the absence of observations, they were subjected to the vote.

Paragraphs 3 and 4 were successively adopted with a very large majority.

M. Michel de BEAUMONT (FR), of the French Group, intervened on the subject of paragraph 5. He wondered about the utility to envisage in this paragraph that a solution can consist in removing a part of the contents of the application when this part of the contents was added within the framework of a divisional application.

M. MOLLET-VIEVILLE answered by recalling that paragraph 5 deals with the problem of the sanction for the addition of subject matter to a divisional application. It should be known whether AIPPI is in favour of revocation of such a divisional application or whether it accepts that the additional contents are purely and simply withdrawn.

Mr. Ejvind CHRISTIANSEN (DK), of the Danish Group, observed that there can be situations in which a patentee can forget that he has, within the framework of a divisional application, added additional content to his application. It is thus necessary to regulate this situation and that, more especially, as the European Patent Office has done, rules relating to this problem should be adopted.

Mr. Heinz BARDEHLE (DE), of the German Group, intervened to recall that this addition of additional content to a patent application can result from an involuntary error by the patentee. It is thus necessary to organize the consequences and the possible sanctions of such an addition. Paragraph 5 of the draft Resolution makes it possible to find, according to him, a satisfactory solution to this problem.

Paragraph 5 was subjected to the vote.

Paragraph 5 was approved with a very large majority.

Paragraph 6 was the object of a comment by Mr. CHRISTIANSEN, of the Danish Group, who suggested modifying the drafting of this paragraph by replacing the term "to extend" by the
term "to exceed". This textual modification was approved by the Working Committee which made the amendment of Mr. CHRISTIANSEN.

The text of paragraph 6 in its new drafting was subjected to the vote.

*Paragraph 6 was approved by a very large majority.*

Paragraph 7 did not raise any comment.

*Paragraph 7 was also approved by a very large majority.*

Mr. Robert MITCHELL (CA), of the Canadian Group, intervened about paragraph 8. He wondered about the range of this paragraph, which asks for Patent Offices to accelerate the grant of patents. However, according to Mr. MITCHELL, it is the publication of patent applications which must occur very quickly. Indeed, it is the publication which informs third parties of the contents of divisional or continuation applications. He proposed to introduce a reference to publication in paragraph 8.

His amendment was submitted to the vote and it was accepted.

The entire paragraph with the amendment of M. MITCHELL was then subjected to a vote.

*Paragraph 8 was accepted.*

Mr. MOLLET-VIEVILLE then proposed to take again the suggestion which was formulated at the beginning of the session by Mr. HOYNG who asked for an additional paragraph in the resolution, which would show the concern that AIPPI has for protecting the rights of third parties. M. MOLLET-VIEVILLE read the text of this amendment which would constitute a new paragraph 9 of the Resolution.

A Canadian delegate expressed his agreement with this proposal, but requested that it be supplemented by the expression "with the aim of avoiding abuse".

Mr. BARDEHLE, intervening on his personal behalf, expressed his hesitation as to the advisability of envisaging a new paragraph 9. He observed that paragraph 8, such as it was adopted, as well as paragraph 9 of the preliminary draft of the Resolution express already the concern which the proposal of Mr. HOYNG tries to cure. And he recalled that, according to him, AIPPI must give practical solutions within the framework of the harmonization and that such is not the case of the proposal of Mr. HOYNG.

Mr. David HARRISON (UK), of the British Group, expressed a fear with the too broad range of the suggestion formulated by Mr. HOYNG. He considered, in addition, that such a provision is likely to be in contradiction with paragraph 3 of the Resolution which had been just adopted.

Mr. David MERRYLEES (BR), of the Brazilian Group, opposed the proposal presented by Mr. HOYNG. According to him, this proposal is too restrictive and unfavourable to patentees.

Mr. Reiner HILLI (FI), of the Finnish Group, observed that the proposal formulated by Mr. HOYNG does not encourage the disclosure of inventions by patents. He considered that it is not necessary to limit divisional applications since they encourage the inventors to make available of the public, by the disclosure of the patents, their new inventions.
Mr. Yves BIZOLLON (FR), of the French Group, expressed on the other hand the support of the French Group to the proposal of Mr. HOYNG such as it was modified by the amendment formulated by the Canadian Group.

And Mr. Jean-Robert CALLON de LAMARCK (FR), of the French Group, supported the proposal formulated by Mr. BIZOLLON. He specified however that in fact the States must be encouraged to prevent abuses resulting from continuation applications.

Mr. Ivan HJERTMAN (SE), of the Swedish Group, expressed the agreement of his Group to the proposal of Mr. HOYNG.

And Mr. CHRISTIANSEN, of the Danish Group, considered that in truth the problem arising from continuation applications is very exaggerated. And, under any assumption, there is not abuse, according to him, for divisional applications which should not be aimed at by new paragraph 9 of the draft Resolution. He recalled that divisional applications often result from objections raised by Patent Office examiners who require division of patents pursuant to the rules on unity of the invention.

Mr. Peter FRANKE (AUS), of the Australian Group, expressed the hostility of his Group to the amendment of Mr. HOYNG. The Australian Group considered that Patent Offices are likely to deal with such a recommendation by imposing arbitrary rules limiting divisional applications or continuation applications. He added that, in any case, divisional applications cannot be the subject of such a paragraph.

Mr. Fernand de VISSCHER (BE), of the Belgian Group, considered that the problem which arises for third parties is knowledge as to which patents could be used against them: whether the application is a divisional or a continuation application is less important. He thus suggested not eliminating from this paragraph divisional applications and he proposed to maintain the amendment as first drafted by Mr. HOYNG.

Mr. HOYNG intervened to indicate that he agrees with the majority of the comments made, which tend to limit the range of his amendment. He thus withdrew from his amendment the reference to divisional applications, although he persists in thinking that these applications can also pose problems.

Mr. Michel of BEAUMONT (FR), in the name of the French Group, expressed his agreement with the last proposal of Mr. HOYNG.

The Belgian Group maintained however its desire to see the amendment of Mr. HOYNG also relating to divisional applications.

Finally, after various amendments, paragraph 9 was submitted the vote and was adopted in its new version:

"Conditions such as restrictions as to the time of filing of the application can be adopted with the aim of preventing abuse in relation to continuation applications."

Mr. MOLLET-VIEVILLE pointed out that the purpose of this paragraph is to confirm the search for a balance between the rights of patentees and rights of third parties.

New paragraph 9 was adopted with a very large majority.

Mr. MOLLET-VIEVILLE subjected paragraph 10 to the vote.
Mr. MITCHELL opposed this paragraph which seems to criticize the system of "continuation in part". He considered that it is a system which is very useful for patentees and that AIPPI should not devalue it.

No other comment was formulated about this paragraph. It was therefore subjected to a vote.

*Paragraph 10 was adopted with a very large majority.*

Mr. HARRISON, of the British Group, intervened about paragraph 11. He suggested modifying the drafting of this paragraph by specifying that the link between the main patent and divisional or continuation applications must exist in the two directions in the data bases.

Mr. HILL answered that the current drafting corresponds to this concern. However, he recognized that it causes a drafting problem and that the Committee must still work on this question.

Mr. HOYNG proposed adding the expression "as soon as possible" after the words "of the clear links" to encourage the administrative authorities to establish such data bases as soon as possible.

His amendment was adopted with a very large majority.

*Paragraph 11 was also accepted.*

Mr. MOLLET-VIEVILLE subjected the body of the resolution to the vote.

Mr. de VISSCHER spoke to observe that, according to him, there is a contradiction between the resolution and new paragraph 9. Notwithstanding his observation, the Assembly voted on the draft Resolution.

*And the text of the Resolution was adopted with a very large majority.*

Then, the Chairman subjected to the vote the preamble which was also adopted.

The meeting was concluded by the Chairman, Mr. Thierry MOLLET-VIEVILLE, thanking the President of the Committee, Mr. David Hill, for the work provided by the Q193 Committee. His intervention was followed by applause by the delegates of the Executive Committee of AIPPI.